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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/487,526

Applicant(s)

Harvey et al.

Examiner

David E. Harvey

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on May 11, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 2-65 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 2-65 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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## **SECTION I: ( A *MOST* SIGNIFICANT ISSUE)**

**A) The present application is continuation that depends on a chain of applications dating back to 11/3/1981. Each application within this chain contains only a respective one of two separate and distinct written descriptions <sup>1</sup>. Specifically:**

**1) All of the applications that occur in the chain prior to CIP application S.N. 96,096 of 9/11/87 comprise the same 44 page written description.**

**[Because this 44 page written description was in applicant's earliest filed parent application the examiner has assumed, right or wrong, that this disclosure gets an effective filing date of 11/3/1981; i.e. which is the reason the examiner often refers to this 44 page disclosure as: "the original parent disclosure", "the parent disclosure", "the 1981 disclosure", etc,...]; and**

**2) All of the applications that occur in the chain from the filing of CIP application S.N. 96,096 to the present, comprise the same 557 page written**

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<sup>1</sup> The later filed 557 page 1987 disclosure literally replaced the earlier filed 1981 parent disclosure as "the instant" disclosure because it did not incorporate the earlier filed 1981 disclosure into itself; i.e. the earlier filed 1981 disclosure was left behind in the drafting and filing of the 1987 disclosure.

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**description which is, for all intents and purposes, *completely* different from the originally filed 44 page written description.<sup>2,3</sup>**

**[Because the written description of the present application is the same as the 557 page written description of the earlier filed CIP application the examiner has assumed, right or wrong, that the disclosure of present application gets the effective filing date of 9/11/87; i.e. which is the reason the examiner often refers to the disclosure of the instant application as the: “the present disclosure as originally filed”, “the present disclosure”, “the 1987 disclosure”, “the instant disclosure”, etc,...].**

**B) All the inventions that are described within the 557 pages of applicant’s instant 1987 disclosure represent specific applications of applicant’s 1987 “*SPAM data transmission technology*” that was first described (i.e. *introduced*) via applicant’s 1987 disclosure. In contrast, all the inventions that were described in the 44 pages**

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<sup>2</sup> The 1981 and 1987 inventions from applicant’s 1981 and 1987 disclosures represent vastly different 1981 and 1987 data transmission technology, respectively. Since applicant’s 1981 inventions and technology were not incorporated into applicant’s 1987 disclosure (they were not “carried forward” into the 1987 disclosure), applicant cannot be claiming his 1981 inventions/technology now; i.e. because the currently pending claims must derive all 112-1 support from the “instant disclosure” which is now the 1987 disclosure that only contains 1987 inventions/technology. The 1987 inventions/technology that is now necessarily being claimed is certainly not entitled to the 1981 filing date of applicant’s earlier 1981 inventions/technology.

<sup>3</sup> SEE APPENDIX II OF THIS OFFICE ACTION.



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of applicant's earlier 1981 disclosure represent specific applications of technology other than said 1987 "SPAM data transmission technology"; e.g. they appear to represent applications of cuing signal/tone technology which was common to 1981. In any event, applicant's present 1987 "SPAM-based" disclosure clearly represents a "NEW BEST MODE DISCLOSURE" when compared to the 1981 disclosure that it literally replaced. As explained by Judge Rich in "TRANSCO PRODUCT INC. VS PERFORMANCE CONTRACTING, INC. and PERFORMANCE CONTRACTING GROUP, INC. [38 F.3d551; 32 U.S.P.Q.2D (BNA) 1077], this fact alone deprives applicant of his claim to the 1981 effective filing date:

"It must be understood that the introduction of a new best mode disclosure would constitute the injection of 'new matter' into the application and automatically deprive the applicant of the benefit of the earlier filing date of the parent or original application for any claim whose validity rests on the new best mode disclosure."

**[IMPORTANT NOTE:** Applicant failed to incorporate his 1981 disclosure into his 1987 disclosure in any way whatsoever(e.g. it was neither physically incorporated nor was it incorporated by reference). Being such, applicant's

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present 1987 disclosure literally replaced the original 1981 disclosure as the “instant disclosure” from which all section 112 support must now be obtained <sup>4</sup>. Being such, the “validity” all of applicant’s currently pending claims necessarily rests solely on applicant’s 1987 “new best mode disclosure” and solely in the new 1987 “SPAM data transmission technology” on which the inventions of applicant’s 1987 “new best mode disclosure” are based. Because of this, as explained by Judge Rich, the present applicant has “automatically deprived” himself the benefit of the earlier 1981 filing date of his 1981 parent application with respect to the currently pending claims; i.e. applicant’s 1987 inventions, comprised of applicant’s 1987 SPAM technology, were not described in applicant’s 1981 parent application and therefor are not entitled to the 1981 filing date of the parent application. Viewed from another direction, the inventions disclosed in applicant’s 1981 disclosure and the inventions disclosed in applicant’s 1987 disclosure represent very different data transmission system technologies, and therefor do not constitute “common subject matter” that is required to substantiate applicant’s claim to the earlier 1981 filing date <sup>5</sup>. Because applicant’s 1981

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<sup>4</sup> SEE: *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973)

<sup>5</sup> Because of the way applicant elected to draft and file his 1987 disclosure, applicant’s 1981 disclosure and 1981 inventions were not carried forward into, and are not part of, applicant’s 1987 disclosure. Thus, because the 1981 inventions are not

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**and 1987 disclosures do not contain “common subject matter”, the effective filing date for all of applicant’s later filed 1987 inventions (i.e. those 1987 inventions that are now necessarily being claimed) can be no earlier than the original 1987 filing date of applicant’s CIP in which they were first described (i.e. the earliest filing date of applicant’s 557 page “new best mode disclosure”)<sup>6</sup>.**

**C) Throughout the present prosecution, applicant has made some effort to show:**

**1) where/how applicant’s *instant specification* (i.e. the 1987 disclosure) provides section 112-1 support for his pending amended claims; and also**

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disclosed within the 1987 disclosure, the 1987 disclosure does not provide required section 112-1 support for claims which are directed to these 1981 inventions. Likewise, the 1987 inventions, that are now necessarily being claimed by the currently pending claims, were not previously disclosed in the earlier filed 1981 disclosure and therefor are not entitled to the 1981 filing date. In contrast to the present circumstances, had applicant elected instead to incorporate his 1981 disclosure and inventions into the 1987 disclosure during the drafting and filing of the present 1987 disclosure (i.e. applicant did not!), then applicant would have been entitled to draft claims directed to the incorporated 1981 portion of the 1987 disclosure and such claims, i.e. claims supported by this incorporated 1981 portion, would have been entitled to the 1981 filing date because they would have represented inventions which were previously described/disclosed in the earlier filed 1981 disclosure; i.e. they would have represented “common subject matter”.

<sup>6</sup> At best, one can only argue that a given one of applicant’s 1981 inventions and a given one of applicant’s 1987 inventions represent different technological ways of achieving similar goals/effects and therefor constitute some type of “correlated subject matter”. However, “correlated subject matter” does not constitute “common subject matter” and therefor does not substantiate a claim for 1981 priority.

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2) where/how applicant's *previously filed 1981 specification* (i.e. the 1981 disclosure) provides section 112-1 support for these same pending amended claims.

However, what has become crystal clear from these efforts is that the scope/meaning/interpretation that applicant is given to each claim limitation via the *instant 1987 specification* differs from the scope/meaning/interpretation given to each claim limitation via the *1981 parent specification*<sup>7</sup>. So which of these two 1987 and 1981 scopes/meanings/interpretations should each claim limitation get? Well, because the disclosure of applicant's 1981 parent application was not incorporated into the instant 1987 disclosure, each claim limitation gets the scope/meaning/interpretation that is given to it by the *instant 1987* disclosure. And, because these 1987 scopes/meanings/interpretations are not the same as- and do not go back to- the original 1981 disclosure, the 1987 scopes/meanings/interpretations cannot be given the 1981 filing date. By alleging a 1981 effective filing date for the 1987 claim scopes/meanings/interpretations that are now necessarily being claimed via his pending claims, applicant is effectively attempting to use his pending claims' limitations as time machines so as to transport those portions of his 1987 disclosure

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<sup>7</sup> i.e. the respective 1987 and 1981 interpretations of the same limitations encompass subject matter of a different scope/meaning and thus do not constitute "common subject matter" that is required for the purpose of establishing priority.

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**that are now necessarily being claimed by each limitation (e.g. the limitations 1987 claim interpretations), back in time to the earlier 1981 filing date of the 1981 parent application. The effect of such illicit time travel can be seen in the following example:**

**The scope/meaning that has been given to the term “programming” by applicant’s present 1987 disclosure is broader and encompasses much more than the scope/meaning that was given to this same “programming” terminology by applicant’s original 1981 disclosure. By alleging the 1981 priority date for the pending claims which include this “programming” terminology, applicant is effectively trying to transport the broader 1987 definition of “programming” back to the time of his earlier 1981 application thereby retroactively redefining and broadening the meaning/scope of “programming” at the time of the 1981 disclosure so as to have the later 1987 definition. However, because the same “programming” terminology has been defined differently within the respective 1981 and 1987 disclosures, the “programming” terminology itself does not constitute “common subject matter” and therefor the “programming” terminology from the 1987 disclosure is not entitled to the 1981 filing date of the 1981 parent application.**

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**[It is helpful to remember that this situation exists because applicant elected not to incorporate the 1981 disclosure into the 1987 disclosure. By failing to carry the 1981 disclosure forward into his 1987 new best mode disclosure, applicant has forfeited his right to now claim any and all subject matter from his original 1981 disclosure (i.e. at least all subject matter which was not made part of the present 1987 disclosure). Because the 1981 definition of “programming” was not incorporated into applicant’s 1987 disclosure, the old 1981 definition of “programming” has been forfeited too (the current “programming” recitations necessarily get the 1987 “programming” definition AND its 1987 filing date to boot!)]].**

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**SECTION II:** ( The record appears to be replete with straw man arguments and allegations. This “noise” makes it difficult for the Office to frame the issues that need to be resolved prior to Issue (or at Appeal). The present examiner believes that much of this noise could be eliminated if applicant were to explain away the following “examples of noise” in a simple, clear, direct, and concise manner):

**THE EXAMPLES:**

1) Applicant alleges that “teletext decoders” did not “locally generate” the images that they outputted/displayed. According to applicant, teletext decoders only transferred, to their outputs, displayable image data that was received at their inputs. The examiner rejects such a notion. The following is noted:

a) That, as was exemplified via the discussion provided on page 5 of the appendix that was attached to a 1981 “PETITION FOR RULEMAKING” submitted to the FCC <sup>8</sup>, it was notoriously well known in the art that transmitted teletext data *typically* comprised a “series of instructions” which instructed the teletext decoders on how to “generate” the desired images which were to be outputted/displayed;

b) That conventional teletext decoders *typically* comprised “character generators”; i.e. such “character generators” would not have been required had the received teletext data actually comprised displayable image data as alleged by applicant; and

c) That transmitted teletext data *typically* comprised of ASCII-type codes; i.e. wherein one of ordinary skill in the art would have understood the fact that these ASCII-type codes are not themselves displayable. Specifically, these ASCII-type codes only identified locally stored pixel patterns which were locally retrieved and locally assembled into image frames, e.g. via the “character generators”, in order to locally generate the images that were outputted/displayed.

Clearly, teletext decoders operated to “*locally generate*” the images that they outputted and displayed! <sup>9</sup>

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<sup>8</sup> SEE: APPENDIX IX of this Office action

<sup>9</sup> Character data was “always” transmitted in an encoded non-displayable format by “typical” teletext transmission systems;

e.g. the only exception to this “typical” configuration that the examiner is aware of is “typical” Chinese/Japanese ideograph teletext

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2) Applicant points out that term “computer software” has been described as: “a series of instructions which controls the operation of a computer”. Then, stretching this definition, applicant erroneously suggests that the term “computer software” encompasses: “any series of instructions which controls the operation of a computer”. And finally, using this improperly stretched definition, applicant argues that each series of transmitted cuing codes which were described in his 1981 parent application inherently taught the transmission and/or downloading of “computer software” in view that each of these series of codes represented “instructions which controlled the operation of a computer”. Applicant’s argument is lame. For if one were to adopt applicant’s argument, then in applicant’s new world:

a) a computer mouse and computer keyboard suddenly become generators of “computer software” because they too generate series of instructions which are used to control the operation of a computer;

b) teletext data itself, when received by a CPU implemented decoder, suddenly becomes “computer software” because it too represents series of instructions which are used to instruct a computer as to how to generate an image for display;

c) etc,...

Clearly, applicant’s argument twists the definition of “computer software” in a way that is repugnant to its conventional use/meaning in order to obtain a 1981 effective filing date for something that he did not have in his possession, and/or did not disclose, until 1987; e.g. namely, the downloading of computer software.

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systems being that there were simply too many Chinese/Japanese characters to encode efficiently. Graphics data, on the other hand, was “typically” encoded such that designated bits of each transmitted graphic code could be mapped by the decoder to regions of the display screen so as to generate the graphics image frame that was to be displayed. Yes, even here, a local graphics generator was still required to convert the graphics codes into displayable pixel data. Such a local graphics generator was conventionally implemented either with dedicated logic circuitry or with a “graphics generator” of the “character generator” variety [SEE: the discussion under the headings “Producing the display” and “Graphics” on page 398 of the article “CEEFAQ/ORACLE: reception techniques (part I)” by Money in the 7/1975 issue of “TELEVISION”, and lines 13-21 in column 9 of US Patent #3,982,065].



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**3) While applicant has alleged that his “computer software/programming” recitations should be stretched so as to retroactively find support from things which were not “computer software/programming” <sup>10</sup>(i.e. a series of cuing codes/signals from his 1981 disclosure), applicant also takes the opposite approach by alleging that elements which operated to process signals (i.e. specifically teletext decoders) are not encompassed by the “signal processor” recitations of his pending amended claims <sup>11</sup>. The examiner disagrees. The examiner points out that not only are teletext decoders “signal processors” in any conventional sense of such terminology, but that teletext decoders are in fact “signal processors” specifically within the context of applicant’s own alleged invention. More to the point, the teletext decoders of the prior art and the “SPAM” decoders of applicant’s own alleged invention both operated to extract and process packets of encoded information distributed to them, at least “preferably”, via the VBI of broadcasted and/or cablecasted TV programming; i.e. wherein the packets of encoded information comprised teletext data packets in the case of prior art teletext decoders and comprised SPAM data packets in the case of the SPAM decoders of applicants alleged invention <sup>12</sup>. Being such, applicant’s allegation that conventional teletext decoders should somehow be excluded by the “signal processor” recitations of his pending claims seems to fall under the heading of: “NONSENSE” <sup>13</sup>.**

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<sup>10</sup> This erroneous *reading* has been used to allege support for that which is now claimed back to the 1981 filing date of the 1981 parent application.

<sup>11</sup> This erroneous *reading* has been used to try to distinguish which is now claimed over applied “prior art” of record.

<sup>12</sup> In fact, for reasons which will be addressed in more detail below, the examiner maintains that the “SPAM” data packets of applicant’s alleged invention represent, for all intents and purposes, little more than applicant’s own version of a teletext system in which the function of its teletext data packets have been “extended” so as to carry more than just the normal displayable character/graphics code (e.g. “extended” to carry control signals, Telesoftware, etc,...).

<sup>13</sup> NOTE:

1) that *typical* teletext decoders sequentially performed steps of signal slicing/separation, serial-to-parallel conversion, signal storage, ASCII code to pixel data translation, etc... all which were recognized as having comprised steps of “signal processing” [the last 16 lines on page 5 of the appendix that is attached to the “PETITION FOR RULEMAKING” which was filed with the FCC on 3/26/1981 by the “United Kingdom

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**4) The examiner maintains that applicant's own "SPAM" transmission system, at least as described in the context of television distribution, constitutes little more than applicant's own version of an "extended teletext system" <sup>14</sup>. However, when teletext "prior art" is applied against his claims, applicant becomes hostile to the suggestion that there is any correlation between his own "SPAM" transmission system and conventional teletext transmission systems <sup>15</sup>. Yet, on the other hand, applicant appears to openly believe that the scope of many of his pending amended claims encompasses the "WEATHER STAR" system/receiver technology which, to the extent understood by the examiner, is a teletext based technology <sup>16</sup>. If applicant's claimed/disclosed "SPAM" systems/receivers encompass teletext based systems/receivers such as the "WEATHER STAR" system/receiver technology, then how in the world can applicant possibly suggest that "SPAM" and teletext are not**

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Teletext Industry Group" which explicitly indicates teletext decoders as having performed "signal processing"; and

2) that such processing was even true in the unusual "ideograph" decoders of applicant's argument [i.e. see the block labeled "Teletext signal processor" in figure 10 of the NHK article "A Teletext System for Ideographs" by Numaguchi et al. ].

<sup>14</sup> The term "extended teletext" is being used here to refer to teletext systems which have been "extended" so as to carry other types of information beyond the normal/typical coded teletext character/graphic information. One alleged novel feature of applicant's SPAM packets was its ability to carry and distribute computer software. However, contrary to applicant's allegation, packets of "extended teletext" systems had long been used to carry and distribute computer software too. In fact, the term "Telesoftware" had been specifically coined so as to refer to the "software" that was carried by "extended teletext systems. The point being, that SPAM and Teletext data packets are equivalent right down to there recognized ability to carry other forms of information including "Telesoftware".

<sup>15</sup> Yet a large portion, if not the majority, of the "prior art" cited by applicant pertains to teletext.

<sup>16</sup> SEE: the article "Landmark forms cable weather news network" which was cited by applicant [see appendix VIII attached hereto]

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correlated/analogous technologies/arts when considering applied prior art? Clearly there is a conflict between the two positions.

5) Applicant and his originally filed 1987 disclosure both seem to have alleged that “digital television signals/programming”, of the type that now appears to be recited in his pending amended claims, were notoriously well known in the art at the time of his alleged invention. The examiner has challenged applicant’s apparent allegations. In response to this challenge, applicant has (and continues) to submit U.S. Patent #3,906,480 to Schwartz et al. as having evidenced the conventional “digital television signal” technology on which his disclosure and amended claims were/are allegedly based. The examiner is mystified by this submission. The examiner points out that the cited Schwartz et al. patent describes a computer display system in which a computer was used to generate, albeit digitally, *frames* of vector encoded graphic/character information which were then transferred, via a data bus, to “digital TV monitors” for display thereon. As far as the examiner can tell, the Schwartz et al. disclosure has absolutely nothing to do with the transmission of “digitized TV signals/programming” in any conventional sense of such terminology. Simply trying to figure out how the Schwartz et al. patent might be related to anything that was originally disclosed by applicant in his 1987 disclosure, much less trying to figure out how it could have been used to enable that which was originally disclosed by applicant in his 1987 disclosure, represents an insurmountable invitation to experimentation unto itself. If Schwartz et al. has been cited by applicant out of carelessness, then its submission to the Office for required review and consideration represents nothing less than an unnecessary drain on already limited PTO resources. If, on the other hand, Schwartz et al. was cited out of necessity (e.g. if it actually represents the best showing of his “digital television” recitation that applicant is/was aware of), then its very presence in the record only goes to support the examiner’s position that which is now claimed by applicant, i.e. the subsequently introduced “digital television” recitations, are not supported or enabled by applicant’s originally filed 1987 disclosure.

6) Throughout prosecution, applicant has made many attempts to have the applied Zaboklicki reference [i.e. DE 2,914,981] removed from consideration. In his latest response, applicant argues that the applied Zaboklicki reference should be removed from consideration because the teachings and descriptions provided by this applied prior art reference differ from teachings and descriptions provided by other non-applied members of its patent family (namely, GB #2,016,874). Such a position is

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absurd. If Zaboklicki DE 2,914,981 teaches that which applicant now claims, then the fact that Zaboklicki GB #2,016,874 might not have provided these same teachings (even if proven true) is irrelevant to the fact that the claims are unpatentable over Zaboklicki DE 2,914,981.

7) Within the originally filed abstract of applicant's 1981 parent application (i.e. note S.N. 06/317,510), the term "*programming*" was explicitly defined to mean:

**"everything transmitted over television or radio intended for communication of entertainment or to instruct or inform". [see lines 4-7 in the abstract of US patent #4,694,490]**

Today this definition is in conflict with applicant's present needs (e.g. it too refutes applicant's claim to the earlier 1981 priority date <sup>17</sup>). Being such, applicant now argues that this explicitly stated definition should be ignored and given no weight because the "abstract", as applicant alleges, was not *technically* part of his 1981 written description. The examiner rejects this allegation too. The examiner points out: that the originally filed abstract was certainly part of the originally filed disclosure of applicant's 1981 parent application on which all issues must be considered/based; that the definition of "programming" that was provided by this originally filed abstract is completely consistent with the way that it was used throughout the 1981 disclosure.

8) In order to try to overcome applied prior art of record, applicant has willfully and repeatedly alleged that the Radio and Television broadcast arts represent non-

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<sup>17</sup> The examiner notes that applicant is only entitled to the 1981 priority date for "common subject matter"; i.e. the "same" subject matter that is commonly found in both the present 1987 and the 1981 parent disclosures as originally filed. However, the term "programming" itself does not represent "common subject matter" required for priority because the definition given to it within the present 1987 disclosure is vastly different than the definition given to it via the 1981 parent. Specifically, whenever the "programming" terminology is used in a currently pending claim, section 112-1 demands that it be held to the definition that is explicitly provided via the present 1987 disclosure. This 1987 definition is not entitled to the 1981 priority date in view that the 1981 disclosure explicitly gave the same terminology a different meaning.

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analogous arts. This position is absurd and wholly unsupportable. The examiner points out that the Television broadcast art actually evolved from the radio broadcast art because the original radio broadcast networks represented existing entities who had program distribution resources and expertise which could be easily extended and applied to TV programming; e.g. NBC, CBS, ABC all began as Radio distribution networks which evolved, quite “naturally”, into Television broadcast networks too [NOTE: the last 5 lines of the first paragraph of the first column on page 811 of the article “Versatile Transmission Video Facilities at NBC New York” by Mausler which states that: “the origins of television broadcasting practice may be found in radio”]. In fact, the most significant difference (i.e. if not the only “real” difference) between Radio and Television distribution networks is the difference in bandwidth of the equipment that is required to handle Radio and Television program distributions. Thus, for example, when Hetrich [Australian #74,619] stated that his disclosed “Netcue” system was applicable to either “a network of radio or television stations”, one of ordinary skill in the art would have recognized that this teaching was in fact founded on the underlying understanding that Radio and Television network were in fact analogous arts!!! Applicant’s allegations to the contrary is based on a unrealistically low level of skill in the art.

9) Throughout their dealings with the PTO, applicant has steadfastly maintained that the “*simultaneous or sequential presentation*” recitation, as found in many of their pending claims, represents a “key limitation” in overcoming and/or avoiding “prior art” of record. The examiner strongly disagrees. Specifically, the examiner points out that the alternative expressions “*simultaneous or sequential*” or “*one of a simultaneous and sequential*” simply encompasses ANY AND ALL of the ways by which two types of information could ever be presented to a given audience. Specifically, any time two types of information are presented to a given audience, they must necessarily be presented to that audience either *simultaneously or sequentially* in time. The phrase “*simultaneous or sequential*” covers ALL of the possibilities! Thus, if one can show that a given piece of “prior art” operated to present two types of information to a given audience, then one has in fact implicitly shown that the prior art meets the “*simultaneous or sequential presentation*” limitation of applicant’s claims; i.e. again, the recitation “*simultaneous or sequential*” covers ALL of the way that two types of data could ever be displayed to a single audience!

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10) Applicant clearly failed to carry his original 1981 disclosure forward into the instant 1987 disclosure <sup>18</sup>. Because of this, applicant has forfeited his right to now claim any subject matter that was set forth in the disclosure of his originally filed 1981 parent application, but was not carried forward into the disclosure of his originally filed 1987 parent application <sup>19</sup>. Thus, **APPLICANT IS CLEARLY WRONG** when he alleges that he can secure a 1981 priority date for that which is now claimed by showing “possession” of that which is now claimed via the original disclosure of his 1981 parent application (i.e. NOT for the subject matter that was left behind!). Specifically, not only must applicant show that he possessed the subject matter that is now claimed with respect to the original 1981 disclosure but, more importantly <sup>20</sup>, applicant must first show possession of the same claimed subject matter with respect to the instant 1987 disclosure. Stated another way, to secure priority, applicant must be able to show that he did not forfeit his right to claim the subject matter possessed in his originally filed 1981 parent application by

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<sup>18</sup> The examiner notes that applicant failed to incorporate the original disclosure from his 1981 parent application into the original disclosure of his 1987 parent; i.e. the 1981 disclosure was neither formally copied into the 1987 disclosure nor was the 1981 disclosure “incorporated by reference” into the 1987 disclosure. The original 1987 disclosure simply replaced the 1981 disclosure as “THE INSTANT DISCLOSURE” from which all section 112 issues must be analyzed.

<sup>19</sup> As evidenced by testimony given in ITC investigation #337-TA-392, even applicant and/or his counsel seemed unsure as to exactly what subject matter from applicant’s 1981 parent (“if any”) made it into applicant’s 1987 disclosure.

<sup>20</sup> “More important” in the sense that applicant is prohibited from now claiming anything that is not fully supported in accordance with all of the requirements of section 112-1 by the present disclosure (e.g. the disclosure that was originally filed by applicant in 1987). Specifically, the present claims fall under section 112-1 if they are not fully supported by the present 1987 disclosure even if they were, by some remote chance, fully supported by the disclosure of the earlier 1981 parent.

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showing, *independently* <sup>21</sup>, that he possessed this same subject matter via the originally filed disclosure of his present application too (i.e. with 1987 disclosure).

11) Applicant is only entitled to claim subject matter which was set forth within the originally filed 1987 disclosure of his present application in accordance with ALL of the requirements of section 112-1. Specifically, the examiner refutes applicant's allegations that the original disclosure of his 1981 parent application can be used in place of the instant 1987 disclosure to meet one or more of the section 112-1 requirements (namely, to establish "possession" of that which is now claimed). It is only after proper section 112 support (i.e. including "possession") has first been established for the pending claims from the disclosure of the present application (the 1987 disclosure), that there is even a need to consider applicant's 1981 parent application at all. Simply put, if the pending claims are not supported under section 112-1 by applicant's present disclosure as originally filed, then the pending claims themselves fail to comply with the requirements of section 112-1 and no further questions need be asked <sup>22</sup>. Again, because applicant failed to formally/properly incorporate his 1981 disclosure into his 1987 disclosure, applicant is prohibited from relying on his 1981 disclosure to supplement his present 1987 disclosure (i.e. at least as far as complying with the requirements of section 112-1 is concerned). Stated another way, because applicant's 1981 parent application was never formally incorporated into applicant's present 1987 disclosure, it does not constitute part of applicant's 1987 disclosure, i.e. the *instant disclosure*, from which all section 112-1 support for the currently pending amended claims must be derived.

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<sup>21</sup> If applicant had formally/properly incorporated the written description from his 1981 parent application into his originally filed 1987 disclosure, then there would be no need for these "independent" showings; i.e. applicant could have established "possession" via the originally filed disclosure of his 1981 application alone. It is only because applicant failed to formally/properly incorporate the written description from his 1981 parent into his originally filed 1987 disclosure, that such "independent" showings of "possession" are needed; i.e. because the actions taken by applicant have in fact caused the forfeiture of his right to now claim that subject matter from his 1981 disclosure which was not carried forward into the 1987 application.

<sup>22</sup> At least with respect to the issue of "adequate written description".

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12) It is noted that applicant does not even pretend that the subject matter that is now being claimed represents “common subject matter” which is required to substantiate applicant’s claim to the earlier 1981 filing date<sup>23</sup>. Instead, applicant seems only willing to allege that what is now being claimed represents “correlated subject matter”. Allegations pertaining to the existence of “correlated subject matter” are irrelevant to the issue of priority [e.g. “common subject matter”, not “correlated subject matter”, is required to substantiate such a claim for priority].

13) The examiner notes that the “SPAM” technology, on which the “more sophisticated” systems of applicant’s present 1987 disclosure are based, is vastly different from the “cuing signal” technology on which the “primitive” systems of applicant’s 1981 parent application were based; e.g. the ability of SPAM to carry and distribute “software” being but just one of the more notable differences. Clearly, the “more sophisticated” 1987 alleged inventions that are now *necessarily being claimed*<sup>24</sup> are not entitled to the 1981 filing date of their 1981 “primitive” ancestors; i.e. applicant is not allowed to transport his “more sophisticated” 1987 alleged inventions back in time to the 1981 filing date of his different, albeit sometimes “correlated”, “primitive” 1981 alleged inventions<sup>25</sup>.

14) The issues cited above illustrate a further dilemma that the examiners have faced when trying to read and understand that which is now being claimed by applicant. Specifically, terminology which might seem definite when one looks to the instant 1987 disclosure alone, becomes confusing and indefinite when read in light of applicant’s responses; responses in which applicant has applied newer 1987 interpretations/definitions to the claims in order to establish section 112-1 support and has applied older and different 1981 interpretations/definitions to the same claims in order to obtain the 1981 priority date for the recitations. Thus, at times, it seems to be the record itself that has, or that has at least contributed to, making the meaning and scope of the claims’ recitations unclear. It must also be noted that the claim recitations themselves are often contorted in the attempt to craft them to read

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<sup>23</sup> Corresponding to the “same” subject matter which must be commonly/respectively disclosed in both of applicant’s 1981 and 1987 disclosures, as originally filed, for priority to be established.

<sup>24</sup> See section “11)” of this paragraph.

<sup>25</sup> See section “12)” of this paragraph.



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**independently on different teachings from the two disclosures <sup>26</sup>. Not only does this process results in claim limitations that are difficult to read in that they do not quite fit teachings from either disclosure, but more importantly, the effort involved in this process is wasted effort because the subject matter being claimed/referenced in the two disclosures is not “common subject matter”; e.g. the claims are not entitled to the 1981 filing date even if it could be shown that they can be read on respective (but different) subject matter from the two disclosure.**

**Even so, given a record in which applicant continues to argue that his pending claims are entitled to the 1981 priority date because they can be read in different ways on the 1981 and 1987 disclosures, a situation is created in which the “broadest reasonable meaning” of a claim’s limitations takes on one meaning when defined by the file history itself ( e.g. when based on applicant’s attempt to read each claims’ limitations, improperly, onto two completely different disclosures), and takes on a different meaning when defined, properly, from the originally filed 1987 disclosure by itself. Should the examiner apply the “prior art” according to the interpretations afforded by applicant’s 1987 disclosure alone, or should the examiner apply the “prior art” according to the interpretations created by applicant via his improper reliance on different descriptions from the two 1981 and 1987 disclosures? No matter how you cut it, the result is confusion!**

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<sup>26</sup> For example, ones of applicant’s claims recite “downloadable processor instructions” which has no antecedent basis in either of the originally filed 1987 and 1981 disclosures. Yet it appears that this recitation could, quite properly, be read on the originally described “program instruction sets” (e.g. downloaded software) of applicant’s instant 1987 disclosure. However, when one looks at the alleged support that is put forth by applicant, one finds that applicant has attempted to read the recitation not on the originally described “program instruction sets” of the instant disclosure, but instead on respective (and different) commands/instructions from the 1981 and 1987 disclosures both of which functioned only to trigger actions/operations on the receiver side. Applicant resorts to this interpretation apparently out of recognition that the “program instruction sets”/software of the instant 1987 disclosure has no equivalent in the 1981 disclosure. What results from this process is a claim which looks like it is literally directed to the downloading of software that was described only in the 1987 disclosure, and yet has been afforded the 1981 effective filing of a parent application in which such a downloading feature was NOT disclosed (i.e. effectively transporting the 1987 “downloading of software” feature back in time to the 1981 date of the parent application in which it was not disclosed).

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15) The position set forth by Judge Rich (see "SECTION I" of this Office action) shows that "continuity of disclosure", needed to establish the benefit of priority to an earlier filing date, requires the disclosure of "common subject matter" in a form that meets all of the requirements of section 112-1; e.g. even continuity of "best mode". This evidences the fact that applicant is simply wrong when he alleges that "priority" can be established merely by showing "possession" as of the earliest earlier filing date for which priority is claimed. Applicant seems to have overlooked the fact that the case law which applicant cited in support his erroneous allegation (i.e. *In re Wertheim*) was based on an underlying assumption that the disclosure of the parent application had been carried forward into the disclosure of the continuing application. This underlying assumption does not exist within the current state of applicant's applications and, therefor, the case law that has been cited and relied upon by applicant does not apply to the present fact pattern!

16) At times, applicant seems to be of the opinion that *only* the "enablement" requirement of section 112-1 applies to the issue of "continuity". At other times, applicant seems to be of the opinion that *only* the "description" requirement of section 112-1 applies to the issue of "continuity". On its face, one of these two positions must be wrong (i.e. they are mutually exclusive). In reality, both positions are wrong. As evidenced above, *ALL* of the requirements under section 112-1 apply to the issue of "continuity" ( e.g. even "best mode"). Being such, applicant is only entitled to the benefit of an earlier filing date for claims that are directed to "common subject matter" for which "continuity" has been maintained between the present and the earlier filed application. "Continuity of common subject matter" exists between applications only when there is:

A) Continuity of "written description" between applications for the subject matter being claimed (as defined under section 112-1);

B) Continuity of "enablement" between applications for the subject matter being claimed (as defined under section 112-1); *and*

C) Continuity of "best mode" between applications for the subject matter being claimed (as defined under section 112-1).

[note sections 14 and 15 above]

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**Being such, none of applicant's currently pending amended claims are entitled to the priority date of applicant's 1981 parent application in that the claims are not directed to "subject matter" for which there is has been:**

**a) the required continuity of "written description" between applications;**

**b) the required continuity of "enablement" between applications; *and***

**c) the required continuity of "best mode" between applications. <sup>27</sup>**

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<sup>27</sup> Applicant has argued that he was under no obligation to update his earlier filed disclosure with his "new best mode" when originally filed the present disclosure. The examiner strongly agrees. However, to maintains continuity between applications, applicant was required to at least carry forward the "old best mode" from of his earlier filed application into his originally filed present disclosure. Applicant failed to do this and therefor has not maintained "continuity of disclosure". For example, as was noted in part "13" of this paragraph, the "old best mode" of applicant's 1981 parent application was based exclusively on primitive 1981 cuing technology while the "new best mode" of applicant's present application was based exclusively on the more sophisticated 1987 "SPAM" technology (i.e. extended teletext technology). In view that the primitive 1981 cuing technology was not carried forward into the present 1987 application, e.g. applicant's new 1987 disclosure literally replaced applicant's earlier filed 1981 disclosure in its entirety, the "old best mode" was in fact left behind (i.e. it had to be!). For this reason alone, the pending amended claims are not entitled to the 1981 priority date of applicant's parent application. Again, the pending amended claims are necessarily directed to the systems/methods of applicant's present 1987 disclosure which is based on the more sophisticated "SPAM" technology". Accepting applicant's claim to a 1981 priority date for these pending amended claims would allow applicant to transport claims which are necessarily directed to the 1987 disclosure/technology back in time to the 1981 date of the earlier disclosure/technology. Using this scheme, applicant would be able to improperly transport his new 1987 "best mode"/technology back in time to the 1981 date of his "old best mode"/technology.

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17) It is understood that CIP practice allows an applicant to file a new application containing additional/new subject matter while preserving the applicant's right to claim (and the right to the earlier filing date for) subject matter which was previously disclosed in the parent application. But an applicant's right to claim subject matter from the parent application is only preserved for that subject matter of the parent application which has actually been carried forward (i.e. *incorporated*) into the disclosure of the CIP. Any and all subject matter from the parent application that is not carried forward into the disclosure of the CIP cannot be legally claimed within said CIP; i.e. the right to claim subject matter that is left behind is lost/forfeited with respect to said CIP application. To prevent such a loss/forfeiture, it is common for an applicant to draft the disclosure of his CIP application so that it literally incorporates the entire disclosure of the parent application, e.g. either physically or "by reference", thereby literally carrying forward all of the subject matter from the parent application into the CIP application and in doing so:

A) Preserving applicant's right to claim any/all of the subject matter from the parent within said CIP application; and

B) Preserving applicant's right to the filing date of the parent application for any/all claims which are directed to the subject matter of the parent application that has been carried forward into the CIP application.

In contrast to the common CIP practice described above, when filing his 1987 CIP disclosure, the present applicant elected to draft an entirely new specification and elected not to incorporate the disclosure from his 1981 parent application in its entirety. In fact, when filing his 1987 CIP disclosure, applicant elected to draft the entirely new specification in a way which makes it difficult to impossible to determine if any of the subject matter from his 1981 parent was carried forward into the disclosure of his CIP<sup>28</sup>. Today, faced with the fact that subject matter which was not carried forward (i.e. *incorporated*) into the present disclosure has been lost/forfeited, applicant takes a leap of faith by suggesting that all of the subject matter from his 1981 parent application somehow/miraculously found its way into the new disclosure of his 1987 CIP. Clearly, this is not true. In fact, when one studies the two disclosures in detail, one actually finds that little to none of the subject matter from the 1981 parent made it into the 1987 CIP disclosure in a form that constitutes "common subject matter" [note part 15 above]. For example, even

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<sup>28</sup> Again, the 1987 CIP has clearly injected a "new best mode disclosure" by literally replacing the 1981 disclosure and this, by itself, automatically refutes all claims of priority to the 1981 filing date.

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the subject matter from the two disclosures which looks similar at first glance, is based on vastly different transmission technologies, different scopes/meaning/interpretations, and on a new "best mode" [e.g. note appendix II of this Office action]. Being such, it does not appear that any of applicant's currently pending amended claims are entitled to the 1981 date of applicant's parent application.

18) In the past, applicant seems to have suggested that even if one were to find that applicant's 1981 disclosure had not been carried forward into applicant's later filed 1987 disclosure, one/applicant could still rely on said 1981 disclosure to provide an understanding of the later filed 1987 disclosure with respect to issues under section 112. The examiner notes that only "prior art" can be used for such purposes. Therefor applicant's 1981 can only be used to clarify/supplement his 1987 disclosure if it is found to be "prior art" with respect to the 1987 disclosure. But if the 1981 disclosure is "prior art" for applicant's suggested purpose (i.e. for the purpose of understanding the later filed 1987 disclosure), then it must be "prior art" for issues under sections 102 and 103 too. Thus, for applicant to suggest that his 1981 disclosure be used as "prior art" for the purpose of understanding his 1987 disclosure seems to put applicant, at least potentially, on a very slippery slope; i.e. because if applicant's position were ever *legally* accepted, then applicant's 1981 disclosure would *legally* become "prior art" against the 1987 disclosure for sections 102 and 103 issues too. <sup>29</sup>

19) The examiner notes that many of applicant's currently pending claims recite the following receiving station structures: a) a receiver; b) a signal detector; c) a processor; and d) an output device. Many of applicant's submission have shown that:

a) the recited "receiver" actually refers to nothing more that --a TV tuner--;

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<sup>29</sup> For the record: applicant's 1981 disclosure does not constitute "prior art" with respect to applicant's 1987 disclosure and therefor cannot serve as "prior art" for any purposes. Thus, applicant's 1981 disclosure cannot be used to supplement ones understanding of applicant's 1987 disclosure, with respect to issues under section 112-1, as seems to have been improperly suggested by applicant in the past. Specifically, with respect to section 112 issues, applicant's 1987 disclosure *stands alone*.

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b) the recited "signal detector" actually refers to nothing more than a decoder 203 which extracts and error corrects embedded information from the VBI of TV programming;

c) the recited "processor" actually refers to nothing more than microcomputer 205; and

d) the recited "output device" refers to nothing more than a "TV monitor".

The examiner maintains that all of these recited structures are found within a conventional computer implemented teletext receivers: e.g. noting

a) the TV tuning element (2);

b) the extracting and decoding circuitry 8 and 11;

c) the processing element (13); and

d) the TV monitor/display (6),

evidenced in the showing of BETTS [GB 1,556,366].

This further highlights the direct correlations that exists between the "SPAM" distribution system of applicant's alleged invention and the "teletext" distribution systems of the "prior art". In fact, the examiner believes that applicant's "SPAM" is synonymous with conventional "Extended Teletext" [note: parts "3)" and "4)" of this paragraph; part "A)" under "SECTION XI" of this Office action; etc,...];

20) Applicant's originally filed instant disclosure clearly taught away from the "interactive" ultimate receiver station configuration that is now being claimed. Namely, as originally described, one of the key advantages allegedly offered by applicant's alleged invention was the fact that its "ultimate receiver stations" produced their respective personalized audio/video presentation "automatically"; e.g. without any manual input from the viewer whereby and in a manner whereby the complex processing that was involved remained hidden from, and transparent to, the viewer [SEE: lines 27-34 on page 11 of applicant's instant disclosure as originally filed; lines 18-20 on page 91 of applicant's instant disclosure as originally filed; lines 13-34 on page 427 of applicant's instant disclosure as originally filed; etc,...]. Despite this original teaching, applicant continues to submit claims into the record which, according to applicant's own allegation, are directed to "interactive" implementation of the originally disclosed non-interactive "ultimate receiver stations". The section 112-1 problem is immediately apparent.

21) As originally described, the "ultimate receiver stations" of applicant's alleged invention produced the combined image of applicant's figure 1C by additively mixing the images of figures 1A and 1B in their entirety; i.e. this fact explains why

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**the “line” of figure 1A had to be produced “on a background color that is transparent when overlaid on a separate video image” as was described in applicant’s originally filed disclosure [see lines 9-14 on page 25 of applicant’s instant disclosure]. Despite this original teaching, applicant continues to submit claims which recite some type of keying process (e.g. a process in which respective images are now combined in less than their entirety). Again, the section 112-1 problem is immediately apparent.**

**22) etc,...**

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**SECTION III :** (Even though it falls short of requiring in haec verba support, section 112-1 still imposes a substantial burden on an applicant to clearly and concisely set forth in his originally filed disclosure that which the applicant intends to claim, e.g. that which the applicant understands to be his/her invention(s). For it is only by being clear and concise, that an applicant can actually establish that he/she *possessed* that which he/she claims with relative certainty.)

1. While section 112-1 does not require that in haec verba support for each of applicant's amended claims' limitations be found within applicant's originally filed instant disclosure, section 112-1 does require that the currently claimed subject matter to have been described sufficiently well in the originally filed disclosure, e.g. *clearly and concisely enough*, so that one skilled in the art would have "immediately discerned" all of the limitations that are now being claimed from the instant disclosure at the time the disclosure was originally filed. For if one would not have "immediately discerned" that which is now claimed from the originally filed instant disclosure, then one could not be sure that applicant truly possessed what he now claims as of said original filing date. The point being that the written description requirement of section 112-1 still places a heavy burden on an applicant to draft his disclosure in a fashion that clearly and concisely sets forth that which he intends to



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claim, even though it falls short of requiring in haec verba support for the claims.

As to the actual weight of this burden, it is noted that even having “discernibly” described that which applicant he now wishes to claim is not good enough under section 112-1; e.g. nothing less than “immediately discernible” will do.

It is the examiner’s position that which is now claimed by applicant was not described by applicant’s originally filed disclosure in the required “immediately discernible” fashion. The following is noted:

A) The examiner emphasizes the fact that he understands that the written description requirement of section 112-1 does not require that there be in haec verba support in applicant’s originally filed disclosure for the subject matter being claimed via applicant’s pending amended claims. Rather, section 112-1 “only” requires applicant’s originally filed disclosure to have conveyed to those of ordinary skill in the art, with reasonable clarity, that applicant actually possessed what he now claims. So how does one go about determining whether possession was conveyed with “reasonable clarity”? Well, for each pending claim, one makes determination as to whether one skilled in the art would have “immediately discerned” all of the claim’s limitations from the disclosure at the time that the disclosure was originally filed. Here, it must be noted that with respect to the instant application the pending amended claims currently before the Office were not part of the originally filed disclosure and therefor cannot serve as a basis/source of the teachings that are relied on to provide the required section 112-1 support. For the description requirement of section 112-1 to have been fulfilled, it must be judged that the subject matter recited by each amended claim and its limitations was taught and would have be “immediately discernible” from the originally filed disclosure alone (e.g. absent knowledge and teaching of the subsequently filed claims).

B) Under the present circumstances, attempting to determine whether or not applicant possessed what is now claimed is made ever more difficult by the fact that it is so unclear as to what it is that is now being claimed: for how can one begin to determine whether applicant possessed what he now claims, if one cannot determine exactly what it is that is now being claimed? The reason for this uncertainty is due, in no small part, to the fact that applicant has elected to try to introduce unsupported conventional art-specific terminology into his originally filed disclosure by way of the pending amended claims. In an attempt to justify the introduction of such unsupported terminology into the original disclosure under section 112-1, applicant

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has been forced to give the added terminology meanings and/or scopes which are repugnant to their normal/conventional/expected meanings and/or scopes as understood by those of ordinary skill in the art. Namely, applicant has been forced to twist and/or stretch the conventional meaning of the added art-specific terminology in order to allege that there is section 112-1 support in his originally filed disclosure for the introduction of the terminology into his disclosure "today". However, because twisted/stretched definitions must be attached to the conventional terminology that is now being injected into the record, and because applicant's originally filed instant disclosure does not set forth these required twisted/stretched definitions (i.e. how could it when it does not even contain the terminology that is now being added), the examiner would be remiss if he did not demand that applicant at least commit clear and concise definitions for this subsequently added terminology to the record: e.g. wherein the provided definitions must be consistent with the scope of applicant's originally filed disclosure. For there is simply no place that the public can go to obtain applicant's stretched/twisted definitions if they are not formally recorded as part of the record. However, applicant seems unwilling to formally commit his stretched/twisted definitions to the record; i.e. possibly out of fear of being estopped, at some future date, from arguing that the added terminology literally encompasses its normal/conventional interpretations too (i.e. normal/conventional interpretations for which there is clearly no section 112-1 support in applicant's instant disclosure). So, instead of committing his stretched/twisted definitions to the record, applicant resorts to misdirection by arguing that it is the examiner's duty (and not applicant's) to read and understand the originally filed instant disclosure and to come up with claim interpretations which have proper 112-1 support. Applicant even goes so far as to express an interest in "learning from others", e.g. from examiners, ways in which his claim limitations might be interpreted so as to find proper section 112-1 support. The present examiner is only willing to go down this avenue to the extent necessary to try to apply "prior art" against the amended claims in hope of furthering the present prosecution (e.g. a difficult task given the examiner's limited understanding of exactly what is being claimed). As to the burden of actually locating the required section 112-1, the examiner notes that once applicant has been properly challenged, the burden of showing section 112-1 support for the amended claims shifts to applicant. To the extent of his current understanding, it is the examiner's opinion that one skilled in the art had little chance of discerning (and no chance of "immediately discerning") that which applicant now claims from said originally filed disclosure because:

- 1) The apparent and obvious meaning of the claims, e.g. given the apparent/obvious definitions of the added art-specific terminology, is different and/or inconsistent with that which was actually described in applicant's originally filed disclosure.

- 2) *Many/most* of the interpretations which must be applied to the currently pending claims' limitations, and subsequently introduced art-specific terminology, in order for them to be read back onto something that was

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originally disclosed by applicant are known only to applicant (if at all). There is simply no way for one of ordinary skill in the art to have “immediately discerned” that which is now located only within an applicant’s head. <sup>30</sup>

3) Applicant’s originally filed instant disclosure described a transmission system which comprised a large number of system components. Applicant’s originally filed instant disclosure also described a limited number of ways/“examples” by which the components of his described transmission system could be organized/configured/activated in order to have performed a specific handful of disclosed operations/methods/processes [i.e. see the “TABLE OF CONTENTS” of applicant’s disclosure]. While applicant’s currently pending claims are clearly directed to operations/methods/processes, each claim does not appear to be directed to a respective one of the handful of operations/methods/processes that were originally described. Instead each of the recited operations/methods/processes appears to be a hybrid of the originally disclosed operations/methods/processes in that each of the recited operations/methods/processes appears to contain a mixture of steps from different ones of the originally described operations/methods/processes. <sup>31</sup> The examiner maintains that the originally filed disclosure does not provide the required section 112-1 support for these recited hybrid operations/methods/processes. Namely, the examiner maintains that each step that is now being recited by each claim which so as to define a recited “method” was not originally described in the context of the specified “sequence”/“method” in which it is now finds itself vi the amended claims. <sup>32</sup>

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<sup>30</sup> Specifically, the examiner notes that only those interpretations which happen to have been uncovered during the course of the prosecution have come within in the examiner’s domain. To date, applicant seems unwilling to share these required interpretations with the examiners/PTO; again, by contending that determining the scope/meaning of his own pending claims is a function to be performed by the examiners, not by applicant.

<sup>31</sup> Note for example, as set forth by applicant himself in appendix A of applicant’s last response, how the alleged support for the limitations of each pending claim comes from teachings that are scattered throughout the 557 pages of the originally filed written description; whereas, on the other hand, the 557 pages of the instant disclosure are themselves neatly divided into sections/“chapters” that describe respective ones of a handful of originally disclosed operations/methods/processes.

<sup>32</sup> Applicant’s disclosed system structure itself does not implicitly describe any and all methods which could have been produced by randomly mixing and matching the stated functions of the systems components; e.g. indeed, applicant is now limited to

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C) Applicant's 1981 disclosure set forth a television distribution system that distributed a plurality of different digital codes within the VBI of its distributed TV programming, wherein ones of these distributed codes operated only to "cue"/trigger the execution of specific segments of pre-loaded software by "devices" which were remotely located throughout the television network. The 1981 disclosure referred to these cuing codes as: "instructions" and "commands". Today, applicant argues that because a series of such distributed cuing codes represented a series of instructions/commands for controlling the operation of a pre-programmed processor they should be interpreted, in some twisted hindsight sense, as having specifically comprised/taught the downloading of *computer software/programming*. The examiner rejects this position noting: that the 1981 processor was in fact a "pre-programmed" processor; and that not every series of instructions/commands constitutes *computer software/programming* as applicant must now allege/suggest in support of his current position. Again, applicant's current position is equivalent to arguing that a computer input device, e.g. such as a mouse, generates computer software/programming because it also provides a series of coded instructions/commands which trigger the execution of specific segments of computer software/"programming" by a computer. Wrong! It continues to be the examiner's position that the series of coded instructions/commands which triggered a programmable device to execute designated portions of pre-loaded software, e.g. that which was disclosed in applicant's 1981 parent application, did not (and does not) constitute computer software/programming in any conventional sense/use of the terminology. The twisted/stretched/repugnant scope and meaning which applicant now tries to attach to conventional computer software/programming terminology, for the purpose of alleging section 112-1 support for this recited feature back to the 1981 filing date of the parent application, does not pass section 112-1 muster<sup>33</sup>. However, applicant's attempt to twist/stretch the conventional meaning

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now claiming only those "methods" which were actually described in an "immediately discernible" fashion by applicant's originally filed instant disclosure.

<sup>33</sup> While applicant uses *distorted* definitions/interpretations of conventional terminology to justify their subsequent introduction into his original disclosure/claims under 112-1, the record suggests that applicant fears being held to these distorted definition/interpretations should the claims ever be patented. However, applicant should be held to these distorted definitions if they are the basis from which section 112-1 support is obtained from his own disclosure. Otherwise, applicant would be allowed to obtain patent coverage over the subject matter that is literally encompassed by a normal/conventional reading of such art-related terminology when, in actuality, applicant obtained such patent coverage only through a distorted reading of the same claim/limitations/terminology;

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of the “computer software/programming” terminology in a way which encompasses the sequence of transmitted coded cuing signals/“instructions” disclosed in his 1981 parent application exemplifies the kind of *word games* that the examiners have struggled to deal with throughout the prosecution of applicant’s 329 co-pending applications. This kind of twisting also exposes how far applicant is needs to deform the obvious/apparent meaning of his pending amended claims to allege that 112-1 support exists for the recited subject matter that is now being claimed. Again, in the year 2000, applicant is contending that the transmission of a series of cuing codes which triggered the execution of pre-stored software, e.g. that which was actually taught within applicant’s 1981 parent disclosure, provides (in hindsight) section 112 support for the subsequent introduction of recitations that have been drafted so as to literally recite/capture the downloading of computer software/programming. Nothing could be further from the truth.

The continuing inability of the examiners at the PTO to locate and determine the scope/meaning of the terminology and recitations used throughout applicant’s currently pending amended claims from applicant’s originally filed 1987 disclosure, in spite of years of effort, suggests to the present examiner that there are probably many more absurd (e.g. wholly unsupported) allegations of alleged claim support still hidden below the waterline of the current record (and hidden within the tens of thousands of pending amended claims). Namely, the twisted arguments/allegations of record only seem to represent those which have been exposed/uncovered to date; i.e. the visible tip of an iceberg. If such is the case, then the examiner has no choice but to rely on section 112-1 rejections in order to encourage applicant to provide the much needed clear and accurate explanations as to where the pending amended claims and the subsequently added terminology finds required section 112-1 support from the instant disclosure as originally filed; i.e. obviously, the examiner has no way of “immediately discerning” recited claim limitations if the basis for such recitations exist only within applicant’s “own head”. Further, if the pending claims are truly based on such exemplified absurd (e.g. wholly unsupported) allegations of claim support, then all of applicant’s demands for the examiners to determine the scope/meaning of applicant’s currently pending claims have been completely disingenuous; i.e. applicant could not possibly expect an examiner to discern (much less “immediately discern”) the meaning/scope of the pending claims when the apparent/normal meaning of subsequently introduced terminology is vastly different from the meaning/scope that must be attached to them by way of applicant’s arguments (arguments which are not yet part of the record). For example, the examiner maintains that it would be improper for applicant to now draft amended claims to literally recite the “downloading of computer software/programming” while, at the same time, antedating prior art by twisting the conventional/apparent meaning of this

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the claims should be held to their distorted readings.

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terminology to be read (i.e. to be misread) on the 1981 description of transmitted cuing codes; i.e. a seemingly blatant attempt to obtain a 1981 priority date for something that applicant did not have in his possession until 1987. Applicant seems to justify such actions by alleging that he has only asserted his right to be his own lexicographer. The examiner thinks not...

D) Again, at first glance, the meaning of many of applicant's currently pending amended claims seems explicitly clear. Specifically, applicant's currently pending amended claims explicitly recite interactive television systems, digital television systems, intermediate television stations for generating user "specific" overlays and/or graphics; etc, ...<sup>34</sup>. However, when one turns to applicant's originally filed 1987 disclosure to locate the required section 112 support for this explicitly recited subject matter, one is immediately lost; i.e. nothing that is now claimed is "immediately discernible" from the originally filed disclosure. Specifically, in reading the original 1987 disclosure, one quickly finds that the explicitly claimed subject matter has no obvious/apparent/"immediately discernible" support within applicant's originally filed 1987 disclosure.

Again, applicant tries to justify this situation by arguing that his "right to be his own lexicographer" gives him the right to draft and submit any amended claim/limitation he wishes as long as APPLICANT himself can allegedly produce, at some later date, an interpretation which allows the amended claims and their amended claim limitations be read back onto something/anything that was described by his originally filed 1987 written description (or as long as applicant can allege that it is the examiner's duty to come up with an interpretation which allows applicant's amended claims' limitations be read back onto something/anything that was described by his originally filed 1987 written description). The examiner maintains that both arguments are wrong. For no matter how applicant now elects to draft his current claims/limitations, said claims/limitations must still meet the requirements of section 112-1; wherein the description requirement of section 112-1 is only met if one skilled in the art would have "immediately discerned" the newly drafted claim/limitation within applicant's originally filed 1987 disclosure. Thus, in contrast to applicant's allegation, the "right to be his own lexicographer" only gives applicant the right to draft and submit those claims/limitations whose alleged interpretations would themselves have been "immediately discerned" by those skilled in the art from applicant's originally

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<sup>34</sup> Note too the wide scope of technology that has been alleged by applicant as having been within, and/or at least alleged to

be covered by, patents that are based on applicant's 1981 and 1987 disclosures [SEE: Applicant's own web page attached hereto as "APPENDIX V"].

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filed 1987 written description <sup>35</sup>. Being such, if extensive arguments/explanations must also be submitted by applicant along with the subsequently submitted claims in order to enable one skilled in the art to begin to “discern” that which is now claimed from applicant’s originally filed 1987 disclosure, then written description requirement of section 112-1 has been violated because it is the subsequently submitted argument which attempt to complete the originally filed disclosure with respect to the subject matter that must be extensively explained in this way.

Given the present circumstances, the examiner maintains that it is only through the use of the proverbial “sledgehammer”, provided by applicant’s arguments submitted more than a decade after the original 1987 filing date of the present disclosure, that applicant even begins to impart a sufficient degree of deformation to the clear/apparent meaning of his currently pending claims/limitations as to enable them to be read onto something from his own originally filed 1987 disclosure. There is no way that one skilled in the art would have “immediately discerned” that which is now claimed from applicant’s 1987 disclosure without the guidance of such subsequently filed arguments. As noted above, this is a violation of section 112-1.

In summary, it appears that each of applicant’s currently pending amended claims might be clearly, distinctly, and explicitly reciting subject matter of an alleged invention that is now recognized applicant. Unfortunately, the subject matter that is now being clearly, distinctly, and explicitly recited by these claims does not appear to be that of an invention that was originally described by applicant, in the required “immediately discernible” fashion, within the originally filed 1987 instant disclosure. The claims themselves appear to represent “NEW MATTER”. This issue, and those discussed above, will be revisited in greater detail within the “SECTIONS” that are to follow.

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<sup>35</sup> Applicant might be permitted to add new terminology to the disclosure via amended claims provided that he also explicitly defined the new terminology in a way that was consistent with the original scope of his original disclosure (i.e. appropriate estoppel). However, if for example the term “programming” was used in applicant’s originally filed 1981 disclosure as meaning “scheduled radio and television shows” (as it was), applicant is not permitted to come back at a later date with arguments which try to attach a new and broader dictionary definition to the originally disclosed “programming” terminology and then use this new broader definition as the basis/support for drafting claims directed to computer software/“programming” (as seems to be happening). Namely, the definition of terminology that is provided by applicant’s original disclosure trumps any dictionary definition as being the proper definition that must be applied/used.

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**E) Part "A" of this section was provided to establish the fact that the examiner understands that the "immediately discernible" requirement of section 112-1 pertains to the issue of "possession". Having said this, it is noted that parts "B"- "D" of this section have been provided to show that the question of "possession" under section 112-1 is extensively intertwined with section 112-2 issues by the way that applicant has elected to draft his claims; i.e. by the introduction of new terminology of twisted scope/meaning under the guise that applicant is only utilizing his "right to be his own lexicographer". Being such, the rejections of the claims under section 112-1 and section 112-2 may appear, at times, a bit tangled. This should not be construed, in itself, as an indication that the examiner misunderstands the laws that are being applied.**



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**SECTION IV: (All of Applicant's Pending Amended Claims Should Fall Under Section 112-1).**

**2. ATTENTION:**

THE WRITTEN DESCRIPTION OF APPLICANT'S 1981 PARENT WAS ITSELF LEFT BEHIND BY THE ACTION, OR LACK OF ACTION, TAKEN BY APPLICANT WHEN DRAFTING AND FILING OF THE INSTANT 1987 DISCLOSURE. THERE IS ABSOLUTELY NOTHING APPLICANT CAN SAY OR DO TO CHANGE THIS FACT. SIGNIFICANTLY, APPLICANT'S FAILURE TO INCORPORATE THE 1981 DISCLOSURE INTO THE PRESENT 1987 DISCLOSURE MEANS THAT ALL SECTION 112-1 SUPPORT FOR THE PENDING AMENDED CLAIMS MUST FIRST BE IDENTIFIED WITHIN APPLICANT'S PRESENT 1987 DISCLOSURE AS ORIGINALLY FILED, BEFORE THE WRITTEN DESCRIPTION OF APPLICANT'S 1981 PARENT DISCLOSURE

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**EVEN NEEDS TO BE CONSIDERED [i.e. one cannot assume that the subject matter of applicant's 1981 disclosure made it into applicant's 1987 disclosure as would have been the case had the 1981 disclosure been literally incorporated, e.g. either physically or by an *incorporation by reference*, into the 1987 disclosure].**

*Given the above, there is a problem with the way applicant has responded to the section 112-1 issues that have been raised by the Office/examiners during the prosecution of many, if not all, of applicant's 329 co-pending applications. To fully grasp the significance of this problem, it must be understood that the requirements of section 112-1 for the current application(s) can only be met if it can be shown that section 112-1 support for each of the pending amended claim existed within the present 1987 disclosure as originally filed and taken alone. Only after all section 112-1 support has been established for the pending amended claims from the originally filed present 1987 disclosure (alone!), is there even a need for*

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**one to consult and consider the 1981 parent disclosure and, even then, only for issues relating to claims of priority to the 1981 filing date of said parent.**

The reason why applicant's 1981 parent disclosure must be ignored when considering section 112-1 issues is because said 1981 disclosure was never *formally* incorporated into the present 1987 disclosure:

- 1) The 1981 disclosure was not physically copied into the present 1987 disclosure; and
- 2) The 1981 disclosure was not "*incorporated by reference*" into the present 1987 disclosure.

Being such, applicant has forfeited his right to now claim any and all subject matter from his 1981 parent disclosure which was not carried forward and described in the new 1987 written description at the time of its original filing. There is no question such forfeiture has in fact occurred. For example, the "JULIA CHILDS" embodiment/application that was described in applicant's 1981 parent disclosure was not carried forward into applicant's 1987 disclosure and has thereby been forfeited from being claimed now. Much more (if not all) of the 1981 subject matter has been forfeited too [see "SECTION I" of this Office action].

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In light of the above, it is clear from the record that applicant has erroneously addressed section 112-1 issues by citing teachings from the 1981 parent disclosure often without, but sometimes in combination with, teachings from the present 1987 disclosure. Again, the showing of section 112-1 support must be obtained from the present 1987 disclosure as originally filed without any assistance from the 1981 parent disclosure; i.e. hence, applicant's error in citing the 1981 parent disclosure. In the past, when applicant was confronted with this error, applicant took the position that they actually elected to cite the 1981 disclosure out of their thoughtfulness for the person(s) reviewing the record because applicant and their experts recognized that the 1981 parent disclosure was significantly shorter than the present 1987 disclosure and took less time and effort to read/review/understand <sup>36</sup>. More recently, however, when applicant was confronted with making this same error again, applicant took the position that it was all a misunderstanding in that they were confused by what the Office/examiners' meant via terminology such as: "the disclosure as originally filed", "the written description as originally filed", etc,... As explained by applicant, they allegedly believed that the examiners were referring to the 1981 parent disclosure as the "original" disclosure when making section 112-1 rejections..... (even though, in almost the same breath, applicant

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<sup>36</sup> Note the first full paragraph on page 252 of part I of ITC Investigation No. 337-TA-392 which begins "At closing arguments complainant's council argued..." [1997 ITC LEXIS 307, 252].

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**acknowledged understanding the fact that the required 112-1 support must come from the present 1987 disclosure and not the 1981 parent disclosure).**

**While the explanations given by applicant for their erroneous citations to the 1981 parent disclosure must be accepted by the examiner, it is noted nonetheless that their alleged *thoughtfulness* for others was a boon to themselves too. Specifically, benefits which were improperly obtained by applicant via their erroneous citations to the 1981 parent disclosure, are evident in the following:**

**1) The present 1987 disclosure is (at best) large, bulky , and difficult to read and/or understand, even by applicant's account <sup>37</sup>, thereby making applicant's task of having to find/cite/establish section 112-1 support for the pending claims from the 1987 disclosure an arduous chore (if not an impossible chore). The burden placed on applicant by their need to find/cite/establish the required 112-1 support for the pending claims was obviously lessened by the erroneous citations to the 1981 parent disclosure, if for no other reason, simply because the 1981 parent disclosure was smaller,**

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<sup>37</sup> A feeling applicant's own expert witness elegantly expressed in ITC Investigation No. 337-TA-392 when he stated that:

"when I received the '277 patent [i.e. the present 1987 disclosure], my heart truly sank because I knew I would have to read and absorb the patent" [see the discussion starting in the last few lines of part I of 1997 ITC LEXIS 307\*250].

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**less bulky, and not as difficult to read and understand when compared to the present 1987 disclosure;**

**2) If the teachings provided by the 44 pages of the 1981 parent disclosure ever found their way into the 557 pages of the present 1987 disclosure then, by applicant's own admission, they were (at best) scattered throughout the 557 pages of the present 1987 disclosure<sup>38</sup>. Thus, any section 112-1 support which may have been clear and concise in the 1981 parent disclosure, would have been scattered (at best) and/or lost within the 557 pages of the present disclosure. By scattering and/or losing the teachings from their 1981 disclosure within the 557 pages of the present 1987 disclosure, applicant has made the task of re-capturing any clear and concise section 112-1 support which might have existed in the 1981 parent disclosure, via the originally filed present 1987 disclosure, an arduous if not impossible journey.**

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<sup>38</sup> See the first 4 lines on page 252 of part I of said ITC Investigation No. 337-TA-392 which states that applicant's council admitted at closing arguments of the preceding that: "the disclosure in the 24 columns of the '490 patent [i.e. the 1981 parent disclosure], if indeed it is at all carried forward, is interspersed among some 328 columns of the '277 patent [i.e. the present 1987 disclosure]". The ITC investigation also noted: 1) that the present 1987 disclosure is almost 10 times the length of the parent disclosure and more than 500 pages of text longer than the 44 page parent disclosure; and 2) that applicant's own council admitted that the teaching found in said 44 pages of the 1981 parent disclosure were, at best, "spread around and sometimes stated a little bit differently [in the 557 pages of present 1987 disclosure]".

SEE the discussion starting at the top of page 253 of part I of ITC Investigation No. 337-TA-392.

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**However, applicant could sidestep the need for this arduous/impossible journey, albeit improperly, through erroneous citations to the 1981 parent disclosure; i.e. if, and only if, applicant's erroneous 1981 citations were improperly accepted by the examiners/reviewers themselves. The current examiner will make every effort not accept such improper 1981 citations from applicant!**

**3. As is evident from the discussion of the preceding paragraph, time and time again, applicant has *erroneously* alleged that required section 112-1 support for his pending amended claims can be obtained solely from his 1981 parent disclosure. When confronted, time and time again, applicant has retreated from this position and has acknowledged that section 112-1 support for the limitation of the currently pending claims must come from applicant's present 1987 disclosure as originally filed; i.e. not from the parent 1981 disclosure as referenced by applicant. By now, it would seem reasonable to expect that there would be no more misunderstandings pertaining to this issue. However, for some unexplained reason, applicant still seems inclined to take every opportunity to return to his 1981 parent disclosure when addressing section 112-1 support issues; i.e. even though applicant clearly understands such action to be wrong, erroneous, and irrelevant to the pending section 112 issues. Applicant's illicit addiction to their own 1981 disclosure seems**

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evident in that applicant continues to try to improperly find a quick fix for his section 112-1 woes via his 1981 parent disclosure by arguing:

*“The function of the descriptive requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.” In re Wertheim, 541 F.2d 257,262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). Applicants rely on the filing date of November 3, 1981. On this date, Applicants filed Application No. 317,510, now issued as U.S. Patent No. 4,694,490 (the ‘490 patent). The specification of the ‘490 patent (the ‘81 disclosure) clearly demonstrates the Applicant had possession of the subject matter presently claimed.”*

With respect to the current state of applicant’s applications, applicant’s position is once again wrong and misleading !!! What the ‘490 patent (the ‘81 disclosure) shows is irrelevant to the 112-1 issue currently being addressed because the written description of applicant’s 1981 parent was left behind and replaced via the drafting and filing of applicant’s present 1987 “new best mode disclosure”. Namely, applicant’s 1981 parent disclosure was never formally incorporated into the present 1987 present disclosure and thus the written description of said 1981 parent is not part of said present 1987 written description. Therefor the 1981 written description must be ignored when addressing issues under section 112. Simply put, applicant’s 1987 written description has literally replaced



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applicant's 1981 written description as the "present written description" from which all section 112 support must now be obtained/shown/derived/provided.

The following is noted:

- a) Applicant must be able show that section 112 support for his pending amended claims actually existed in his present 1987 disclosure at the time of its original filing;
- b) If section 112 support for the pending claims cannot be found in applicant's original 1987 disclosure, then the search for section 112 support simply ends there: support for the pending claims does not exist and the pending claims fall under section 112; and
- c) *Only if section 112 support can first be found in applicant's original 1987 disclosure* must applicant even be afforded an opportunity to use his 1981 disclosure, and even then, only for supporting allegations of "priority" to the 1981 date via showings of "common subject matter".

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**4. Evidence of record demonstrates that, in the past, applicant and their counsel seemed unsure as to whether the written description of their 1981 parent disclosure had made it into the written description of their present 1987 disclosure. For example, Part I of ITC Investigation No. 337-TA-392 states:**

**A) That applicant's counsel admitted during closing arguments of that proceeding that: "the disclosure in the 24 columns of the '490 patent [the 44 page 1981 disclosure], if indeed it is at all carried forward, is interspersed among some 328 columns of the '277 patent [the present 557 page 1987 disclosure]". 1997 ITC LEXIS 307, \*252 (emphasis added); and**

**B) That applicant's counsel made the statement:**

*"To the extent -- and I'm unaware of any significant differences between the '490 patent [the 44 pages of the 1981 parent disclosure] and the '277 [the 557 pages of the present 1987 disclosure]. I haven't seen one, and I don't remember it. Certainly, I made an effort early on to determine whether or not the disclosures of the '490 patent [the 44 pages of the 1981 parent disclosure] made their way into the '277 [the 557 pages of the present 1987 disclosure] and although they're spread around and sometimes stated a little bit differently, for all relevant purposes of this hearing, the '490 patent [the 44 pages of the 1981*

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*parent disclosure] is expanded by the '277 [the 557 pages of the present 1987 disclosure]. Its certainly not inconsistent.”*<sup>39</sup>

[1997 ITC LEXIS 307, \*252]

In sharp contrast to this past uncertainty, today not only does applicant appear to have new confidence that his 1981 parent disclosure actually made it into his present 1987 disclosure, but applicant now appears to remember having “specifically” incorporated his 1981 parent disclosure into their present 1987 disclosure. Applicant’s new position and recollections appear to represent 180 degree changes from those past position and recollections as presented before the ITC. For this reason alone, the examiner would be remiss if he were to accept applicant’s most recent memory/allegation at face value.

For practical purposes, given the present circumstances, it seems impossible to determine how much (if any) of applicant’s 1981 parent disclosure was actually carried forward into his present 1987 disclosure using the “brute force” approach of trying to compare the respective disclosures in their entirety. Fortunately, such a direct comparison is not required. Specifically, before applicant can even attempt to establish a 1981 priority date for his pending amended claims, applicant must first be able to prove/show that

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<sup>39</sup> Here, applicant’s council alleged that they were unaware of any “significant differences” between their ‘490 patent [the 1981 parent disclosure] and the ‘277 patent [the present 1987 disclosure]. The ITC dismissed this allegation out of hand stating somewhat sarcastically: “there is at least one significant difference in the specifications of the ‘490 and ‘277 patents, viz. the fact that the ‘277 specification is more than ten times the length of the ‘490 specification.” 1997 ITC LEXIS 307, \*253 On a less sarcastic note, the examiner points out that there are many other “significant” differences too [note “SECTION I” of this Office action].

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**section 112-1 support for the pending amended claims was provided in his present 1987 disclosure at the time it was originally filed (i.e. by at least identifying those portions of the 1987 disclosure which described each/all limitations of each/all pending claims in an “immediately discernible” fashion <sup>40</sup>). If applicant is unable to identify such support in his originally filed 1987 disclosure, then the pending amended claims fall under 112-1 (... no further questions need be asked ... and applicant’s 1981 disclosure can be ignored entirely).**

**5. As prosecution has progressed over the last 5+ years, it seems increasingly apparent that applicant has drafted and/or amended many of his pending amended claims, if not all of his pending amended claims, to literally read on devices/technologies that are in (or are coming into) the marketplace <sup>41</sup> ; i.e. the “Weather Star” addressable receiver being but one example of such devices/technologies <sup>42</sup>. It is the examiner’s current understanding that applicant is permitted to draft/amend claims in this manner provided that the**

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<sup>40</sup> The examiner notes that applicant has been asked to provide specific showings of such 112-1 support for each of his pending claims practically from the beginning of prosecution some 5+ years ago.

<sup>41</sup> The examiner’s perception appears to be supported by evidence already in the record [See: Civil Action No. 2:95cv242 which was decided on September 8, 1995 by the United States District Court for the Eastern District of Virginia, Norfolk Division (1995 U.S. Dist. LEXIS 14518, \*\*5)]. Also, note APPENDIX V of this Office action.

<sup>42</sup> Civil Action No. 2:95cv242 which was decided on September 8, 1995 by the United States District Court for the Eastern District of Virginia, Norfolk Division (1995 U.S. Dist. LEXIS 14518, \*\*4)].

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**resulting claim(s) meet all requirements of section 112** <sup>43</sup>. It is, however, the examiner's belief that the applicant's currently pending amended claims fail to meet these section 112 requirements.

Applicant seems to be of the opinion that his right to be his own lexicographer gives him the right to draft any claim he wishes, provided he can make the argument that the terminology and limitations used in his newly drafted claim can be read and interpreted in some fashion (i.e. any fashion), which allows these terms and limitations to be read onto at least some portions of his originally filed written description <sup>44</sup>. While the examiner acknowledges that applicant has the right to be his own lexicographer, the examiner maintains that this right does not give applicant the freedom to violate other requirements of section 112. For example, the examiner notes that:

1) Section 112-1 requires applicant to be able to show that his original 1987 disclosure, e.g. absent his subsequently filed claims, conveyed with reasonable clarity to one of ordinary skill in the art that applicant was in fact in the possession of his subsequently filed claims (i.e. the alleged invention) at the time that applicant originally filed said 1987 disclosure;

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<sup>43</sup> Assuming that "laches" does not apply and that the claims are patentable over the "prior art" too (note APPENDIX VI of this Office action).

<sup>44</sup> THE originally filed written description, and not the 1981 written description of the parent.

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2) Section 112-1 requires applicant to be able to show that one of ordinary skill in the art, in reading applicant's originally filed 1987 disclosure, would have immediately discerned the limitations at issue in any and all pending claims<sup>45</sup> ; and

3) Section 112-1 prohibits applicant from disclosing a "forest" in his originally filed disclosure only to, at some later date, use subsequently filed claims as a vehicle for selecting "trees" from this forest and declaring the subsequently selected group of trees to be: "my invention!". (Because the subsequently claimed/selected group of "trees" was not specifically identified/recognized by the originally filed disclosure as having comprised an alleged invention, the subsequently claimed/selected group of trees was not adequately described in the original disclosure, the subsequently claimed/selected group was effectively lost/concealed within the forest that was originally disclosed, and/or the subsequently claimed/selected group of trees represents "NEW MATTER")

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<sup>45</sup> The examiner maintains that this requirement alone sets the bar at a level which is high enough to reject /sink all of applicant's pending claims under section 112; i.e. the limitations of applicant's pending claims are far from being "*immediately discernible*" from his present 1987 disclosure.

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**It is the examiner's position that all of applicant's pending amended claims are in violation of these three requirement of section 112-1.**

**6. A showing of adequate section 112-1 support should be as easy as pointing to that portion/section/example of applicant's original written description which described that which is now being claimed. In fact, Applicant has alleged that his 1987 specification was: "a single cohesive document with each section and example incorporating, extending, and developing the preceding disclosure." If this is true, then identifying 112-1 support should be an easy chore in that applicant should simply be able to point to the alleged section/example which allegedly (all by itself) incorporated, extended, and developed the preceding disclosure on which it was allegedly based; i.e. assuming such support is in fact immediately discernible as is required. At most, applicant might have to provide a cursory explanation as to how the limitations of the pending claim are supported by such identified "EXAMPLE"/"SECTION". So where is it? Instead of citing a section/example and quickly explaining how support is provided for each claim the cited example/section, applicant has shown that he feels the need to provide massive exhibits which map limitations of the pending amended claims to scattered portions of the present omnibus 1987 disclosure <sup>46</sup>. However, even when one improperly relies on these subsequently filed**

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<sup>46</sup> Undoubtedly, applicant might respond to this issue by arguing that his grand submission was somehow required by the

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mappings, the limitations of the claims are still not immediately discernible. This is due, in no small part, to applicant's use of language, wording, terminology, and expressions throughout their pending the amended claims which find no antecedent basis, and therefore find no immediately discernible support, in the present 1987 disclosure as originally filed; i.e. this newly introduced language, wording, terminology, and expressions have not been explicitly defined by applicant's originally filed disclosure as is required when applicant elects to invoke his right to be his own lexicographer.

Throughout the present prosecution, applicant has improperly used the amended claims as *treasure maps*<sup>47</sup> for providing the direction that is needed to collect bits and pieces of the original written description which, when taken as a whole, provide some sort of alleged description for that which now claimed via these same amended claims. The examiner

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actions of Office /examiner. Such a position would be ridiculous. All the Office/examiner's have ever requested, was for applicant to cite that portion of the disclosure which described that which is now claimed in an "immediately discernible" fashion as is required under section 112-1.

<sup>47</sup> In light of applicant's latest submissions, the examiner adopts the positions set forth in *related* ITC investigation No. 337-TA-392 [1997 ITC LEXIS 307 \*257] that:

- 1) applicant's citations of alleged support read "like the directions to a treasure hunt....There is a piece here, there's a piece there, its in there somewhere"; and
- 2) that applicant's pending claims and original 1987 specification "are like ships passing at night in the same ocean, but not necessarily sailing in the same direction."

[see the second full paragraph on page 257 of PART 1 of 2 of ITC investigation No. 337-TA-392]



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flatly rejects applicant's position that these collected excerpts provide the adequate written description that is required for that which is now claimed in view that the alleged support for the limitations in anything but "immediately discernible". However, even if these collected excerpts were to provide an adequate written description, it would have been the collecting of the excerpts by applicant's newly created/claimed *treasure map(s)* which fulfilled the written description requirement of section 112-1; i.e. not applicant's original written description alone as is required by section 112-1. Via applicant's recent submissions, applicant has simply gone through a circular exercise in which amended claims, filed subsequent to the original filing date of the application, were themselves used as the source of support for their own limitations; i.e. the attempted use of new matter to support the introduction of itself. Simply put, it only through the use of applicant's most recent massive submissions, filed 12+ years after the filing of the original 1987 disclosure and 18+ years after the 1981 filing of the parent disclosure, by which applicant now tries to create/provide/complete the section 112-1 support that was required of his original written description filed 12+ years ago. The practice of retroactively creating section 112-1 support for limitations of subsequently filed amended claim in any manner is a practice which is unquestionably prohibited under current U.S. patent law.

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7. As was recognized by applicant's own experts <sup>48</sup>, the amount of effort that is required to read and absorb much/most/all of applicant's original 1987 disclosure represents nothing less than an unpleasant and difficult task. However, the excessive amount of effort that is needed to read and absorb applicant's originally filed 1987 disclosure simply pales in comparison with the monumental task of trying to decipher the limitations of applicant's currently pending amended claims based on such a difficult disclosure. Specifically, trying to read and understand the currently pending amended claims, whose word selection/usage drastically depart that of applicant's originally filed 1987 disclosure, in the context of said original 1987 disclosure which is difficult to read/absorb in its own right, further explains why the limitations of applicant's pending claims are not "immediately discernible" from applicant's original 1987 disclosure. This situation is in fact a fatal flaw under section 112-1 given the present fact pattern. Namely, the currently pending claims are amended claims which were added to the original 1987 disclosure long after the original 1987 filing date of the present disclosure and, therefore, all recitations found within these claims must be, by the requirements of section 112-1, "immediately discernible" from the originally filed 1987 disclosure itself. Here, it is important to note that the courts have set

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<sup>48</sup> Applicant's own expert witness stated, in ITC Investigation No. 337-TA-392, that: "when I received the '277 patent [i.e. the present 1987 disclosure], my heart truly sank because I knew I would have to read and absorb the patent" [see the discussion starting in the last few lines of part I of 1997 ITC LEXIS 307\*250].

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the section 112-1 “bar” high for subsequently amended/presented claims due to the potential introduction of “NEW MATTER” via such subsequently drafted/filed claims.

It must be noted that those representing the PTO have long expressed to applicant the difficulty that the examining corps was having in its effort to ascertain the meaning/scope of applicant’s pending amended claims based on applicant’s originally filed 1987 disclosure. In fact, near the beginning of prosecution, those representing the PTO asked applicant to submit a communication in each application which would identify at least one concrete example of the alleged support in applicant’s originally filed 1987 written description for each of the pending claims as an aid to the examiners. In response to this requests, applicant contended that they were/are under no obligation to provide such examples or explanations and has expressed their belief that it is the examiners’ duty to read and understand their 1987 disclosure in order to ascertain the metes and bound of the pending claims. Applicant went so far as to characterize their own pending amended claims as being: “models of clarity”.

Given the record before him, the examiner finds applicant’s position and directives to be a bit disingenuous. To this point, applicant is reminded that in at least one meeting between representatives of the PTO and applicant, applicant was presented with one of their own independent claims and were asked to explain/summarize where the section 112-1 support for it could be found in their own 1987 disclosure. After more than 20 minutes of near silence, during which applicant and counsel flipped through their own files in an

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obvious attempt to explain and identify support for their independent claim, applicant's representatives indicated that they were unprepared to discuss/explain the alleged support for the claim in question. At this point, applicant and counsel were reminded that the claim in question was an independent claim which inherently represented the broadest patent coverage over which applicant sought the "right to exclude" and, being such, it seemed reasonable and fair to expect that its scope/meaning/support would/should be readily apparent to applicant's representatives without extensive preparation; certainly within the 20+ minutes allotted to applicant and his counsel during the meeting. Yet, applicant and representative insisted on departing the meeting without addressing the meaning/scope/support of the independent claim in question. The examiner believes that this event shows/suggests that at least some of the limitations of applicant's pending amended claims were/are, at times, not "immediately discernible" even to applicant themselves.

The examiner poses the following questions:

- 1) If applicant cannot immediately discern what they have claimed in their own broadest independent claims, then what chance (if any) does one skilled in the art (or an examiner) really have when embarking on this same endeavor for multitudes/thousands of pending independent and dependent claims?
- 2) Is it really reasonable for applicant and their own counsel to dismiss, out of hand, the difficulty that the examiners are having in

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**reading and understanding applicant's pending claims when applicant and his own counsel have shown, on at least one occasion, that they too have difficulty in summarizing/explaining at least one of their broadest independent claims ( at least when not extensively prepared to do so)?**

**3) Can a broad independent claim actually be considered a "model of clarity" when applicant and their own counsel cannot summarize its meaning/scope/support within 20+ minutes? If so, then exactly what does applicant mean by his expression: "a model of clarity"?**

**The current record before the Office shows that the PTO/examiners continue to struggle in their attempts to determined the scope and meaning of applicant's pending claims. The current record shows that the International Trade Commission (ITC) <sup>49</sup> struggled in its attempt to determined the scope and meaning of a few related claims. The current record even shows that applicant and their own counsel have struggled, i.e. on at least one occasion, in their attempts to explain the scope and meaning of one of their broadest independent claims. If such a struggle to understand the presently pending claims in the present application is justified, then the presently pending claims are in fact fatally flawed under section 112-1 because (once again):**

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<sup>49</sup> In investigation No. 337-TA-392 [1997 ITC LEXIS 307]

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**1) The pending claims in this application are amended claims which were drafted/filed well after the original filing date of the present disclosure and thus, in accordance with section 112-1, their limitations must be “immediately discernible” from the 1987 disclosure; and**

**2) One would not have to struggle to understand the scope and meaning of a claim whose limitations meet the “immediately discernible” requirement of section 112-1.**

**It is the examiner’s position that the currently pending claims are fatally flawed for this reason alone.**

**8. The record seems to show that applicant has, at least in the past, drafted claims for the expressed purpose of reading on products which are being developed in the marketplace <sup>50</sup>. If applicant has drafted the currently pending claims for the same purpose, then this might explain many of the problems which have and will be discussed within this Office action, such as:**

**1) Why applicant appears to persist in the effort to obtain allowed claims which incorporate terminology that was not present, supported, and/or used**

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<sup>50</sup> Civil Action No. 2:95cv242 which was decided on September \*, 1995 by the United States District Court for the Eastern District of Virginia, Norfolk Division [ see the last 3 sentences of the paragraph which begins “The defense of laches raised...” on page 899F. Supp.239,\*241 or page 1995 U.S. Dist. LEXIS 14518,\*\*5 Also, note APPENDIX V of this Office action.

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in applicant's present 1987 disclosure as originally filed, but which terminology has now come to have widely recognized/accepted meanings in the television art that has evolved since said original filing of applicant's present 1987 disclosure (e.g. the term "digital television"; the term "interactive television"; etc,...);

2) Why applicant appears to insist on drafting claims whose interpretations must be pulled, twisted, prodded and stretched by subsequently filed submissions (arguments and explanations) before they even begin to resemble something which was actually described in applicant's originally filed 1987 disclosure; and

3) Why applicant feels the need to present an unusually and/or overwhelmingly large number of new/amended claims (i.e. 10,000+) that are allegedly based on the relatively limited original written description (i.e. number of words, number of pages, content, etc,...) that is comprised of those cited portions from which all claims allegedly originated.

In fact, given the issues cited above and in the record, one might reasonably believe that applicants have focussed too much of their efforts on drafting claims to read on products in the marketplace, and have failed to focus enough of their efforts on

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**ensuring that their drafted claims find the support that is required under section 112 from the originally filed 1987 disclosure alone. This might also explain applicant's apparent need to amend the same claims over and over again in a continuing quest for "further clarity".**



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**SECTION V: (Applicant's Pending Claims are not Entitled to the 1981 Priority Date of the Parent for reasons given in "Section I" above).**

9. At best, the systems/methods that were described in applicant's 1981 parent disclosure represent "primitive" versions of some of the systems/methods that are now described in applicant's present 1987 disclosure. Because the descriptions of these 1981 "primitive" embodiments were not carried forward into the present 1987 disclosure, applicant has in fact forfeited his right to now claim these primitive embodiments in his currently pending 329 co-pending applications; i.e. the present application included. Specifically, section 112 support for all of the currently pending claims must come from the present 1987 disclosure as originally filed and alone [see "SECTION III" of this Office action]. Being such, all limitations of the currently pending claims are necessarily directed to that which is described in the present 1987 disclosure; namely, the more "sophisticated" systems/methods of the present 1987 disclosure. These 1987 "sophisticated" systems/methods clearly constitute "different" subject matter" from the "primitive" systems/methods whose descriptions were left behind in the 1981 parent disclosure. Accordingly, the

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**“subject matter” of the 1981 parent does not constitute “common subject matter” with respect to the “subject matter” that is now necessarily being claimed and, therefor, the currently pending amended claims are not entitled to the priority of the 1981 filing date of the parent (e.g. the validity of the currently pending claims rests solely on applicant’s 1987 “new best mode disclosure”, which represents “new matter” with respect to applicant’s 1981 parent disclosure, and thus automatically refutes applicant’s claim to the 1981 priority date). In summary, applicant’s pending amended claims are not entitled to priority because:**

**A) Applicant’s pending claims cannot be directed to the “primitive” systems/methods of the 1981 parent disclosure because the written description pertaining to these “primitive” systems/methods never made it into the present written description. Thus, via section 112-1, applicant has forfeited his right to claim this “primitive” subject matter here and now;**

**B) The written description of applicant’s 1981 parent did not describe the “sophisticated” systems/methods of the present 1987 disclosure to which all of the recitation of the currently pending claims must necessarily be directed. Thus, there is simply no basis for granting a 1981 priority date to claimed “sophisticated” systems/methods which were not previously described/disclosed in the 1981 parent; i.e. these currently claimed system/methods were not disclosed until the filing of the present disclosure in 1987 and therefor only get the 1987 date.**

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**NOTE that if the currently pending amended claims, which are necessarily directed to the “sophisticated” systems/methods of the present 1987 disclosure, were improperly granted the 1981 priority date of their primitive ancestors, then said currently pending claims would effectively become “time machines” for transporting these necessarily recited “sophisticated” systems/methods of applicant’s present 1987 disclosure back in time to the 1981 filing date of their primitive ancestors. Such time travel is not permitted under current U.S. Patent Law.**

10. Applicant continues to suggest that he is entitled to the 1981 priority date of his parent application simply by showing that the written description of his 1981 parent disclosure met the descriptive requirement of section 112-1 for the currently pending amended claims. This might have been true had applicant’s 1981 written description been formally incorporated into applicant’s present 1987 disclosure <sup>51</sup>.

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<sup>51</sup> CIP applications are often drafted by grafting new written descriptions onto the original written description of the parent application. In such circumstances, the written description of the CIP application literally includes the written description of the parent application and, therefore, the written description of the parent literally constitutes the “subject matter” that is “common” to both applications. Because this “common subject matter” exists within the written description of the CIP, it can be claimed by the claims of the CIP application under section 112-1. Because this same “common subject matter” also exists in the parent application, it is entitled to the priority date of the parent application even when claimed within the CIP application.

In drafting his 1987 CIP application, applicant did not simply graft new written descriptions onto that of the parent

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However, in the present application, this is not true because the written description of applicant's 1981 disclosure was literally replaced by the written description of the present 1987 disclosure given the way in which the present 1987 disclosure was drafted and filed [note "SECTION III" of this Office action]. Therefor, to establish 1981 priority for a given pending amended claim, applicant must actually go through his present 1987 disclosure in order to get back to the 1981 date of his parent disclosure; i.e. applicant cannot go directly to his 1981 parent application as would be the case had the 1981 disclosure been formally incorporated into the 1987 disclosure. Specifically, because of the present fact pattern:

1) Applicant must first identify exactly where the present 1987 disclosure described in "immediately discernible" fashion that which is now being claimed in the given pending amended claim; and

2) Then, applicant must identify "common subject matter" in the 1981 disclosure which provided this "same" section 112-1 support for the given claim.

Here it must be emphasized that in order for priority to be established, the pending amended claims must be directed to subject matter that is "*common*" to both of

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application as in the case described above. Instead applicant wrote an entirely new written description which replaced that of the 1981 parent application. Because the written description of applicant's CIP does not literally include the written description of the parent application, one cannot assume that it represents "common subject matter" at all. Being such, allegation of "common subject matter" and "priority" must now be proven with showings and supporting evidence.

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**applicant's present 1987 written description and applicant's 1981 parent written description. Priority is not established via allegations of "*correlated* subject matter".**

**11. Again, applicant is not allowed to use allegations of priority as a "time machine" for miraculously transporting alleged inventions from his 1987 disclosure back in time to the 1981 filing date of his parent application. For example, applicant cannot identify the recited "transmission of instructions" in his currently pending claims as being directed to the "downloading of software" as is found only within his present 1987 disclosure, and then legally allege priority for this recited "subject matter" back to the 1981 filing date of his parent disclosure by arguing that the same "transmission of instruction" recitations can be broadly read on the non-analogous transmission of "non-software type cuing/instruction signals" that was described in the 1981 parent disclosure. These two vastly different interpretations of the same claim recitation encompass different subject matter and not the "common subject matter" that is required for a proper claim to priority. Specifically, applicant is only entitled to priority for that subject matter which he disclosed in 1987 which he previously disclosed in 1981 too. The "downloading of software" described in 1987 was not disclosed in applicant's 1981 parent application and is, therefor, not entitled to priority.**

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Throughout the present prosecution, when alleging “priority” to the 1981 date of his parent application, it is the examiner’s expressed belief that applicant has unwittingly confused his ability to draft “quasi-generic” claims, e.g. a claim which can be interpreted DIFFERENTLY so as to read on DIFFERENT subject matter from his different 1981 and 1987 disclosures, with the process of establishing “priority” wherein it must be shown that a given pending amended claim is directed to subject matter that was itself “*common*”/*disclosed* in both disclosures. Namely, for priority to be granted, applicant must be able to show that the disclosed/claimed subject matter of the present 1987 application represents the same subject matter (i.e. “common” subject matter) which was disclosed/described earlier in his previously filed 1981 parent application; why in the world would (or should) “priority” be granted otherwise? In contrast, in order to read his own pending amended claims on both of his 1981 and 1987 disclosures, applicant has clearly given each claim vastly different 1981 and 1987 claim interpretations which, by definition, constitutes “*different*” subject matter; not the “common subject matter” that is required for priority. Being such, Appendix A of applicant’s last response actually refutes applicant’s own claim to priority for his pending amended claims because this Appendix shows, given applicant’s own claim interpretations, that the pending amended claims are not directed to “subject matter” that was “common” to both disclosures. For example, “SPAM” has been explicitly cited in Appendix A of

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applicant's last response as having represented the "subject matter" of the present 1987 disclosure to which limitations from every pending amended claim are directed/supported under section 112-1. Yet "SPAM" itself does not represent "subject matter" found within applicant's 1981 parent disclosure and therefor does not constitute "common subject matter" that is entitled to the 1981 priority date of the parent <sup>52</sup>. The "transmission of instructions" recitations, as discussed earlier in this paragraph, represents another specific example of cited support from applicant's submitted Appendix A which evidences the fact that the currently pending claims/limitations are not entitled to 1981 priority. "Appendix II" of this Office action offers many more showings of such differences too.

12. For emphasis, only if applicant successfully identifies portions of the present 1987 disclosure which supports each limitation of each pending claim under section 112-1 in an "immediately discernible" fashion, need/will applicant even be given the chance to establish priority to the earlier 1981 date. To establish priority to the

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<sup>52</sup> Here, it is important to note that the commands/instructions which were transmitted by the system described in applicant's 1981 disclosure appear to be little more than embedded cuing signals whereas the commands/instructions which were transmitted by the system described in applicant's present 1987 (i.e. SPAM) are clearly of a much more sophisticated "extended teletext" type nature. Clearly, it would be wrong to give applicant's 1981 priority date to applicant's more sophisticated and "new best mode" 1987 embodiments.

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earlier 1981 date, applicant must **ADDITIONALLY** show that the “subject matter” of the portions of the present 1987 disclosure which were identified as having provided section 112-1 support for each limitation of each pending amended claims, was in fact “common” with respect to subject matter previously described in identified portions of the 1981 parent disclosure. “*Common* subject matter”, however, is vastly different from applicant’s alleged “correlated subject matter”. It is worth noting that trying to prove the existence of “common subject matter” in applicant 1981 and 1987 disclosures is not an easy or trivial task because even those teachings from the 1981 parent which supposedly made it into applicant’s present 1987 disclosure are at best, by applicant’s own admission, “worded differently” and “scattered” throughout 557 pages of the new 1987 disclosure; i.e. at best, they too are anything but “immediately discernible”!

13. The examiner notes that terms and phrases that are recited in applicant’s pending amended claims are entitled to the 1981 priority date of applicant’s 1981 parent disclosure if, and only if, they are used in a manner that conveys “common subject matter”; i.e. subject matter that is common to both the 1987 and 1981 disclosures. Thus, any recited term or phrase which must be interpreted differently



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when read back onto the two disclosures, is not entitled to priority <sup>53</sup> (e.g. given the present fact pattern). Specifically, any term or phase which has two different meanings/scopes when read in the context of the two disclosures, respectively, does not convey “common subject matter” and is therefor not entitled to the 1981 priority date of the parent disclosure.

The examiner notes that the original disclosure of the present application defines the terminology “programming” differently than the original disclosure of Parent Application S.N. 06/317,510. Specifically:

a) The original disclosure of the present application explicitly defined the term “*programming*” to mean: “everything that is transmitted electronically to entertain, instruct, or inform including television, radio, broadcast print, and computer programming as well as combined medium programming” [see lines 5-8 on page 11 of the present written description]; while in contrast

b) The original disclosure of Parent Application 06/317,510 explicitly defined the same “*programming*” terminology to mean: “everything transmitted over television or radio intended for communication of entertainment or to instruct or inform” [see lines 4-7 in the abstract of US patent #4,694,490].

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<sup>53</sup> Given the fact that the 1981 parent was not physically incorporated into the present 1987 disclosure.

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As has been fully addressed in "SECTION III" of this Office action, all of the currently pending must derive section 112-1 support from the present application (i.e. the original 1987 disclosure). Being such, when one of these claims recites "programming", one must turn to the 1987 disclosure in order to determine the scope/meaning of the recited terminology. Hence, the recitations of "programming" of the currently pending claims must be interpreted as having the meaning/scope that is set forth by definition "a)" from above. However, the definition set forth for the term "programming" in by the present 1987 disclosure [e.g. definition "a)" from above] is clearly of a much broader scope/meaning than the way this same "programming" terminology was defined within the context of the original 1981 parent [e.g. definition "b)" from above]. Being such, the term "programming" itself does not represent "common subject matter" that is entitled to the 1981 priority date. Again, accepting applicant's claim to priority for a currently pending claim which includes the "programming" terminology would allow applicant to obtain a "time machine" by which the broader 1987 scope/meaning of the "programming" terminology could be illegally carried back into the earlier 1981 disclosure/date of the parent application; i.e. effectively redefining and broadening meaning/scope of the "programming" as it appears within the context of the original 1981 disclosure. This is not allowed under current US Patent Law.

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As will be addressed in “SECTION V” of this Office action, applicant appears to have alleged that the terms “instruction”, “command”, and “data” are all of the same scope/meaning as used within applicant’s present 1987 disclosure. Whether true or not, the examiner notes that this terminology takes on different meanings/scopes between applicant’s present and parent disclosures and thus is not entitled to the priority date of the parent applicant; i.e. for example, the terminology has been defined to encompass downloaded computer software only within the present 1987 disclosure, not the 1981 parent [see “APPENDIX II” of this Office action]. Again, accepting applicant’s claim for priority for a claim using this terminology would enable applicant to illegally transport the 1987 meaning/scope of the terminology back in time to the 1981 date of the parent application.

14. One of the devices in the marketplace, to which many of applicant’s claims appear to be directed, is the “WEATHER STAR”<sup>54</sup>. The “WEATHER STAR” is an addressable receiving device that operates at “intermediate transmission stations” to overlay downloaded regional weather data onto broadcasted national

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<sup>54</sup> Note Civil Action No. 2:95cv242 which was decided on September \*, 1995 by the United States District Court for the Eastern District of Virginia, Norfolk Division [ see the last paragraph on page 899F. Supp.239,\*240 and the first paragraph on page 899F. Supp.239,\*241]

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weather TV programming, prior to retransmission by the “intermediate transmission stations”; i.e. thereby “specifically tailoring” the nationally broadcasted weather programming to each region in which the national programming is rebroadcast by “intermediate transmission stations”. In contrast to the “WEATHER STAR”, the combined medium receiver and display device that was actually described by applicant was a receiver which operated at “ultimate receiving stations”; and not “intermediate broadcast stations” as in the case of the “WEATHER STAR” (“ultimate receiving stations” represent the final destinations, e.g. household receivers, of the TV broadcasts that are broadcast/rebroadcast from the “intermediate transmission stations”). As originally described in applicant’s originally filed 1981 parent application, applicant’s combined medium receiver operated to generate and display “unique”, locally generated, user information over received TV programming; i.e. thereby “uniquely tailoring” the received TV programming for each ultimate receiver station/user (i.e. in contrast to “specifically tailoring” as in the case of the “WEATHER STAR”). What is significant here is that the “Weather Star” system operated to download regional weather data to its regional receivers such that the regional data was region “specific” but not necessarily receiver “unique”; i.e. all receivers in each region would receive and overlay the same regional data. In contrast, at least as was originally described in applicant’s 1981 parent application, each of applicant’s combined medium receivers

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generated and displayed data which was “unique” to each receiver; i.e. each receiver generated and displayed data derived on the content of a user’s “unique” stock portfolio. Only in hindsight and/or as an afterthought, e.g. specifically in a 312 amendment that was filed in application No. 06/829,531<sup>55</sup>, did applicant realize a desire/need to replace the term “unique” with the term “specific” in claims that were based on his parent 1981 disclosure. Significantly, the changing of this terminology effectively removed from applicant’s claims, *merely by chance (?)*, a limitation which clearly highlighted real structural/operational differences between applicant’s disclosed/claimed combined medium “ultimate receiver station” and the “WEATHER STAR” “intermediate transmission station”. More significantly, as explicitly explained by applicant in said 312 amendment of S.N. 06/829,531, changing “unique” to “specific” in the pending claims represented a real change in claim scope in that applicant now wanted his claims to explicitly encompass a situation where the user data might not be “unique” as had been originally described in applicant’s original 1981 parent disclosure, but which now might only be user “specific” (*but was this actually a situation that had been recognized/possessed by applicant at the time he originally filed his 1981 parent disclosure?*). Most significantly, applicant’s alleged justification for changing “unique” to “specific” being that there could obviously (not explicitly!) have been some remote chance

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<sup>55</sup> Similar amendments were also made to the claims in application 06/317,510.

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that two of applicant's described users/receivers could have actually have contained the same numbers and types of stock shares in their stock portfolios and, if this situation by some unlikely chance occurred, then the user data for these users/receivers would not, literally, be "unique" as was originally described in the 1981 disclosure.

Given the real change in scope that was caused by the introduction of the "specific" terminology to the 1981 disclosure, the current examiner is of the position that the currently pending amended claims which use this "specific" terminology (i.e. in place of "unique") are not entitled to the 1981 priority date of applicant's 1981 parent disclosure in view that applicant's 1981 parent, as originally filed, does not provide adequate section 112-1 support for the use/definition of that has been given to the subsequently introduced "specific" terminology by applicant's subsequently submitted arguments. The point being, that the record shows that the "specific" terminology was not simply added as a broad term to broaden the scope of the claims, but was instead specifically "coined" and "added" to the originally filed disclosure for the stated purpose of capturing a specific situation which was not conveyed/described in applicant's 1981 parent disclosure at the time of original filing. Again, it is the current examiner's position that applicant's right to be his own lexicographer does not give applicant the license to violate the description requirements of section 112-1 (i.e. a license to add *NEW MATTER*).

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## **SECTION VI: (All of Applicant's Pending Amended Claims**

**Fall Under Section 112-2 Too).**

15. The term “program” had a specific meaning when used in the context of *the radio and television broadcast arts*: “a scheduled radio or television show.” The examiner maintains that this specific meaning was unquestionably how the “program” terminology was used/defined within the context of applicant’s own 1981 parent disclosure; i.e. a fact, written in stone, from which applicant nonetheless still tries to run/escape <sup>56</sup>.

While the term “program” was unquestionably used in the context of applicant’s 1981 parent disclosure in the conventional sense to refer to “scheduled radio and television shows”, it is not so clear as to whether this specific meaning holds true within the context of applicant’s present 1987 disclosure. Specifically,

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<sup>56</sup> The fact that the term “program” was used in applicant’s 1981 in the conventional sense to refer to “scheduled radio and television shows” is not only implicitly clear via its use in the context of the 1981 written description, but it is explicitly clear via the definition provided for the terminology in abstract of the 1981 disclosure [note US Patent #4,694,470]. Applicant’s current position that no weight should be given to his own abstract is simply ridiculous especially in view that this abstract only states explicitly that which is already implicitly clear from the rest of applicant’s 1981 written description [NOTE: lines 5-13 of column 4, lines 47-49 of column 4, lines 4-11 of column 5 in the context of lines 10-24 of column 17; lines 23-26 in column 6, lines 28-52 in column 10, etc,... (of US Patent #4,694,490)].



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while it is acknowledged that early portions of the present 1987 disclosure explicitly defined the term “program” in a manner that generically encompassed other alleged types of programs and programming from environments outside the radio and television art, it appears that this generic definition of the “program”/”programming” only holds true in those rare instances where the terminology was being used in the context of 1987 disclosure that was allegedly universal/generic to all distribution environments. More specifically, as best understood by the examiner, the “program” and ”programming” terminology in the present 1987 disclosure appears to revert back to its specific/conventional meaning (i.e. “*scheduled radio and television shows*”) whenever and wherever it was used, not in a generic/universal sense, but specifically within the context of radio or television program/programming distribution; i.e. as it was within the context of applicant’s 1981 parent disclosure. Being such, any time a pending claim includes recitations which specifically limit that claim to the TV program/programming transmission/broadcast/distribution environment, one must ask himself/herself whether it makes any sense within the context of applicant’s 1987 disclosure to read recited “program”/”programming” terminology as having the universal/generic meaning which encompassed environments outside the television and/or radio

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**broadcast art to which the claim is explicitly limited? The answer to this question seems to be: “ABSOLUTELY NOT!”<sup>57</sup>.**

**16. Applicant contends that he should be allowed to use “television signal/program” terminology to refer to his disclosed “SPAM” message packets rather than, or in addition to, using this same terminology to refer to broadcasted/cablecasted television signals which comprised actual television programming/shows. The examiner continues to object to such a use of the “television signal/program” terminology for the following reasons:**

**1) As best understood by the examiner, applicant’s 1987 disclosure described an ancillary/insertion signal transmission system in which ancillary/insertion signals, e.g. in the form of SPAM message packets, were embedded into broadcasted/cablecasted television programs/shows for the expressed purpose of:**

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<sup>57</sup> If applicant’s claim to the priority of the 1981 disclosure is ever accepted, then all terminology that is used in the claims must be interpreted as having a meaning that is common to both disclosures. Thus, the term “program” would have to be held to the narrower definition of the 1981 disclosure; i.e. “a scheduled television or radio show”.

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*A. Enhancing the content of the broadcasted/cablecasted television/radio programs/shows at the ultimate receiver station(s); and/or*

*B. Controlling the operations performed by downstream devices located at intermediate or ultimate receiver stations.*

Given the above, the examiner maintains that it is improper for applicant to confuse his own transmitted ancillary/insertion signals, e.g. the SPAM message packets, with his own broadcasted/cablecasted television programming/shows into which his own SPAM ancillary/insertion signals were inserted; i.e. the examiner refutes applicant's position that his right to be his own lexicographer gives him the right to cause/create such confusion in the way such well known terminology is being used. More specifically, the examiner maintains that applicant's amended claims and arguments become vague, indefinite, confusing, convoluted, and/or improper when applicant suggests that he has used well known "television signal", "television program", "digital television signal", and "digital television program" terminology to refer to his own ancillary/insertion SPAM message signals rather than, or in addition to, the

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cablecasted/broadcasted television signals/programs of his own originally filed disclosure.

2) The examiner maintains that the terminology “a television signal” and “a television program” were used and understood by those of ordinary skill in the art to mean and refer to video signals whose sequences of raster scanned image frames were to be displayable on a standard TV receivers. Likewise, the examiner maintains that the modified version of this terminology, e.g. “a digital television signal” and “a digital television program”, was known and understood by those of ordinary skill in the art to mean and refer to digitized versions of such “television signals” and said “television programs”. Specifically, the examiner maintains that a “digital TV signal” or a “digital TV program” was understood to be a digitally encoded composite TV signal such as that now transmitted within DBS systems and those that are now obtained by standard MPEG encoding ; i.e. not to insertion/ancillary signals like applicant’s own SPAM message packets and conventional Teletext message packets whose purpose was to enhance, and not carry, the content of conventional TV programs/shows. Simply put, applicant’s *SPAM* was not “digital

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**television” in the exact same way that conventional *Teletext* was not “digital television”<sup>58</sup>.**

**3) Given that set forth in parts “1” and “2” of this paragraph, the examiner points out that the only place within applicant’s entire 1987 disclosure where there is any suggestion as to the transmission of “digital television” was within the description of “Example #7” that begins on page 288 of the written description. For the reasons which were fully addressed in the last Office action, the examiner maintains his position that this description was not enabled by the original disclosure<sup>59</sup>.**

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<sup>58</sup> The examiner notes that such a bastardized use/definition of the “digital television” terminology might have been accepted had this use/definition been explicitly coined by applicant’s disclosure as originally filed (i.e. as required when an applicant wishes to employ his right to be his own lexicographer). Such a bastardized use/definition of the “digital television” terminology will not be accepted now in view that it materialized via subsequently filed amended claims pending 13+ to 19+ years after applicant’s original filing; i.e. materializing in the hindsight afforded by 13+ to 19+ years of real technological trends, advancements and innovations that have occurred in the television art since applicant’s original filing. Preventing invention-via-drafting-of-amended-claims is precisely why the bar is set so high via the written description requirement of section 112-1 with respect to the adding of “NEW MATTER”; specifically, why the limitations of amended claims must be “immediately discernible” within the disclosure as originally filed. Allowing a bastardized use/definition of terminology to be introduced into claims via amendment flies in the face of this “immediately discernible” requirement of 112-1.

<sup>59</sup> The examiner concurs with the expert testimony of Mr. Schreiber which as cited in *related* ITC investigation No.

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**4) In light of the above, it is the expressed intent of the examiner to properly reject all occurrences of the terminology “digital (or digitized) television (or TV) program (or programming or signal or signals or content )” under section 112-1 and/or section 112-2, wherein:**

**A. In those instances in which the claimed terminology is used by applicant to refer to SPAM message packets, the claims should be rejected under 112-2 as being used in a manner which is repugnant to its normal meaning (note part “2” of this paragraph); and**

**B. In those instances where the claimed terminology is used to refer to a true/conventional digitized television signal (i.e. that of applicant’s “Example #7”), the claims should be rejected under 112-1 as being not enabled (note part “3” of this paragraph).**

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337-TA-392 [1997 ITC LEXIS 307 \*257] that the limited description of “digital television programming” in applicant’s 1987 disclosure would not have been enabling of “digital television programming”[see the discussion which begins at \*255 in PART I of 2].

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However, because of the confusion which clouds the record, the examiner finds it difficult to impossible to properly identify which interpretation applicant intends to give to each occurrence of the “digital (or digitized) television (or TV) program (or programming or signal or signals)” terminology that is recited in the pending claims. Therefor, the examiner has found it difficult to impossible to determine which one of the two categories of 112 rejection should be applied to each occurrence of the “digital (or digitized) television (or TV) program (or programming or signal or signals)” terminology in the pending claims <sup>60</sup>. Thus, any assistance that applicant can provide in identifying the intended interpretation of each “digital (or digitized) television (or TV) program (or programming or signal or signals)” recitation that appears in the claim would be very helpful in clarifying the record; i.e. if applicant is willing to identify what “digital signal/program” is being claimed at each occurrence, then the

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<sup>60</sup> Applicant has submitted argument's in which he seems to suggest/allege that, in at least some situations, the examiner has failed to understand that what is actually being claimed is the digital nature of SPAM messages rather than the digital nature of TV programming. If this is true, the use of the “digital” terminology in the claims/disclosure also appears to be used/applied inconsistently raising yet further section 112 issues.

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examiner will be able to specifically set forth the grounds under section 112 on which it is being rejected.

17. Applicant appears to take the position that the U.S. Patent #3,906,480 to Schwartz et al. disclosed structure that was representative of:

*“the means needed to format and transmit digital television signals in a manner compatible with all the methods and apparatus disclosed in [his] specification.”*

This position appears to be way wide of the mark and seems silly/absurd/ridiculous ..... (especially if the term “digital television signals” in this allegation is intended to refer to digital/digitized TV programming/shows as discussed in the preceding paragraph of this Office action). Clearly, U.S. Patent #3,906,480 to Schwartz et al. described a computer display system which had absolutely nothing to do with the formatting, the transmission, and/or the display of digital or digitized television programs/shows. Applicant seems somehow confused and/or misled by the mere presence of “digital television” terminology in the title and body of this U.S. patent. Nonetheless, the fact that applicant has explicitly pointed to such unrelated prior art as having been representative of the “means” on which his disclosed/claimed methods and apparatus were (are) based, emphasizes the seriousness of the issues



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which have been raised by the examiner under both section 112-1 and section 112-2 concerning applicant's own use of such "digital television" and "digital programming" terminology throughout his own disclosure and pending amended claims. Specifically, applicants citation of, and explicit reliance on, an unrelated Schwartz et al. patent adds further confusion to an already confused record and gives further credence to the section 112 rejections that are already of record <sup>61</sup>.

Given the above, applicant is again requested to provide evidence (e.g. *related prior art*) that actually shows that "*the means needed to format and transmit digital television signals in a manner compatible with all the methods and apparatus disclosed in [his] specification*" was in fact notoriously well known in the art as alleged to have been the case by applicant from the time he originally filed is 1987 disclosure. Alternatively, applicant is asked to explain how the apparently *unrelated* Schwartz et al. patent provides such a showing as has now been alleged by applicant in his latest response. <sup>62</sup>

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<sup>61</sup> Again, the examiner concurs with the expert testimony of Mr. Schreiber which was cited in *related* ITC investigation No. 337-TA-392 [1997 ITC LEXIS 307 \*257] that the limited description of "digital television programming" in applicant's disclosure would not have been enabling [see the discussion which begins on page 255 of PART 1 of 2].

<sup>62</sup> If/when applicant uses the "digital television" terminology to actually refer to "digital television signals", then the examiner maintains that evidence is still needed to show "enablement"; i.e. a section 112-1 issue. This "enablement" issue appears under a section 112-2 heading only for convenience of explanation.

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18. Applicant also to take the position that the examiner has erred under section 112 by improperly assuming that applicant is claiming “digital television” when he recites “digital television” in his pending amended claims. More specifically, applicant seems to be suggesting that the examiner’s section 112 positions might not be correct because applicant might not actually be claiming “digital television” when applicant recites “digital television” in his pending amended claims; i.e. applicant suggests that he might actually be claiming “SPAM” when he recites “digital television”. The examiner rejects applicant’s insinuations in view: 1) that applicant’s “SPAM” does not fall within the commonly accepted meaning of “digital television”; and 2) that applicant at least failed to properly execute his right to be his own lexicographer by explicitly defining and limiting the term “digital television” to have the uncommon/unusual meaning of “SPAM” as now alleged/claimed. In light of the above and the record before him, the examiner is now concerned that applicant might be purposefully drafting amended claims to read on subject matter that he clearly did not have in his possession at the time of original filing; i.e. namely “digital television”. To the extent of the examiner’s understanding, what applicant actually had in his possession was a supplemental data channel, carried within the VBI of a conventional analog TV programming broadcast, through which digital enhancement/control/monitoring data could be

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**distributed along with the transmitted analog television signal broadcast. This, even by today's standards, constitutes nothing more than an "extended" Teletext transmission system <sup>63</sup> ; it certainly did and does not constitute "digital television" as commonly known/understood by those of ordinary skill in the art.**

**19. The examiner notes that in the 312 amendment filed in application S.N. 08/447,415 [note "Exhibit H" of the Rule 1.181 Petition that was filed in March of 2000 in application S.N. 08/470,571], applicant changed the term "software module" to read "instruction module" because the examiner had pointed out that the alleged support for this limitation, as identified by applicant himself, was a disclosed "data module". In the REMARK section this 312 amendment [see page 6] applicant alleged that the amendments which changed "software module" to read "instruction module" did not: *"change the scope of the claims"*. If this is truly applicant's belief, then one must conclude that it is applicant's position that the expression "a software module" was synonymous with the expression "an instruction module" and with the expression "a data module"; i.e. applicant has explicitly argued that a claimed "software module" has the exact same scope as a claimed "instruction**

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<sup>63</sup> An extended Teletext system is a conventional Teletext system that has been modified/extended to carry other types of data besides text and graphics data, such as "Telesoftware".

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module” and has explicitly cited a “data module” as the disclosed support for the claimed “software module”/“instruction module” recitations. Being such, there appears to be no difference in applicant’s mind between the meaning/scope of the terms “software”, “instruction”, and “data”; i.e. at least in when they are used to modify the term “module”. To the examiner, applicant’s position/belief appears to be counter-intuitive at best. In any event, the examiner maintains that such arguments made by applicant justify section 112 concerns over applicant’s use of the “software”, “instruction”, and “data” terminology in the pending claims. Specifically, do these terms have the same scope and meaning as has apparently been alleged?:

- 1) if so, then why are different terms needed/used when such only creates unnecessary confusion?; and
- 2) if not, then how are the terms differentiated in light of applicant’s REMARKS, arguments, etc,... as exemplified above?

20. Early in applicant’s present 1987 disclosure: 1) the term “original transmission stations” was formally defined as having been used, thereafter, to refer to stations that originate broadcast transmissions; 2) the term “intermediate transmission stations” was formally defined as having been used, thereafter, to refer to stations that receive and retransmit said broadcast transmissions; 3) the term

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**“ultimate receiver stations” was formally defined as having been used, thereafter, to refer to stations where subscribers view programming; and 4) the term “subscriber stations” was formally defined as having been used, thereafter, to refer to the entire group/class of stations consisting of both said “intermediate transmission stations” and said “ultimate receiver stations” [NOTE: the last 12 lines on page 40 of the present written description]. In contrast, it is noted that the term “receiver station” was never formally defined within the present 1987 disclosure. Instead, the meaning/definition of the “receiver station” terminology changed depending on the context within which it appeared. More specifically, there exists:**

**1) Sections of the originally filed 1987 disclosure in which the “receiver station” terminology was specifically used to refer to “intermediate transmission stations” [note lines 28-32 on page 340 of the present disclosure as read in the context of lines 11-32 of said page];**

**2) Sections of the originally filed 1987 disclosure in which the “receiver station” terminology was specifically used to refer to the “ultimate receiver stations” [note: the use of the term in lines 12-17 on page 12 of the present 1987 disclosure; the use of the term in the context of the descriptions that appear under the heading “BRIEF DESCRIPTION OF THE DRAWINGS” on pages 16-18 of the present disclosure (i.e. it only appears in the**

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**descriptions of figures 1, 3, 7D, and 7E pertaining to URSs); and the use of the term in 5-11 on page 539 of the present disclosure], and**

**3) Sections of the originally filed 1987 disclosure in which the “receiver station” terminology, like the newly coined “subscriber station” terminology, was specifically used to refer to the “intermediate transmission stations” and to the “ultimate receiver stations” as a combined group [note lines 11-17 on page 536 of the present disclosure].**

**Given the above, the examiner maintains that one must be careful so as to properly interpret the use/meaning of the “receiver station” terminology in a given claim according to the context in which it is being recited in said claim. Specifically, when a claim uses the “receiver station” terminology in the context steps/structure for actually combining data and programming into a user specific multi-media display/presentation, the “receiver station” terminology should be held to its “ultimate receiver station” definition/meaning in view that “ultimate receiver stations” were the only stations described in the present 1987 disclosure which were capable of having produced said combined multi-media displays/presentations [note lines 14-25 on page 39 of the present disclosure]; i.e. applicant’s disclosed “intermediate transmission stations”, as described, were not capable of having provided such displays/ presentations. Likewise, when a claim uses the “receiver**

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**station” term in the context steps/structures for relaying/retransmitting received programming broadcasts, the “receiver station” terminology should be held to its “intermediate transmission station” definition/meaning in view that “intermediate transmission stations” were the only stations described in the present 1987 disclosure which were capable of having received and retransmitted such broadcasted programming; i.e. applicant’s disclosed “ultimate receiver stations”, as described, were not capable of having provided such program retransmissions.**

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## **SECTION VII: (Evidence of a Shell Game?)**

21. Throughout the prosecution of their 329 co-pending applications, applicant has amended the same claims over and over again, in successive amendments, often only for the alleged purpose of providing “clarity”. The examiner points out that this process of continuously amending large numbers of claims for the sake of “clarity” effectively, and perhaps unfairly, creates moving targets for the Office/examiners to hit/address; i.e. it creates a burdensome situation for the Office/examiners in any event. This “*moving target*” approach to prosecution takes on a more ominous/disturbing complexion when there appears to be some evidence that applicant is recycling previously presented claims/issues within the movement, and is presenting the same claims/issues in different applications that are before different examiners, without notifying the Office/examiners to the fact that presented claims/issues are recycled ones and /or ones that have been presented a multiple of times. The examiner is not objecting to what applicant seems to be doing (i.e. recycling claims/issues and presenting duplicate claims/issues in different application before different examiner’s), but the examiner is strongly objecting to what applicant seems not to be doing (i.e. formally notifying the Office/examiners when claims/issues have been considered elsewhere in the record).



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**The following four examples have been cited to exemplify this situation:**

**1) In lines 10-12 on page 32 of the Rule 1.181 Petition that was filed in March of 2000 in application S.N. 08/470,571, applicant argued that the *Administrative Requirement* was/is unfair because it requires applicant to resolve all conflicts between claims in different applications and therefor:**

***“compels [applicant] to narrow their claims without the benefit of a substantive determination how others may potentially interpret applicants [claims]”.***

**By taking this position, applicant appears to be admitting that they have been intentionally presenting conflicting claims within different applications for the expressed purpose of obtaining potentially different interpretations from “others”. However, if this is true, then one should be able to locate statements in the record where applicant has brought such conflicting claims/issues to the attention of the Office/examiners in view that the record is replete with applicant’s pledges to either: 1) maintain a patentable demarcation between claims in co-pending applications; or 2) to make a good faith effort to alert the PTO when conflicting claims have in fact been treated differently. A cursory review of the record by the examiner has failed**

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to locate even one example of where the PTO was alerted as to the intentional presentation of conflicting claims/issues on the part of applicant. Thus, the obvious question arises: *If applicant has in fact knowingly and intentionally presented conflicting claims/issues in different applications to obtain different interpretation from others as their statements in the 181 Petition seem to suggest, then why have they failed to alert the Office/examiners of such conflicts as pledged?*

2) On 4/14/98, the examiner of record rejected claims 48-63 of application S.N. 08/471,024 under section 112. In response to this rejection, applicant amended claims 48-63 on 10/14/98 by deleting the recited “completed” terminology from these claims for the purpose of, as stated by applicant, providing “clarity”. However, when applicant transferred these same claims into the respective consolidating application (i.e. as claims 167-182 of current application S.N. 08/470,571), applicant recycled the this issue by re-introducing the previously deleted “completed” terminology back into the claims without ever going back and addressing the issue which caused the terminology to be deleted in the first place; i.e. without explaining why the “completed” terminology had not caused the section 112

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**problems alleged by the previous examiner, and/or without explaining why the deleting the “completed” terminology was no longer needed for “clarity” as previously alleged.**

**3) Throughout the present prosecution, applicant has acknowledged that section 112-1 support must come from his present 1987 disclosure and not his 1981 parent disclosure. Yet, time and time again, applicant seems to forget this fact and returns to old ways of improperly addressing section 112-1 support issues through erroneous and irrelevant citations to his 1981 parent disclosure. This forgetfulness seems to evidence ongoing efforts on the part of applicant to misdirect the focus of the section 112-1 issues to his 1981 parent disclosure: possibly indicating that applicant recognizes that it is difficult/impossible to identify section 112-1 support for the limitations of his pending claims from his originally filed 1987 disclosure in a manner that is “immediately discernible”; possibly indicating that applicant recognizes that it will be difficult/impossible to provide sufficient evidence needed to show “others” that the required section 112-1 support existed in his present 1987 disclosure at the time it was originally filed; possibly indicating that applicant**

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**has in fact left his “best mode” behind in the 1981 disclosure by the drafting and filing of the present 1987 disclosure; possibly indicating something else..... In any event, there seems to be little doubt that applicant’s 1987 disclosure is difficult to read and/or absorb; i.e. even by the accounts of applicant’s own expert witnesses <sup>64</sup>. For this reason alone, it would be no surprise if applicant wished to avoid having to confront his own 1987 disclosure when addressing issues under section 112-1. Unfortunately, applicant has no choice. Specifically, the use of his 1981 parent disclosure to address section 112-1 is in fact prohibited and is not a legal or valid alternative. [See the preceding paragraphs of this Office action for greater details].**

**4) Applicants appear to have made a ‘material to patentability’ allegation in a second co-pending application even though:**

**a) they appear to have taken countervailing actions, earlier, in a first co-pending application when amending its ‘to avoid the prior art’ ‘for reasons of patentability’;**

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<sup>64</sup> Applicant’s own expert witness seems to have elegantly captured this fact during ITC Investigation No. 337-TA-392 when he stated: “when I received the ‘277 patent [i.e. the present 1987 disclosure], my heart truly sank because I knew I would have to read and absorb the patent” [see the discussion starting in the last few lines of part I of 1997 ITC LEXIS 307\*250].

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**b) the same allegation of ‘material to patentability’ had been made, addressed, and dropped in the first co-pending application prior; and**

**c) the Examiner of the second co-pending application was not informed of the earlier countervailing action in the first co-pending application.**

**Moreover, and even later, Applicants seem to have made yet the same allegation ‘material to patentability’ ‘to avoid the prior art’ and ‘for reasons of patentability’ in a third co-pending application even though the Examiner of the third co-pending application was not informed, yet again, of the earlier countervailing action.**

**It is fact that what a single prior art reference teaches is uniform, and does not change, from co-pending application to co-pending application. Being such, there is no way to justify any allegation which creates, or attempt to create, countervailing estoppel in different ones of co-pending applications with respect to a single prior art reference. Unfortunately, such appears to have occurred during the prosecution of applicant’s 329 co-pending applications as is evidenced in the following:**

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**A) The First Instance (U.S. co-pending application no. 08/446,431) on February 24, 1998.**

**In the first co-pending application, the first Examiner rejected claim 13 as anticipated by Campbell et al (U.S. patent no. 4,536,791) under 35 U.S.C. 102(e). 102(e) is a finding of fact. Hence, the first Examiner made a factual determination that Campbell et al taught “one of simultaneous presentation and sequential presentation”.**

**See first Office action on the merits paper 12 page 23 paragraph 23 received 2/14/97.**

**In response, Applicants did not recognize that Campbell et al taught “one of simultaneous presentation and sequential presentation”. For their sole allegation ‘material to patentability’ for ‘distinguishing over Campbell et al’, Applicants alleged that Campbell et al “...is completely silent on...one of simultaneous presentation and sequential presentation...”; See paper 15 page 36 lines 9-11.**

**However, in the subsequent final rejection, the first Examiner made his final determination that Campbell et al**

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did, in fact, teach “one of simultaneous presentation and sequential presentation”. See paper 16 pg 10 para. 8. <sup>65</sup>

In the subsequent response, Applicants amended claim 13 ‘to avoid the prior art’ (Campbell et al) ‘for reasons of patentability’. See paper 17 page 2 received 2/24/98.

B) The Second Instance (U.S. co-pending application no 08/441,577) on August 6, 1998.

In the second co-pending application and before a second Examiner, Applicants later alleged that “one of simultaneous presentation and sequential presentation” was, alone, ‘material to patentability’ for ‘distinguishing over Campbell et al’...“...Campbell lacks any concept of simultaneous or sequential output presented...” . See Amend D paper no. 14 pg 36 lines 10-13.

However, this allegation was made even though Applicants had taken the countervailing action earlier in the first co-pending application, and even though they did not provide the second Examiner with the ‘information’ that they had earlier

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<sup>65</sup> Note: part “9)” of “SECTION II” of this Office action.

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amended the first application to 'avoid the prior art' (Campbell et al) 'for reasons of patentability'.

C) The Third Instance (U.S. co-pending application no. 08/484,858) on June 16, 1999.

In the third co-pending application before yet a third examiner, Applicants once again alleged that "one of simultaneous presentation and sequential presentation" was 'material to patentability' for 'distinguishing over Campbell et al' even though Applicants had taken the countervailing action earlier in the first co-pending application, and even though they did not provide the third examiner with the 'information' that they had earlier amended the first co-pending application to 'avoid the prior art' (Campbell et al) 'for reasons of patentability'.

Particularly, on June 16, 1999, there was a personal interview. The topic was the non-patentability of one or more claims under 37 C.F.R. 313(b)(3). In attendance were Applicant Mr. John C. Harvey and representatives Messrs. Donald J. Lecher and Mr. Thomas J. Scott, Jr. as well as



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Acting Director Jim Dwyer, Supervisor Andrew Faile, and Examiner William Luther. When discussing claim 9, Applicant Mr. Harvey alleged before Examiner Luther, and Messrs. Dwyer, and Faile, that Campbell et al did not teach “combined medium presentation” (claim 9 line 7) and that the claim 9 “combined medium presentation” was ‘material to patentability’ for ‘distinguishing over Campbell et al’. However, Examiner Luther explained, that the Campbell et al ‘video presentation’ is one kind of ‘presentation’ and the Campbell et al ‘audio presentation’ is another kind of ‘presentation’ so that the claim 9 “combined medium presentation” read squarely on the combined audio and video presentation of the Campbell et al television. See Campbell et al col 17 lines 58-61 and the written description corresponding to Figures 11, 12, and 13.

Mr. Dwyer said that the proper standard for Examiner Luther to apply is the ‘broadest reasonable interpretation’ standard when considering patentability. Mr. Dwyer then said that, while Examiner was not unreasonable for finding that “combined medium presentation” read on the Campbell et al

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**‘audio presentation’ combined with the Campbell et al ‘video presentation’, when the specification provides definitions for terms appearing in the claims then the specification can be used for interpreting the claim language.**

**In response, Mr. Harvey alleged that Campbell et al does not teach “our combined medium presentation”. Mr Harvey said “our combined medium presentation” is “one of a sequential and simultaneous presentation”, and that Campbell et al “does not teach” “one of simultaneous presentation and sequential presentation”. Mr. Scott then specifically alleged, once again<sup>66</sup>, that “one of simultaneous and sequential” was ‘material to patentability’ when alleging that it “patentably distinguished over” Campbell et al. Mr. Dwyer asked Examiner Luther whether he would indicate patentability if “one of simultaneous presentation and sequential presentation” was substituted for “combined medium presentation”. Examiner Luther declined.**

**In response to Examiner Luther’s declination, Mr. Scott indicated to Mr. Dwyer, Supervisor Faile, and Examiner**

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<sup>66</sup> It is noted that same attorney, Mr. Scott, is the undersigned attorney for the first and second instances.

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**Luther that he would seek a “writ of mandamus” and “*judicial review*” if the third co-pending application was not patented.**

**Mr. Harvey, Mr. Scott, and Mr. Lecher did not, however, inform Mr. Dwyer, Mr. Faile, and Examiner Luther that Applicants had earlier taken the countervailing action of amending the first co-pending application to ‘avoid the prior art’ (Campbell et al), with respect to “one of simultaneous presentation and sequential presentation”, ‘for reasons of patentability’.**

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## **SECTION VIII: (THE “WOODS”).**

**22. Applicant has disparagingly characterized the examiner’s mind as: “a woods”.**

**Is applicant really surprised? One needs only to read *Investigation No. 337-TA-392 of the International Trade Commission (ITC)* <sup>67</sup> to appreciate how difficult it was for that body to deal with a mere handful of applicant crafted claims (i.e. less than 10 of them). Now multiply this number a 1000+ times, literally, and one arrives at the 10-20 thousand applicant crafted claims which are part of the record that is currently before the Office/examiner. To try to picture all of the issues which are associated with these 10 to 20 thousand claims, using the difficulties faced by ITC as indicator, is to begin to picture the real forest to which applicant alludes. <sup>68</sup>**

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<sup>67</sup> 1997 ITC LEXIS 307

<sup>68</sup> As patent applications go in the broadcast art, applicant’s instant 1987 disclosure weighs in on the heavy side of the spectrum comprising a very plump 557 pages of written description. Using the claim numbers set forth above, it can be conservatively estimated that applicant has submitted between 18 and 36 claims for every one of the 557 pages of this lengthy 1987 instant description: i.e. about one claim for every 8.5 to 17.7 words over the entire 557 pages. This claim to description ratio climbs to much higher levels when one considers only those portions of the 1987 written description on which the claims are actually based. For example, applicant’s own expert witness, Mr. Davis, testified in the above cited ITC INVESTIGATION that, “you don’t need to read all 310 columns” of the 1987 disclosure as printed in applicant’s ‘277 patent in order to understand it, “you can gain a complete understanding of what’s going on by reading and focussing on the first 25 to 30 columns” (emphasis added) [SEE: 1997 ITC LEXIS 307, \*249]. These 30 columns correspond to about 57 pages of the 1987 written description which translates to a ratio of one submitted claim for every 1 to 2 words of written description. The claim-to-word ratio also *soars* when one considers those

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**SECTION IX: (Rejections under 35 U.S.C. 112, second paragraph)**

**23. The disclosure is objected to because of the following informalities:**

**24. Claim 2-19, 27, 30, 53-56, 58-60 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

1) In the context of claim 2, it is unclear as to the meaning/scope of the recitation of the phrase "transmissions of different kinds" as it appears within the recitation "a plurality of signals including at least two transmission of different kinds" (note lines 4-6 of claim 2). For example, does a "TV program" comprise a transmission of one kind and the "SPAM" which is embedded within said programing comprise a transmission of another kind?.... and is the information that is obtained over a phone line considered to be a transmission of a third kind?.....and if so, how does

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of the 10-20 thousand submitted claims for which applicant has alleged priority to portions of the relatively brief 1981 written description (i.e. like those of the present application). Given the above, the examiner asks: "Who grew the woods to which applicant now alludes?"

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this all relate to the teaching which has actually been cited by applicant in support of this limitation: e.g.

***“If a unit like the microcomputer can receive transmission from more than one source or of more than one kind-television, radio, or other-it will have sufficient apparatus to monitor every channel and kind of transmission it can receive”.***

Clarification is needed [ also note “EXAMPLE #2” in the following “SECTION” of this Office action].

2) In claim 27, lines 1 and 2, “said information contained in said first signal” has no antecedent basis and is indefinite (i.e. claim 26 only recited information which was based on said first signal, not “contained in” as is now recited). Similar clarification is needed for “said information contained in said second signal” of lines 2 and 3.

3) In line 4 of claim 30, ***“at least one of said sequences of processor instructions”*** does not have clear antecedent basis and is indefinite (note that the “sequences” that have been previously recited were recited in the alternative).

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4) In claim 53, line 2, it is not clear to what “said method” refers. Similar clarification is needed in lines 2 and 3 of claim 54.

5) In claim 58, line 2, “said intermediate transmitter station” has no antecedent basis and is indefinite.

6) In claims 65, line 5, “said control signal” does not have clear antecedent basis and is indefinite.

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**25. SECTION X: (Rejections under 35 U.S.C. 112, first paragraph)**

**26. Claims 2-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

**It is maintained that all of the currently pending amended claims contain limitations which were not described in the present 1987 disclosure in an “immediately discernible” fashion as is required by section 112-1 for the reasons which were addressed in “SECTION III” of this Office action. In addition to those problems which were previously addressed above, the following examples of section 112-1 problems are hereby cited:**

**EXAMPLE #1:**

Applicant's originally filed disclosure described a transmission system/apparatus comprised numerous circuit components and variations thereof, wherein each of these circuit components and variations thereof was described, “independently”, as being capable of providing a wide range of different functions. Given the



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complexity of the disclosed system/apparatus, the many described functions of the many described components and variations thereof can obviously be arranged in different manners so as to create sequences of “steps” which perform/execute an “unlimited” number of processes/methods; i.e. one is limited only by ones imagination and creatively. However, applicant is not entitled to now claim this “unlimited” range of processes/methods. More to the point, applicant is only entitled to now claim those sequences of functions/“steps” which correspond to methods/processes which were actually described in the originally filed instant disclosure in the required “immediately discernable” fashion. Applicant is not allowed to mix and match functions/steps of the originally described components into combinations/sequences which were not described in the originally filed instant disclosure in the required “immediately discernable” fashion.

Thus, for each of the currently pending amended “method” claims, applicant should be able to cite that portion of the originally filed instant disclosure which set forth the sequence of steps that is now being recited in the required “immediately discernable” fashion. Applicant is again requested to provide such citations to the instant disclosure for each of the currently pending amended claims [i.e. as applicant has already done within many of the currently pending claims via a provided “Appendix A” (e.g. note applicant’s last response in S.N. 08/470,571)].

The examiner believes that such citations, submitted on the part of applicant, have

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and will continue to go a long way to advancing prosecution by at least providing the examiner with “clues” as to exactly what it is that applicant now attempts to claim (e.g. note the latest Office action in S.N. 08/470,571).

**EXAMPLE #2:**

Within the context of each of claims 2-19, it is unclear as to where there is support for the recitation of a “plurality of signals including at least two transmissions of different types.” In the remarks section of applicant’s last response, applicant suggests that the support for this recitation came from the originally filed instant disclosure from the following teaching:

*“If a unit like the microcomputer can receive transmission from more than one source or of more than one kind-television, radio, or other-it will have sufficient apparatus to monitor every channel and kind of transmission it can receive”.*

However, the examiner disagrees with applicant’s position. The examiner notes that this cited teaching appears to pertain to the overall structure of applicant’s disclosed transmission system/apparatus; i.e. wherein the disclosed system/apparatus includes circuitry which provides it with the capability of utilizing transmission of various kinds. However, applicant is only allowed to now claim

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those processes/methods of operation which were originally disclosed in “immediately discernible” fashion as having actually utilized this capability. More specifically, applicant is only allowed to now incorporate the “plurality of signals including at least two transmissions of different types” recitation when claiming methods/processed which were originally described in the instant disclosure as having actually received/processed such a “plurality of signals including at least two transmissions of different types”. This does not appear to be the case with pending claim 2. Specifically, as was set forth in the remarks section of applicant’s last response, support for most of the recitations of pending claim 2 are allegedly found within the disclosed “WALL STREET WEEK” application of applicant’s disclosed system/apparatus. However, as originally disclosed, this “WALL STREET WEEK” application did not appear to have utilized a “plurality of signals” that included “at least two transmissions of different types” as has now been positively recited in claim 2. <sup>69</sup>

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<sup>69</sup> The examiner notes that it could be argued that the recited “transmissions of different kinds” might be read on the originally disclosed: “TV programming”, the originally described “SPAM” messages which were embedded in said “TV programming”, the providing of “stock” information via telephone connection, etc,... However, such interpretations seems to be in direct conflict with the meaning/definition that was given to the “transmissions of different kinds” recitation by applicant’s originally filed disclosure as cited in the remarks section of applicant’s latest response.

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Similar problems appear to exist with respect to the “plurality of signals including at least two transmissions of different types” recitation as read in the context of claims 3-19.

**EXAMPLE #3:**

With respect to claim 4, it is not understood as to where the originally filed instant disclosure provided section 112-1 support for the following recitations **as read in the context of claim 2:**

- 1) the recitation of the “first of at least two transmissions of different types” containing “first information” which comprised the recited “multimedia presentation”; and
- 2) the recitation of the “second of at least two transmissions of different types” which was used as a basis for generating “said second information”.

Clarification is needed.

**EXAMPLE #4:**

With respect to claim 5, it is not clear where applicant’s originally filed instant disclosure actually set forth the alternative ways of generating “said second information” as are now being recited in claim 5: e.g. namely,

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- 1) a first method in which the “second information” was generated by processing data which was contained within the second one of at least two transmission of different kinds; and
- 2) an alternative method in which the “second information” was generated by in response to an instruction that was contained within the second one of at least two transmission of different kinds.

*[For the record, if recited “alternative ways” actually refer to different “processes”/“steps” of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #5:**

In the context of the steps of claim 2, it is not clear where applicant’s originally filed instant disclosure provided section 112-1 support for the following recitations of claim 6:

- 1) the “first transmission” of a different kind which contained “only one of” a video and graphic (e.g. as originally disclosed, the first transmission actually appears to have comprised the video which, at times, represented the “graphic”); and

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- 2) the recited “second transmission” of a different kind which contained audio.

Clarification is needed.

**EXAMPLE #6:**

In the context of the steps of claim 6, it is not clear where applicant’s originally filed instant disclosure provided section 112-1 support for recitations of claim 7 in which the multimedia presentation (e.g. the “WALL STREET” application) was derived from a TV programming transmission and a radio programming transmission.

**EXAMPLE #7:**

In the context of the steps of claim 2, it is not clear where applicant’s originally filed instant disclosure provided section 112-1 support for recitations of claim 8 in which:

- 1) the “first transmission” of different kinds comprised “data” which was to be processed by “instructions”; and
- 2) the “second transmission” of different kinds comprised the “instructions” which were used to process the data from the first transmission.

Clarification is needed.

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**EXAMPLE #8:**

In the context of the steps of claim 8, it is not clear where applicant's originally filed instant disclosure provided, in an immediately discernible fashion, the required section 112-1 support for the step recited in claim 9 in which:

- 1) an output of the receiver station was synchronized with "a second portion" of a presented multimedia program based on the step of processing at least a first portion of one of a plurality of signals which included at least two transmission of a different kind.

Clarification is needed.

**EXAMPLE #9:**

In the context of the steps of claim 10, with respect to the recitations of claim 11, it is not clear where applicant's originally filed instant disclosure described the part of the recited "second portion of said program" that included "audio".

Clarification is needed.

**EXAMPLE #10:**

With respect to the recitations of claim 11, it is not clear where applicant's originally filed instant disclosure described the outputting of "video" sequentially with at least part of the "second portion of the program" wherein, in accordance

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with claim 10, said video is also outputted “simultaneously” with said second portion of the program; e.g. how can a portion of a program and a video be outputted “simultaneously and sequentially” at the same time? Clarification is needed.

**EXAMPLE #11:**

In the context of the steps of claim 2, it is not clear where applicant’s originally filed disclosure described the recited transmission of different kind in which one transmission contained video and audio and another transmission of different kind contained “information to be printed.” Clarification is needed.

**EXAMPLE #12:**

With respect to claim 13, it is not clear where applicant’s originally filed instant disclosure described the recited “device” at the receiver station which processed at least two transmissions of different kind. Clarification is needed.

**EXAMPLE #13:**

In the context of the steps of claim 2, with respect to claim 13, it is not clear where applicant’s originally filed disclosure described the recited step in which:



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1) information, which was received in a first of two transmission of different kind, was stored “at a time” when the device of the receiver receives, from an external transmitter station, a second of the two transmission of different kinds.

Clarification is needed.

**EXAMPLE #14:**

With respect to claim 14, it is not clear where applicant’s originally filed disclosure described:

- 1) the recited “*television program content*” and
- 2) the recited “*digital signal which contains [the] television program content.*”

Clarification is needed.

**EXAMPLE #15:**

In the context of the steps of claim 13, with respect to claim 14, it is not clear where applicant’s originally filed disclosure described alternative methods in which the a “device” at the receiver station, which “device” comprised of a “microprocessor operatively connected to a memory, processed:

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- 1) at least a portion of an analog television signal and a digital signal which contains television program content; and, in the alternative,
- 2) at least a portion of an analog radio signal and a digital signal which contains television program content.

Clarification is required.

**EXAMPLE #16:**

In the context of the steps of claim 14, with respect to claim 15, it is not clear where applicant's originally filed disclosure described the recited "multimedia presentation which comprised audio which describes said television program content" wherein "said television program content" was contained within the "digital signal" that was being processed by the "device" at the receiver station. Clarification is needed.

**EXAMPLE #17:**

In the context of the steps of claim 13, with respect to claim 16, it is not clear where applicant's originally filed disclosure described the recited "electrical signal"

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and the recited “optical signal” that was processed by the “device” of the receiver station. Clarification is needed.

**EXAMPLE #18:**

In the context of the steps of claim 2, with respect to claim 17, it is not clear where applicant’s originally filed disclosure described the recited “step of communicating with a source external to the receiver station” so as to receive a “transmission of a different kind”. Clarification is needed.

**EXAMPLE #19:**

With respect to claim 18, it is not clear where applicant’s originally filed disclosure described the recited “data service”. Clarification is needed.

**EXAMPLE #20:**

In the context of the steps of claim 17, with respect to claim 18, it is not clear where applicant’s originally filed disclosure described the recited “step of communicating with a source external to the receiver station”, so as to receive one “transmission of a different kind”, wherein said step of communicating comprises “querying a data service”. Clarification is needed.

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**EXAMPLE #21:**

In the context of the steps of claim 17, with respect to claim 19, it is not clear where applicant's originally filed disclosure described a receiver station which actually "processed a telephone signal". Clarification is needed.

**EXAMPLE #22:**

As will be exemplified via the "examples" which follow, all of claims 20-65 require clarification (an explanation of required section 112-1 support) similar to that which is needed for claims 2-19 as has been addressed, in detail, above.

**EXAMPLE #23:**

With respect to claim 20, it is not clear where applicant's originally filed instant disclosure described:

- 1) the recited "*at least two different sources*" of lines 2 and 3;
- 2) the recited "*receiver station*" of line 2 that is "*adapted to receive a plurality of signals from [said] at least two different sources*";
- 3) the recited "*information*" that is based on a second signal that is received from a source that is external to the receiving station;

Art Unit:

4) the recited “*information*” that is based on a first signal from a first source; and

5) the recited “*multimedia presentation*” which comprises the information from the first signal and the information from the second signal.

Clarification is needed.

**EXAMPLE #24:**

With respect to claim 20, it is not clear where applicant’s originally filed instant disclosure described:

1) the recited “*at least a portion*” of the received first signal from the first source, wherein said “*portion*” enables a multimedia presentation at the receiver station.

Clarification is needed.

**EXAMPLE #25:**

With respect to claim 20, it is not clear where applicant’s originally filed instant disclosure described:

1) the recited “*second source*” that is external to the receiver station.

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Clarification is needed.

**EXAMPLE #26:**

In the context of the steps of claim 20, with respect to claim 21, it is not clear where applicant's originally filed instant disclosure described respective embodiments of invention in which:

- 1) the first signal was received from an intermediate transmitter which received the first signal from the first source; and, *alternatively*
- 2) the second signal was received from an intermediate transmitter which received the second signal from the second source.

*[Again, for the record, if recited "alternative ways" actually refer to different "processes"/"steps" of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #27:**

With respect to claim 22, it is not clear where applicant's original written description described:

- 1) the recited "information" of line 3 that is stored at the receiver station;
- and

Art Unit:

2) the recited “first signal” of line 2 which:

- a) contained the “portion” which enabled the multimedia presentation (see claim 20);
- b) served as a basis for the “information” which comprised said multimedia presentation (see claim 20); AND
- c) contains information that is compared with the information that is stored at the receiver station (see claim 22).

**EXAMPLE #28:**

In the context of the steps that are recited in claim 20, with respect to claim 23, it is not clear where applicant’s original written description described the recited “selective transfer device” that was “controlled” so as to output “said second signal”. Clarification is needed.

**EXAMPLE #29:**

With respect to claim 24, it is not clear where applicant’s originally filed disclosure described the recited “control signal” of line 5 that was: 1) transmitted from the recited remote transmitter station; and 2) received by the recited receiver station. Clarification is needed.

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**EXAMPLE #30:**

With respect to claim 24, it is not clear where applicant's originally filed disclosure described:

- 1) the recited receiver station which comprised "a plurality of output devices";
- 2) the recited "multimedia presentation" which was outputted "*at at least two*" of said plurality of output devices;
- 3) the recited "multimedia presentation" which comprised "information" that was based on a "plurality of signals from at least two different sources"; and
- 4) the recited "control signal" of line 5 that was:
  - a) transmitted from the recited remote transmitter station;
  - b) received by the recited receiver station; and
  - c) controlled the receiver station to output said multimedia presentation.

Clarification is needed.

**EXAMPLE #31:**



Art Unit:

In the context of claim 24, with respect to claim 25, it is not clear where applicant's originally filed disclosure described the recited "plurality of local sources" of line 2. Clarification is needed.

**EXAMPLE #32:**

In the context of claim 24, with respect to claim 25, it is not clear where applicant's originally filed disclosure described embodiments of alleged invention have the following three positively recited alternative configurations:

- 1) a receiver station for outputting the recited multimedia presentation via a plurality of output devices comprised of a "speaker and a printer";
- 2) a receiver station for outputting the recited multimedia presentation via a plurality of output devices comprised of an "image display device and a radio"; and, alternatively,
- 3) a receiver station for outputting the recited multimedia presentation via a plurality of output devices comprised of a "computer and a television receiver."

*[Again, for the record, if recited "alternative ways" actually refer to different "processes"/"steps" of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

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**EXAMPLE #33:**

With respect to claim 26, it is not clear where applicant's originally filed disclosure described a receiver station which was capable of receiving a plurality of signals and yet of only processing one of them as would be needed to support the "at least one" recitation of line 2. Clarification is needed.

**EXAMPLE #34:**

With respect to claim 26, it is not clear where applicant's originally filed disclosure described a receiver station that was capable of only receiving "two discrete signals" as would appear to be needed to support the "at least two" recitation of line 4. Further, it is not clear where these "two" recited "discrete signals" from "different sources" were originally described in applicant's originally filed disclosure. Clarification is needed.

**EXAMPLE #35:**

With respect to claim 26, it is not clear where applicant's originally filed disclosure described the recited:

- 1) "remote transmitter station" of line 5;
- 2) the recited "control signal" of line 6;

Art Unit:

3) the recited “simultaneous presentation of information” that is recited in lines 9 and 10;

4) the recited “sequential presentation of information” that is recited in lines 9 and 10;

5) the recited “first signal” of at least two discrete signals; and

6) the recited “second signal” of the at least two discrete signals.

Clarification is needed.

**EXAMPLE #36:**

With respect to claim 27, and in the context of claim 26, it is not clear where applicant’s originally filed disclosure described the simultaneous display of information that was contained in first and second signals derived from first and second discrete signals. Clarification is required.

**EXAMPLE #37:**

With respect to claim 27, and in the context of claim 26, it is not clear where applicant’s originally filed disclosure described a step for detecting the recited “control signal” in one of said least two discrete signals. Also, is there actually an embodiment described in the originally filed disclosure in which all three of the signals (e.g. the first signal, the second signal, and the control signal) were actually

Art Unit:

derived the same “two” discrete signals as would be needed to support the phrase “at least two” in the recitation “at least two discrete signals”. Specifically, if, as originally disclosed, three discrete signals were needed to represent the three recited signals (e.g. the first signal, the second signal, and the control signal) then there is clearly no support for the “at least two discrete signals” recitation; i.e. it such a case, it would have to read “at least three discrete signals” for section 112-1 support.

**EXAMPLE #38:**

It is not clear how the receiver station can generate one of said two discrete signals from the control signal as is now recited in claim 28 when, as was previously recited in claim 27, said “control signal” was detected in one of said two discrete signals. Clarification is required.

**EXAMPLE #39:**

With respect to claim 29, it is not clear where applicant’s originally filed disclosure described a receiver station which only comprised one output device as would be needed to support the “at least one” recitations of lines 2 and 9. Clarification is needed.

Art Unit:

**EXAMPLE #40:**

With respect to claim 29, it is not clear where applicant's originally filed disclosure described a receiver station which only processed one signal as would be needed to support the "at least one" recitation of line 5. Clarification is needed.

**EXAMPLE #41:**

With respect to claim 29, it is not clear where applicant's originally filed disclosure described a receiver station which received only one second control signal as would be needed to support the "at least one" recitations of lines 6 and 7. Clarification is needed.

**EXAMPLE #42:**

With respect to claim 29, it is not clear where applicant's originally filed disclosure described:

- 1) the "processor" of line 4;
- 2) the "first control signal" of line 4 that "programs" said processor to process "at least one signal";

Art Unit:

- 3) the recited step of “responding to said at least one second control signal” based on the recited step of “processing a first control signal” to program said processor; and
- 4) the recited step of outputting a multimedia presentation based on the recited step of “responding” which is itself based on the recited step of “processing.

Clarification is needed.

**EXAMPLE #43:**

With respect to claim 30, it is not clear where applicant’s originally filed disclosure described:

- 1) the recited “*sequence of processor instructions*” that are now being recited throughout the claim;
- 2) the recited “*command*” that is included within the recited at least one second control signal that executes “*at least one of said sequences of processor instructions*”.

Clarification is required.

**EXAMPLE #44:**

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With respect to claim 30, as read in the context of claim 29, it is not clear where applicant's originally filed instant disclosure described the recited method including:

- 1) a step of processing a first control signal so as to program a processor to process at least one signal;
- 2) a step of responding to at least one second control signal, which was received from a remote transmitter station, based on the step of processing said one signal, wherein:
  - A) said at least one signal included a sequence of processor instructions; and, alternatively,
  - B) said at least one second control signal included a sequence of processor instructions; and
- 3) wherein said at least one second control signal includes a command that executes at least one of said sequences of processor instructions.

*[Again, for the record, if recited "alternative ways" actually refer to different "processes"/"steps" of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #45:**

Art Unit:

With respect to claim 31, as read in the context of claim 29, it is not clear where applicant's originally filed disclosure described:

- 1) the recited ***"television program content"*** that is now recited in line 2;  
and
- 2) the recited "digital signal" which contains said television program content as is recited in line 2.

Clarification is needed.

**EXAMPLE #46:**

With respect to claim 32, as read in the context of claim 29, it is not clear where applicant's originally filed disclosure described:

- 1) the received ***"information"*** that is now being recited in line 2;
- 2) the recited step of ***"decrypting"*** said received information in accordance with:
  - a) said first control signal; and , alternatively,
  - b) said at least one second control signal.

*[Again, for the record, if recited "alternative ways" actually refer to different "processes"/"steps" of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*



Art Unit:

**EXAMPLE #47:**

With respect to claim 33, it is not clear where applicant's originally filed disclosure described:

- 1) the *"first signal"* of line 3 that is outputted at the receiver station;
- 2) the *"user response"* of line 3 that is received based on said outputted first signal;
- 3) the *"remote transmitter station"* of line 5;
- 4) the *"first data signal"* of line 5 that is received from said remote transmitter station;
- 5) the *"second data"* of line 6 that is stored at said receiver station;
- 6) the step of *"comparing"* the first data to the second data *"based on said user's response"*;
- 7) the *"second signal"* of line 8 that is received *"based on said step of comparing"*;
- 8) the *"information"* of line 10 that is *"based on said first signal"*;
- 9) the *"information"* of lines 10 and 11 that is *"based on said second signal"*; and
- 10) the *"multimedia presentation"* that comprises both the information from the first and the information from the second signals.

Art Unit:

**EXAMPLE #48:**

With respect to claim 34, when read in the context of claim 33, it is not clear where applicant's originally filed disclosure described the "*information*" of line 2 that is being "*transmitted from the receiver station based on based said [previously recited step] of receiving a user response*". Clarification is needed.

**EXAMPLE #49:**

With respect to claim 35, it is not clear where applicant's originally filed instant disclosure described the "portion" of the "user response" that is now being recited in line 2. Further, where is the support for the phrase "at least a" in the recitation "at least a portion" of line 2.

**EXAMPLE #50:**

With respect to claim 37, it is not clear where applicant's originally filed instant disclosure described the "*receiver*" that is now being recited in line 2.

**EXAMPLE #51:**

With respect to claim 37, it is not clear where applicant described an embodiment which comprised only one "receiver" for receiving the plurality of signal as would

Art Unit:

be needed to provide section 112-1 support for the “at least one” recitation of line 2.

**EXAMPLE #52:**

With respect to claim 37, it is not clear where applicant described an embodiment in which the one receiver received only one of the plurality of received signals from a remote transmitter as would be needed to provide section 112-1 support for the “at least one” recitation of line 3.

**EXAMPLE #53:**

With respect to claim 37, it is not clear where applicant disclosed a “*receiver*” for receiving the “plurality of signals” wherein:

- 1) said plurality of signals comprised at least two transmission of different kinds; and
- 2) only one of said plurality of signals was provide by a remote transmitter station,

as appears to be required in support of the recitations of lines 2-4.

Clarification is needed.

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**EXAMPLE #54:**

With respect to claim 37, its is not clear where applicant's originally filed disclosure described embodiments, or an embodiment, which support(s) all of the "*at least*" recitations that have been liberally added throughout the recitations of claims 37. For example, where is there support for:

- 1) "*at least one* output device" which is operatively connected to "*at least one* receiver" and "*at least one* processor", wherein said "*at least one* receiver" receives "a plurality of signals" which include: 1) "*at least two* transmissions of different kinds"; and 2) "*at least one*" signal which was received from a remote transmitter station ?

Clarification is needed.

**EXAMPLE #55:**

With respect to claim 37, where is there support in the originally filed disclosure for:

- 1) the recited "*at least two transmissions of different kind*" of line 4;
- 2) the recited "*first of said at least two transmissions*" of line 10;
- 3) the recited "*second of said at least two transmissions*" of line 11;
- 4) the recited "*information*" of line 10 that is "based" on the "first of the at least two transmissions of a different kind";

Art Unit:

- 5) the recited ***“information”*** of line 11 that is “based” on the “second of the at least two transmissions of a different kind”; and
- 6) the recited ***“multimedia presentation”*** of line 10, that is outputted by at least one processor, that comprises the information from the first and second transmissions; and
- 7) the recited ***“portion”*** of the multimedia presentation of line 6 that is provided by the at least one processor.

**EXAMPLE #56:**

With respect to claim 43, it is not clear where the originally filed instant disclosure described:

- 1) the ***“plurality of signals”*** that is recited in lines 2 and 3;
- 2) the ***“at least one of said plurality of signals”*** that is recited in line 4;
- 3) the ***“transmitter station”*** that is recited in line 6;
- 4) the step of ***“receiving”*** said at least one of said plurality of signals ***“at the transmitter station”*** as is recited lines 6 and 7;
- 5) the ***“first of said plurality of signals”*** and the ***“second first of said plurality”*** which are ***“transmissions of different kinds”*** as is recited in lines 7 and 8;

Art Unit:

6) the *“information”* that is based on the first of said plurality of signals as is recited in line 9; and

7) the *“information”* that is based on the second of said plurality of signals as is recited in line 10.

**EXAMPLE #57:**

With respect to claim 44, it is not clear where the originally filed instant disclosure described a receiver station which only comprised one output device as would be needed to support the “at least one” phrase in the recitation “at least one output device”.

**EXAMPLE #58:**

With respect to claim 44, in the context of claim 43, it is not clear where the originally filed instant disclosure described:

- 1) the recited *“two discrete portions”* of the *“multimedia presentation”* of lines 3 and 4;
- 2) the *“at least one of said plurality of signals”* which *“synchronizes an output”* of said *“two discrete portions”* as recited in lines 3 and 4; and

Art Unit:

3 the “*first interval of time*” which ends at the recited “*specific time*” as is recited in lines 1 and 2.

**EXAMPLE #59:**

With respect to claim 45, it is not clear where the originally filed instant disclosure described a receiver station which only transmitted bit of digital data as would be needed to support the “at least one” phrase in the recitation “at least one bit of digital data” in line 9. It is also not understood where the original instant disclosure described a process at the receiver station which allowed the “second image” to be provided via “one bit of data” (e.g. “at least one bit of data”) as is now recited in claim 45.

**EXAMPLE #60:**

With respect to claim 45, in the context of claim 44, it is not clear where the originally filed instant disclosure described:

- 1) the “*first image*” of line 3;
- 2) the “*second image*” of line 4;

Art Unit:

- 3) the “receiver station” which “displays all of said first image before displaying any of said second image” as is recited in lines 4 and 5;
- 4) the “*at least one bit of digital data*”, that is transmitted before the step of transmitting said first image, which is processed at said receiver station to provide said second image (as is recited in lines 8 and 9).

**EXAMPLE #61:**

With respect to claim 46, in the context of claim 45, it is not clear where the originally filed instant disclosure described:

- 1) the “*intermediate transmitter station*” of line 2;
- 2) the “*information*” that is retransmitted by the “intermediate transmitter station” as set forth in line 2;
- 3) the “*control signal*” of line 3 that is operative to cause the “intermediate transmitter station” to transmit :
  - a) “*said at least one of the plurality of signals*”;
  - b) “*said first image*”; and, ALTERNATIVELY,
  - c) “*said at least one bit of digital data according to a schedule*”.



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*[Again, for the record, if recited “alternative ways” actually refer to different “processes”/“steps” of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #62:**

With respect to claim 47, in the context of claim 46, it is not clear where the originally filed instant disclosure described:

- 1) the “**control signal**” of line 1 which is operative at said intermediate transmitter station to *delay the transmission of:*
  - a) the “*at least one of said plurality of signals*”;
  - b) the “*first image*”; and, **ALTERNATIVELY**,
  - c) the “*at least one bit of digital data*”.

*[Again, for the record, if recited “alternative ways” actually refer to different “processes”/“steps” of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #63:**

With respect to claim 48, in the context of claim 43, it is not clear where the originally filed instant disclosure described:

- 1) the “*at least one processor instruction*” of lines 3 and 4;

Art Unit:

- 2) the “*at least a first discrete signal*” which is transmitted in lines 3 and 4;
- 3) the “*second discrete signal*” of line 3;
- 4) the “*information*” of line 2 that is contained within said “second discrete signal”;
- 5) the “*information*” of line 2 that is contained within said “at least a first discrete signal”;
- 6) the “*receiver station*” of line 1 which “organizes” the information contained within the at least one first discrete signal with the information that is contained within the second discrete signal.

**EXAMPLE #64:**

With respect to claim 49, in the context of claim 48, it is not clear where the originally filed instant disclosure described:

- 1) the “microcomputer” of line 2;
- 2) the “sequence of instructions” that is recited in line 3;
- 3) the “sequence of instructions” that is recited in lines 5 and 6;
- 4) the “command” that is recited in line 5;
- 5) the “information” of line 2; and
- 6) the “at least one processor instruction” of line 2 which comprises “information” that includes:

Art Unit:

a) “a sequence of instructions which program said microcomputer to generate a portion of said multimedia presentation by processing data contained in said at least one of said plurality of signals”; and,

**ALTERNATIVELY,**

b) “a command which executes a sequence of instructions contained in at least one of said plurality of signals”.

*[Again, for the record, if recited “alternative ways” actually refer to different “processes”/“steps” of the same method, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #65:**

With respect to claim 50, in the context of claim 43, it is not clear where the originally filed instant disclosure described:

- 1) the recited “said at least one of said plurality of signals” that is recited in lines 1 and 2;
- 2) the recited “first kind of said transmissions of different kinds” of line 2 that is included within the recited “at least one of a plurality of signals”;
- 3) the recited “second kind of said transmissions of different kinds” as is recited in lines 3 and 4; and

Art Unit:

2) the step of “transmitting” in line 3 whereby “second kind of said transmissions of different kinds” is transmitted.

**EXAMPLE #66:**

With respect to claim 51, it is not clear where the originally filed instant disclosure described:

- 1) the “*transmitter apparatus*” of line 1;
- 2) the “*receiver station*” of line 2;
- 2) the “*receiver*” of line 6;
- 3) the “*transmitter*” of line 11 that is operatively connected to said “receiver”;
- 4) the “*plurality of signals*” that is recited in line 3;
- 5) the “*portion*” of the multimedia presentation that is recited in line 3;
- 6) the “*information*” of line 8 that is based on a first of said at least two of said plurality of signals;
- 7) the “*information*” of line 9 that is based on a second of said at least two of said plurality of signals;

Art Unit:

6) the “*at least one of the plurality of signals*” of lines 11 and 12 that is transmitted from the “*transmitter*” to the “*receiver station*”.

Clarification is needed.

**EXAMPLE #67:**

With respect to claim 52, in the context of claim 51, it is not clear where the originally filed instant disclosure described:

- 1) the “*signal generator*” of line 3;
- 2) the “*second receiver*” of line 3;
- 3) the “*transmitter*” of line 2;
- 4) the “*apparatus*” of line 2 which comprised:
  - a) the “*signal generator*”; and, ALTERNATIVELY,
  - b) the “*second receiver*”.

*[For the record, if recited “alternative configuration” actually refer to different portions of the same configuration as was originally disclosed, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #67:**

With respect to claim 53, when read in the context of claim 52, it is not clear where the originally filed instant disclosure described:

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- 1) the recited ***“single information transmission”*** of line 2;
- 2) the recited ***“said plurality of signals”*** of line 2;
- 3) the recited ***“combiner”*** of line 3;
- 4) the recited ***“multiplexer”*** of line 3;
- 5) a receiver configuration which comprises:
  - a) the ***“combiner”***; and, ALTERNATIVELY,
  - b) the ***“multiplexer”***.

*[For the record, if recited “alternative configuration” actually refer to different portions of the same configuration as was originally disclosed, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #68:**

With respect to claim 54, when read in the context of claim 51, it is not clear where the originally filed instant disclosure described:

- 1) the ***“first of said plurality of signals”*** recited in line 2 whose transmission is delayed by the ***“transmitter apparatus”*** of lines 1 and 2;
- 2) the ***“second receiver”*** of line 4;
- 3) the ***“memory device”*** of line 6; and

Art Unit:

4) the “*first receiver*” of line 6.

**EXAMPLE #69:**

With respect to claim 55, when read in the context of claim 54, it is not clear where the originally filed instant disclosure described:

- 1) the “*control signals*” of line 4;
- 2) the “*at least a first of said plurality of signals*” that is recited in line 2;
- 3) the “*schedule*” of lines 3 and 4 based on which said “*at least a first of said plurality of signals*” is “*transmitted*” and said “*control signals*” are “*communicated*”;
- 4) the “*controller*” of line 3; and
- 5) the “*memory*” of line 4.

**EXAMPLE #70:**

With respect to claim 56, when read in the context of claim 55, it is not clear where the originally filed instant disclosure described:

- 1) the “*remote user*” of line 2;
- 2) the “*information*” of line 2 that is from said remote user;
- 3) the “*controller*” of line 1;

Art Unit:

- 4) the ***“telephone network”*** of line 4;
- 5) the ***“data transfer network”*** of line 5;
- 6) the ***“apparatus”*** of line 2 which comprises:
  - a) said ***“telephone network”***; and, **ALTERNATIVELY**,
  - b) said ***“data transfer network”***.

*[For the record, if recited “alternative configuration” actually refer to different portions of the same configuration as was originally disclosed, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #71:**

With respect to claim 57, it is not clear where the originally filed instant disclosure described:

- 1) the recited ***“receiver station”*** of lines 2 and 3;
- 2) the recited ***“plurality of signals”*** that ***“is received”*** by said ***“receiver station”*** in lines 4 and 5;
- 3) the ***“at least one instruction signal”*** that is recited in line 4;
- 4) the ***“first transmitter station”*** of line 2;



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- 5) the ***“at least one of the plurality of signals”*** of lines 3 and 4 that is transmitted by the ***“first transmitter station”*** based on said ***“at least one instruction signal”***;
- 6) the ***“second transmitter station”*** of line 7;
- 7) the recited step of ***“receiving”*** said ***“at least one of the plurality of signals”*** at said ***“second transmitter station”*** of lines 7 and 8;
- 8) the ***“at least two of the plurality of signals”*** which are ***“transmissions of different kinds”*** as recited in lines 8 and 9;
- 9) the recited ***“first”*** of said at least two of said plurality of signals of lines 9 and 10;
- 10) the ***“information”*** of line 9 that is based on the recited ***“first”*** of said at least two of said plurality of signals;
- 11) the recited ***“second”*** of said at least two of said plurality of signals of lines 10 and 11;
- 12) the ***“information”*** of line 10 that is based on the recited ***“second”*** of said at least two of said plurality of signals;
- 13) the ***“at least one of said plurality of signals”*** that is transmitted to the first transmitter station as is recited in lines 12 and 13;
- 14) the ***“at least one instruction”*** that is transmitted in line 14; and

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15) the “*network*” of in line 15 that is “*enabled*” to output a “*multimedia presentation*”.

**EXAMPLE #72:**

With respect to claim 58, when read in the context of claim 57, it is not clear where the originally filed instant disclosure described:

- 1) the “*schedule*” of line 4;
- 2) the “*identifier*” of line 2;
- 3) the “*at least a portion*” of the “*identifier*” that is recited in lines 5;
- 6) the “*instruction*” of line 6 into which said “*at least a portion*” of said “*identifier*” was included;
- 7) “*said at least one of said plurality of signals*” that is “*retransmitted*” in lines 2 and 3;
- 8) “*said at least one of said plurality of signals*” that is “*transmitted according to the schedule*” in lines 3 and 4;
- 9) the “*intermediate transmitter station*” of line 2 which:
  - a) *delays retransmission* of said “at least one of said plurality of signals”; and, **ALTERNATIVELY**,
  - b) *transmits said* “at least one of said plurality of signals” *according to said schedule*.

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*[For the record, if recited “alternative configuration” actually refer to different portions of the same configuration as was originally disclosed, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

**EXAMPLE #73:**

With respect to claim 59, when read in the context of claim 57, it is not clear where the originally filed instant disclosure described:

- 1) the “***plurality of signals***” that is recited in line 2;
- 2) the “***said at least one of plurality of signals***” of line 2;
- 3) the “***information***” of line 2 that is “***embedded***” within the “***said at least one of plurality of signals***”;
- 4) the “***switch***” of line 3 which is controlled based on said embedded information;
- 5) the “***at least one instruction***” of line 6;
- 6) the “***at least a portion***” of said “***at least one instruction***” that is recited in lines 5 and 6;
- 7) the “***transmitting***” of “***at least a portion***” of said “***at least one instruction***” that is recited in lines 5 and 6;

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8) the recited “*step of embedding*” of line 4 which occurs “*before*” the recited “*transmitting*” of “*at least a portion*” of said “*at least one instruction*”.

**EXAMPLE #74:**

With respect to claim 60, when read in the context of claim 57, it is not clear where the originally filed instant disclosure described:

- 1) the recited “*identifier*” of line 2;
- 2) the recited “*plurality of storage location*” of lines 2 and 3;
- 3) the recited “*one*” of the recited “*plurality of storage location*” that was selected “*in response*” to the “*identifier*”;
- 4) the “*at least one of the plurality of signals*” which was “*caused*” to be “*stored*” in the selected “*one*” of the “*plurality of storage locations*”;
- 5) “*the at least one of the plurality of signals*” of line 5 which contains the “*instruction*” in which “*at least a portion*” of the “*identifier*” located.

**EXAMPLE #75:**

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With respect to claim 61, it is not clear where the originally filed instant disclosure described:

- 1) an *“intermediate transmitter apparatus”* of line 1 *“for enabling”* a *“receiver station”* to output a *“multimedia presentation”*;
- 2) the *“intermediate transmitter”* of line 5;
- 3) the *“selective transfer device”* of line 10;
- 4) the *“remote transmitter”* of line 11;
- 5) the *“control signal”* of lines 12 and 13;
- 6) the *“control signal detector”* of line 16; and
- 6) the *“selective transfer device”* which was caused to:
  - a) delay transmission of at least one of a plurality of signals which are received at the receiver station; **AND/OR**
  - (ALTERNATIVELY)**
  - b) transmit said at least one of a plurality of signals based on a schedule.

*[For the record, if recited “alternative configuration” actually refer to different portions of the same configuration as was originally disclosed, then there is no section 112-1 support for reciting them in the alternative as is now being done].*

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**EXAMPLE #76:**

With respect to claim 61, it is not clear where the originally filed instant disclosure described the recited apparatus having structure which perform all of the following explicitly and implicitly recited steps/functions:

- 1) the explicitly recited step/function of “*communicating*” the control signal of line 17;
- 2) the implicitly recited step/function of “*transmitting*” at least one of the plurality of signals based on a schedule of lines 14 and 15;
- 3) the implicitly recited step/function of “*delaying*” the transmission of at least one of the plurality of signals of lines 13 and 14;
- 4) the explicitly recited step/function of “*receiving*” the at least one of the plurality of signals at the selective transfer device as is set forth in lines 10 and 11;
- 5) the explicitly recited step/function of “*communicating*” the received at least one of the plurality of signals in response to a control signal of lines 12;
- 6) the implicitly recited step/function of “*causing*” the selective transfer device to perform “at least one of the two implicitly recited steps which have been cited in parts “2)” and “3)” based on the “*communicating*” of part “5)”;

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7) the explicitly recited step/function of “*transmitting*” that is set forth in line 5; and

8) the implicitly recited step/function of “*receiving*” that is set forth in lines 2 and 3.

**EXAMPLE #77:**

With respect to claim 62, when read in the context of claim 61, it is not clear where the originally filed instant disclosure described:

- 1) the recited “storage device” of line 2;
- 2) the recited “storage controller” of lines 2 and 3 that causes said “storage device” to “store or output at least one of said plurality of signals”.

**EXAMPLE #77:**

With respect to claim 63, when read in the context of claim 62, it is not clear where the originally filed instant disclosure described:

- 1) the recited “first switch” of line 3 that is connected to “an input” of said “selective transfer device”
- 2) the “first receiver” of line 5;
- 3) the “input device” of line 6;
- 4) the “first switch controller” of line 7;

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5) the “said storage device and said output” of line 8 that is selected by (or based on) said “first switch controller”.

**EXAMPLE #78:**

With respect to claim 64, when read in the context of claim 63, it is not clear where the originally filed instant disclosure described:

- 1) the “plurality of storage locations” of line 2;
- 2) the “second switch” of line 3;
- 3) the “second switch controller” of line 5;
- 3) the “said at least one of the plurality of signals” of lines 6 and 7 which is transferred from “one of a plurality of storage locations” selected by the “second switch controller”.

**EXAMPLE #78:**

With respect to claim 65, when read in the context of claim 64, it is not clear where the originally filed instant disclosure described:

- 1) the “remote transmitter” of line 4;
- 2) the “at least one control signal” of lines 3 and 4 which is transmitted from said “remote transmitter” which operates (or causes to be operated):



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the control signal detector; the second switch controller; the first switch controller; and the storage controller;

3) the “second receiver” of line 5 which receives said control signal from said remote transmitter.

**27. Those of claims 2-65 which are directed to the processing/distribution of digital television programming (e.g. claims 14 and 31) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

**A). PREFACE:**

**1) For the purpose of this rejection, the examiner has assumed that applicant is actually claiming “digital television” which he recites “digital television” [note “SECTION V” of this Office action]; and**

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**2) As per an earlier agreement, copies of the “prior art” cited in section “B)” of this paragraph have not been provided with this Office action since such copies were previously provided in co-pending application S.N. 08/449,097.**

**B) THE ORIGINAL “DIGITAL TELEVISION” REJECTION:**

**A) Applicant has now presented claims which appear to be directed to the distribution of “digital television signals”. Applicant alleges that the distribution of such “digital television signals” was described by applicants original disclosure. With respect to this allegation, the following is noted:**

**I.** As originally drafted, it seems apparent that applicant uses the terminology “digital television signals” to refer to conventional television signals, e.g. representing conventional television programming, which comprised digitized audio and digitized video signal components [SEE “Example #7” which begins of page 288 of applicant’s current disclosure]. However, as originally filed, applicant’s disclosure clearly lacked any specific description: a) as to how the “digital television signals” of applicant’s alleged invention(s) were to have been formatted for transmission over

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their disclosed television distribution system *using the method(s) that are now recited in the pending claims*; and b) as to how the transmission circuitry of applicant's alleged invention(s) was modified and/or configured for the purpose of handling these digital television signals *in the manner that is now recited in the pending claims*. Apparent justification for the lack of such teachings in applicant's originally filed disclosure seems to be based: 1) on the allegation put forth by the original disclosure that "digital television signals", of the type described/claimed, were well known in the art at the time of applicant's alleged invention [note lines 30-33 on page 288 of applicant's disclosure]; and 2) on the apparent assumption that the "digital television signals" of applicant's disclosure could be handled/transmitted in a manner that was interchangeable with the handling and transmission of conventional analog television signals.<sup>70</sup> The examiner maintains that, at the

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<sup>70</sup> For example, the disclosure described portions of applicant's alleged invention(s) as having operated to transmit digital television signals over a TV channel during a first period of time and as having transmitted analog television signals over said same channel during a subsequent period of time [see lines 1-5 on page 302 of applicant's disclosure]. No discussion as to any difference in the handling of the two different television signals by the alleged invention(s) was ever provided, suggested, or recognized via applicant's original disclosure.

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time of applicant's alleged invention, such allegations and assumptions were in error.

Here, the examiner emphasizes that he does not dispute the fact that broadcasting digitally formatted television signals was in fact well known to those skilled in the art at the time of applicant's alleged invention. Specifically, the examiner acknowledges that the transmission of digital television signals was in fact known when, under "rare" circumstances, a transmission channel of sufficient bandwidth for such digital television signals was available.

However, it is noted that the transmission of conventional digital television signals was not interchangeable with the transmission of analog television signal as assumed by applicant's original disclosure because of the extremely large bandwidth that was required to transmit conventional digital television signals; i.e. this was true even when the digital television signals had been compressed using state of the art bandwidth compression techniques [1][2][3].

Given the above, the examiner maintains that the description found in applicant's original disclosure pertaining to the transmission of "digital television signals" using applicant's alleged

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invention(s) was insufficient to have enabled the pending claims. Specifically, it is maintained that applicant's original disclosure at least failed to disclose and describe the manner in which the recited "digital television signals" had to have been compressed, formatted, and/or processed so as to have enabled them to have been distributed the manner that was originally described; e.g. the manner that now seems to be claimed.

*Because of the above, applicant has been requested to submit evidence (e.g. a US Patent or a printed publication) to show support the allegations and assumptions on which applicant's original disclosure was clearly based; i.e. references which show the means needed to format and transmit "digital television signals" in a manner required by applicant's disclosed/claimed invention(s) were in fact well known to those skilled in the art at the time of applicant's alleged invention.*

II. The examiner also points out that even those sections of applicant's original disclosure which seems to be directed to the transmission of "digital television signals", e.g. "Example #7" which begins on page 288 of applicant's disclosure, provide few clues as

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to how the recited “digital television signals” were to have been compressed, formatted, handled, and transmitted by applicant’s alleged invention(s) in order to have allowed them to be processed in the manner that is now set forth in the pending claims. For example, the description of applicant’s alleged invention(s) failed to explain: 1) how the “digital television signals” of applicant’s alleged invention(s) were formatted and/or compressed so as to have allowed them to have been handled, transmitted, and/or processed in the manner that is now recited in the pending claims; 2) how the “digital television signals” of applicant’s alleged invention(s) were formatted and/or compressed so that they could be transmitted over the same TV channel that was used to carry conventional analog TV broadcasts as originally disclosed [see lines 1-5 on page 302 of applicant’s disclosure]; 3) how the subscriber stations of applicant’s alleged invention were modified in order to have handled/processed “digital television signals” in the manner that is now claimed; 4) how the “SPAM” messages of subscriber stations were to have been embedded in the “digital television signals”, how said “SPAM” messages were to have been carried by said digitally formatted television signals, and how said “SPAM” messages were to have

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been extracted from digitally formatted televisions signals; 5) how the bit-rate of the “SPAM” messages that were carried by said digital television signals was related to the bit-rate of the digital television signals into which they were embedded and how this bit rate related to the bit-rate of the “SPAM” signals that were carried in the analog television signals and how the disclosed/claimed system was configured to handle any such differences [e.g. while not addressed in applicant’s original disclosure, it appears that the differences between the bandwidth of digital television signals and analog television signals would require corresponding changes in the bit-rate of the “SPAM” messages that were embedded in respective ones of the two types of television signals].

**III.** For the reasons set forth in parts “I” and “II” of this paragraph, the examiner maintains that the pending claims which are directed to the handling/transmission of “digital television signals” were not enabled by applicant’s original disclosure because the allegations and assumptions on which the disclosed handling/transmission of such digital television signals was based appear to have been erroneous. The examiner maintains that these

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pending claims represent an *invitation to experimentation* when read in the context of the state of the “digital television signal” transmission art which actually existed at the time of applicant’s alleged invention; i.e. the technology required to have handled/transmitted “digital television signals” in the manner that was disclosed, and thus in the manner that is apparently claimed, does not appear to have existed at the time of applicant’s alleged invention.

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THE PRIOR ART SUPPORT FOR THE REJECTION:

[1] The publication “Digital Television Transmission With 34 Mbit/s” by Burkhardt et al. evidences a conventional transmission system in which a Television signal was broadcasted in a digital format [see figure 2]. Even though the bandwidth of the digital television signal was compressed prior to transmission, said digital signal still required a 22MHz transmission channel [see the second paragraph under the heading “Bit-Rate Reduction” on page 244]; i.e. wherein a bandwidth of 22MHz is almost 4X that of a standard 6 MHz TV channel used for analog television signal transmission.



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[2] The US Patent No. 3,755,624 to Sekimoto evidences a conventional system in which a television signal was digitally formatted and bandwidth compressed prior to broadcast. The resulting bit-rate of this compressed digital television signal was 32 Mbit/s which required a bandwidth more than 3X that of said standard 6MHz Tv channel.

[3] The US Patent No. 4,742,543 to Fredericksen illustrates a system in which a television signal was processed on the transmitter side of a broadcast system in a digital data format [see figure 1]. However, prior to broadcast, Fredericksen converted the digital television signal back into an analog signal format (@33). Such D/A conversion was described as having been necessary because the standard analog TV channel that was used to transmit the television signal was not of sufficient bandwidth to carry the signal in its digital format (note lines 18-23 of column 5). This provides further evidence that conventional “digital television signals” could not be handled in the manner described by applicant of his alleged invention(s).

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**C) ADDRESSING APPLICANT'S ARGUMENTS AND SUBMISSIONS:**

1) The examiner notes that term "digital television" only appears once within the entire 557 pages of applicant's originally filed disclosure and that occurs in line 16 on page 458. However, even here, the specific context in which it is being used is far from clear; i.e. does it refer to the transmission of digital TV programming?, does it refer to the transmission of digital still picture frames in a digital video format?, or does it refer to something else?.....*WHO KNOWS?* In any event, the examiner does not believe that this lone occurrence the "digital television" terminology in the entire 557 pages of applicant's instant specification, i.e. which appears within the phrase "digital television transmission" and not "digital television signal", provides the required antecedent basis or the required section 112-1 support for the use of the "digital television signal" terminology within in the context of all of the presently pending amended claims into which it has now been added/introduced. On its face, the examiner finds it difficult to accept applicant's allegation that his disclosure could have adequately disclosed or described the numerous methods and structures for distributing and processing "digital television signal" which are now allegedly being claimed, when the term "digital television signal" itself does

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not appear anywhere within the 557 pages of his originally filed disclosure <sup>71</sup>.

2) While the term “digital television signals” does not occur anywhere within applicant’s originally filed disclosure, applicant’s originally filed disclosure did set forth “Example #7”, whose description begins on page 288 of applicant’s original written description, which allegedly operated to transmit “*well known*” digital video and digital audio signals; i.e. a “digitized television signal”(?). While much of the “Example #7” description remains unclear to the examiner, what seems quite clear is that “Example #7” sets forth an embodiment in which:

a) an television origination station was configured so as to selectively output analog television signals and digitized television signals; and

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<sup>71</sup> In the past, applicant has alleged that his right to be his own lexicographer gives him the right to introduce the “digital television signal” terminology into his pending amended claims. The examiner maintains that this is only true if/when applicant or the record clearly explicitly defines the newly introduced terminology in a manner which is consistent with the scope of the originally filed disclosure and is consistent with the normal/accepted meaning of the introduced terminology. The examiner maintains that applicant continues to fail to meet such a burden on both accounts; i.e. applicant refused to explicitly define the meaning of this introduced “digital television signal” terminology and one can only guess as to its intended scope/meaning based on applicant’s originally filed disclosure.

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b) a television distribution network was configured to distribute the originated analog television signals and originated digitized television signals over the same “pipes” during respective times of the day [i.e. SEE lines 1-5 on page 302].

The examiner maintains that this description was not enabling at the time of applicant’s alleged invention because it seems to be based: on a basic misunderstanding as to the very diverse nature of analog and digital television transmissions (i.e. on the erroneous assumption that analog and digital television transmissions are simply interchangeable); and/or on the erroneous assumption that bandwidth compression technology existed in 1987 which would have allowed such analog and digital transmission interchange ability [note “THE ORIGINAL” rejection that is set forth in part “B” of this paragraph]. Trying to have made and used the system which was founded in such misunderstanding or based on such erroneous assumptions (i.e. that which is now allegedly being claimed) would have been impossible. The examiner notes the following:

a) At the time of applicant’s alleged invention, those of ordinary skill in the art had long recognized the many benefits that could be obtained by processing and transmitting “digital television signals” in place of “analog television signals”. However, those of ordinary

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skill in the art understood that there was a “big catch” attached to digitized television signal transmission which prevented its use. Namely, the “pipes”/circuitry needed to distribute and process the “digital television signals” of the day had to be of an unacceptably large bandwidth; i.e. many times greater than those used to distribute and process their analog counterparts <sup>72</sup>. One simply could not transmit and process digital television signals using the same “pipes”/circuitry which carried/processed analog television signals as erroneously alleged/described/assumed within the “Example #7” embodiment of applicant’s originally filed disclosure [i.e. again, note lines 1-5 on page 302]. Simply put, applicant’s originally filed disclosure contributed absolutely nothing to the digital TV broadcast art which would have enabled one of ordinary skill in the art to have overcome the well known bandwidth “catch” inherent to digital television signal transmission. Instead, it appears that applicant’s original disclosure chose to ignore the bandwidth problem (or failed to recognize that it even existed). Unfortunately,

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<sup>72</sup> SEE: the article “A Primer on Digital Television” by Howell on pages 538-541 of the July 1975 issue of the *Journal of the SMPTE* (volume 84); the article “Goodbye, TV Snow” by Ferre on pages 14-22 of the May 1977 issue of *Electronic Servicing*, and the article “The Impact of Digital Techniques on Studio Equipment” by F.G. Parker (i.e. cited by applicant).

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this bandwidth “catch” could not be ignored by those of ordinary skill in the art when trying to implement that which applicant described and now (apparently) claims. Being such, applicant’s example #7 description was not enabling of that which it described (i.e. that which is now allegedly claimed);

b) What has now made the broadcast/distribution of “digital television signals” possible in today’s world, i.e. in the year 2001, has been the discovery, *by others*, of high compression ratio algorithms which now allow broadcast quality television signals to be carried/distributed via “pipes” of conventional/available bandwidth. Applicant’s original 1987 disclosure contributed nothing to these enabling advancements in the compression technology nor could it possibly be based on such advancements in view that they did not exist as of applicant’s original 1987 filing date. Thus, it seems that applicant’s allusions to the distribution/processing of digital video/audio signals in “Example #7” represented, at best, an understanding or recognition on the part of applicant that digital television signal transmission systems would probably be realized some time in the coming future and, at

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such a time, that that which applicant described as "Example #7" might then be applied/extended thereto <sup>73</sup>; and

c) Applicant's original 1987 disclosure, clearly alleged that the "[digital] television signal" of applicant's "Example #7" embodiment, i.e. one consisting of so-called "digital video" and "digital audio", was *well known in the art* at the time of applicant alleged invention [see lines 30-33 on page 288 of applicant's written description]. In the past, after his review of the 2000+ references submitted by applicant failed to find such a showing, the examiner *required* applicant to submit a reference to support the allegation made in applicant's disclosure; i.e. that such described [digital] television signals were in fact "well known" [again, note "THE ORIGINAL" rejection of part "B" above]. In response to this requirement, applicant submitted US Patent #3,906,480 to Schwartz et al. However, Schwartz et al. seems to be totally unrelated to the alleged "[digital] television signals" of applicant's "Example #7" embodiment. For example, the digital video signals

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<sup>73</sup> The examiner is not acknowledging that he understands applicant's example #7 description in terms of how it supports the pending claims [i.e. an issue which will be addressed under the adequate written description requirement of section 112-1].

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described in the Schwartz et al. patent represented non-real non-real-time computer generated, vector encoded, symbolic and alphanumeric images. Such a transmission scheme could not have been used to carry/transmit the digital video component of conventional television signals/programming of the type that is set forth by applicant's "Example #7". For applicant to suggest that teaching of Schwartz et al. be used as scheme for producing the "digital video" of his "Example #7", given its completely non-analogous nature, would be an invitation to experimentation even by today's standards!



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**SECTION XI: (Preface to the Rejection of Claims  
Based on Prior Art Applied Under Sections 102 and  
103).**

**A. APPLICANT'S ALLEGED INVENTION REPRESENTS  
APPLICANT'S OWN VERSION OF AN "EXTENDED" TELETEXT  
TRANSMISSION SCHEME (AND APPLICATIONS THEREOF):**

As best understood by the examiner, applicant's instant 1987 disclosure described a television distribution system in which digitally encoded "SPAM message" packets were generated by a SPAM signal source and embedded, preferably, into the vertical blanking interval (VBI) of TV programming that was provided from a TV studio (i.e. the network/originating TV station). The TV programming along with its embedded SPAM message packets were then distributed/transmitted from a network/originating TV station, via a television distribution network, to various "receiver stations" which were situated throughout the distribution network; i.e. wherein the term "receiver station" was used by applicant in a way that encompasses both "intermediate TV broadcast stations" and "ultimate household receiver stations". At ones of the receiver stations, ones of the "SPAM message" packets were received (i.e. extracted from the TV programming), identified,

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decoded, and processed or outputted by SPAM signal receiving/decoding circuitry. In the preferred embodiment, the SPAM signal receiving/decoding circuitry was implemented using software driven processors.

As also described in applicant's 1987 disclosure, the SPAM message packets that were distributed by applicant's television distribution system carried information pertaining to a wide variety of control, monitoring, and messaging functions. More specifically, the information carried by the SPAM message packets could be used to: 1) to distribute display information to ones of the receiver stations; 2) to distribute monitoring information to ones of the receiver stations; 3) to distribute program identification codes to ones of the receiver stations; 4) to distribute cuing/triggering signals to ones of the receiver stations; 5) to distribute computer software to ones of the receiver stations; 6) to distribute commands to ones of the receiver stations; etc,...

The following is noted:

1) In the past, the examiner argued that applicant's SPAM message packets comprised little more than applicant's own variation of conventional packetized teletext data. At that time, applicant disagreed with the examiner's position arguing that term "teletext" referred *only* to the transmission of digitally coded character/graphics codes. Strictly speaking, applicant was correct. What the examiner should have stated was that

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applicant's SPAM message packets comprise little more than applicant's own variation of conventional digitally encoded "insertion/ancillary signals"; i.e. of which packetized "teletext data" was a known/conventional subset [NOTE APPENDIX III OF THIS OFFICE ACTION]. While the examiner is willing to accept/entertain applicant's strict interpretation of the term "teletext", the examiner nonetheless points out that it was notoriously well known in the art to have "extended" the use of conventional Teletext data packets within conventional teletext distribution systems to carry information/data other than digitally coded character/graphics codes; i.e. to have carried ancillary data other than "teletext data" as strictly defined by applicant [e.g. Telesoftware (computer software) being but one example of these known teletext packet "extensions"]. Applicant's SPAM packets appear to be little more than applicant's own version of such an "extended" teletext system. Being such, it appears that the arguments that were previously presented by applicant merely focussed on the technicality those data packets of an "extended" teletext distribution system which carry *other types of information* are not, strictly speaking, packets of teletext data packets; i.e. they do not carry character/graphics codes. So what!

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The fact remains that the generation and embedding of digitally encoded packetized data within the VBI of distributed TV programming, e.g. in the form of digitally encoded “insertion/ancillary signals” including packetized “teletext data”, was notoriously well known in the art at the time of applicant’s alleged invention. It remains the examiner’s position that the generation and embedding of SPAM message packets into the VBI of distributed TV programming, as described in applicant’s own 1987 disclosure, represents applicant own variation on this notoriously well known theme. The examiner is not to saying that applicant’s own variation/application/implementation of such insertion/ancillary systems are necessarily unpatentable based solely on this fact. However, the examiner is stressing the point that the applied prior art of record, e.g. particularly the “teletext” prior art, is far more closely related to applicant’s alleged invention than the terminology used throughout applicant’s claims and disclosure suggest. Likewise, it is believed that the prior art of record, e.g. particularly the “teletext” prior art, is also far more closely related to applicant’s alleged invention than applicant has ever been willing to acknowledge <sup>74</sup>. In view of this, the examiner maintains that extreme care is needed as one attempts to decipher the scope/meaning of applicant’s

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<sup>74</sup> Obviously the reason so much teletext “prior art” art has been made of record by all involved!

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pending claims in the search of recited differences that do more than give an appearance or impression of patentability. To this point, the following is noted:

1) Many of applicant's claims recite various "discrete signals".

As set forth in Appendix A of applicant's latest response, all of the various "discrete signals" are allegedly supported solely by the fact that the SPAM signals of his 1987 disclosure comprised: discrete words, discrete packets, discrete sequences of packets, discrete header portions, and discrete information portions. The examiner maintains that, by giving such a broad meaning to the recited "discrete signal" terminology, the recited "discrete signal" terminology does little to nothing to overcome/avoid the applied prior art of record because the digitally encoded "insertion/ancillary signals", e.g. packetized "teletext data" of the applied prior art, implicitly comprised: discrete words, discrete packets, discrete sequences of packets, discrete header portions, and discrete information portions too. Hence, the various "discrete signals" recitations of the claims appear to be nothing more than a *straw man*.

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2) Many of applicant's claims recite pluralities of *separate* steps for embedding, transferring, transmitting, and receiving *separately* recited "discrete signals", "instructions", "instruction signals", and "control signals". However, when specifying where these *separate* steps allegedly derive support from his 1987 disclosure [see Appendix A of applicant's latest response], applicant points to the *same* disclosed "step"(?) in which the SPAM messages themselves were generically described as being originated , embedded, transferred, transmitted, and then received. Thus, based on applicant's citation of alleged support from Appendix A of applicant's latest response, it appears to be applicant's position that all of these separately recited steps from applicant's claims were obviously/implicitly described in his 1987 disclosure by the described generation, embedding, transferring, transmitting, and receiving of the SPAM messages themselves. Specifically, applicant appears to allege that any step/process which was described as having been performed on the SPAM messages themselves was also, implicitly, performed *separately* on each component thereof ( wherein the SPAM messages themselves comprised different discrete signals, different instruction signals,

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different instructions, and different control signals). More specifically, it appears to be applicant's position that because the disclosure described the generation, embedding, transferring, transmitting, and receiving of SPAM messages, said disclosure implicitly described the generation, embedding, transferring, transmitting, and receiving of the different discrete signals, different instruction signals, different instructions, and different control signals which comprised the SPAM messages [e.g. note that Appendix A of applicant's last response alleges that support for many of the separately recited steps and signals (i.e. instructions and control signals) is derived the same step of processing the same "second series of instructions"]. Overlooking the issue as to whether this kind of *implied* support meets the "immediately discernible" description requirement of section 112-1 (in the examiner's opinion, it does not), it is evident that **separately** reciting the same disclosed step/process numerous times in a single claim does little to nothing to overcome/avoid the applied prior art of record because the digitally encoded "insertion/ancillary data" of the applied prior art, e.g. packetized "teletext data", also obviously/implicitly comprised different instructions, different

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control signals, different instruction signals, and different discrete signals and therefor, following applicant's own reasoning and justification, also obviously/implicitly comprised **separate** steps of generating ,embedding , transferring , transmitting , and receiving each of the insertion/ancillary signal components. Again, reciting pluralities of **separate steps** which simply describe the same steps of processing and transmitting generic SPAM message packets constitutes another *straw man* (i.e. albeit, a convoluted and confusing *straw man*);

3) Many of applicant's claims recite that each receiver station "includes a receiver, a signal detector, a processor, and an output device." The examiner maintains that such structure is part of any/all TV receivers and is also part of any/all digitally encoded insertion/ancillary signal receivers/decoders; i.e. any/all TV receivers and insertion/ancillary signal receivers/decoders must have comprised circuitry for receiving the transmitted/broadcasted signals, circuitry for demodulating/detecting the transmitted/broadcasted signal, circuitry for processing the demodulated signals; and circuitry for outputting/displaying data/information based on the received signals. Thus, the examiner



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maintains that these recitations also constitute nothing more than *straw men*

4) Many of applicant's claims include words or phrases which initially appear to be significant but, upon close inspection, add nothing of substance to the claim(s). For example: the recitation of "at a particular place and time" in claim 67 (i.e. any signal that is received will be received at a particular place and time); the recitation of a "target" processor in claim 75 (i.e. any processor which receives information directed to it is at least *targeted* by that information); the recitation of "before a specific time" in claim 80 (i.e. all signals must be transmitted from the transmission side before "some specific time" at which they are received on the receiver side); etc,... Simply more *straw men*!

**B. APPLICANT'S CURRENTLY PENDING CLAIMS ARE *NOT***  
**ENTITLED TO THE 11/3/81 FILING DATE FOR REASONS WHICH**  
**HAVE BEEN FULLY ADDRESSED ABOVE.** [NOTE: "SECTION I" AND  
"SECTION III" OF THIS OFFICE ACTION].

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**C. "PRIOR ART" WORTH NOTING:**

I. Nishihara [Japanese Patent document # 58-209276] has been cited for its showing of a TV receiver which, in response to the detection of header/control signals in received "program related" teletext pages, produced an on-screen message/caption which signaled the TV user/viewer that program related teletext pages were "available" (e.g. for selection, superimposure, and display) within the TV broadcast currently being received/watched/displayed. Specifically, Nishihara was cited for the following showings:

1) That it was conventional for Teletext transmission services to have dedicated specific ones of their teletext pages (i.e. specific page numbers) to:

A) the transmission of independent teletext pages whose image content was unrelated to the content of the TV programming in which it was embedded/transmitted; and

B) the transmission of "program related" teletext pages whose image content "supplemented" the content of the TV programming in which it was embedded/transmitted.

[note the paragraph which begins in the last 6 lines on page 3 of the attached translation]

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2) That it was conventional for the receivers of such systems to have comprised:

A) circuitry for detecting the presence/receipt of the “program related” teletext pages within the TV programming broadcast that is currently being received and displayed:

B) circuitry for provided the user/subscriber with an indication as to the detected presence/receipt of the “program related” teletext pages within the TV programming broadcast that is currently being received via either:

1. A caption/message that is overlaid over the displayed TV picture as an indication as to the availability of additional/supplemental information; or
2. A separate indicator (i.e. a lamp/LED) that is lit as the indication as to the availability of additional/supplemental information.

[note lines 16-20 on page 8 of the attached translation]

3) That it was conventional to have selectively overlaid the “program related” teletext image data over the displayed TV programming when so desired/selected by the user.

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[note lines 1-6 on page 4 of the attached translation]

4) That it was conventional/frequent to have implemented all of the different processing functions which comprise the typical teletext data receiving/decoding circuitry using an appropriately programmed microcomputer

[note the paragraph that begins in the last 4 lines on page 8 of the attached translation and extends to the first 5 lines on page 9 of the attached translation].

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**28. SECTION XI: (Rejections under 35 U.S.C. 102)**

**29. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**30. Claim 2 and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by “standard television receivers/sets” as exemplified in figure 1 of Lunn [US Patent #4,383,273].**

1) The examiner maintains that standard TV signals represented multimedia presentations in that they comprised a video signal component and a different audio signal component. Being such, the examiner maintains that a standard TV receiver which operated to present the audio and video signal components of a standard TV signal were, by definition, multimedia presentation devices.

2) The term *transmission*, by definition, simply means: “something that is transmitted”. Being such, by definition, the audio and video signal components of a standard TV signal represent different kinds of transmission; i.e. the audio signal

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component represents an audio-kind of transmission and the video component represent a video-kind of transmission.

3) Given the above, the maintains that the limitations of claims 2 and 37 are met by the structure of conventional/“standard” TV receivers. More specifically, the examiner takes Official Notice that conventional/“standard” TV receivers inherently comprised:

- A) circuitry for receiving both the audio and the video signals from the audio and video transmission of a received TV signal;
- B) circuitry for processing portions of the audio and video signals to obtain audio and video portions of a multimedia presentation; and
- C) circuitry for outputting the multimedia presentation based on the processed audio and video signals wherein the outputted multimedia presentation comprised audio information derived from the audio-kind of transmission and comprised video information from the video-kind of transmission. <sup>75</sup>

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<sup>75</sup> For example, the examiner maintains that figure 1 in the US Patent #4,383,273 to Lunn illustrates the fact that conventional TV receivers comprised: audio component processing sections (20); audio component output devices (22); video component processing sections (24); video component output devices (26); and a signal processing section (28) which includes circuitry for processing incoming “control signals” such as horizontal and vertical synchronizing signals.

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**31. Claim 51 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by “standard television receivers/sets” as exemplified in figure 1 of Lunn [US Patent #4,383,273] for the same reasons which were set forth for claims 2 and 37 in the preceding paragraph of this Office action.**

The examiner maintains that such conventional TV receivers inherently received the TV programming that was displayed from some type of “transmitter apparatus”; i.e. be it a broadcast station, a CATV headend, a VCR, ...

**32. Claim 2 and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366].**

**I. PREFACE (“Teletext”) :**

“Teletext” is a generic term that refers to graphics/character information which was inserted into conventional TV signals/programming for distribution, along with the conventional TV signals/programming, to television receivers located throughout a TV distribution network. Those of the television receivers which comprised appropriate teletext decoding circuitry were able to receive the TV signals/programming, extract desired portions/“pages” of the graphics/character information from the received TV signals/programming, and display these extracted portions/“pages” of the graphics/character information on the display

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device of the TV receiver. The displayed portion of the Teletext data could be displayed alone on the display device, or the data could be displayed along with displayed TV signals/programming as a cut-in “box” or as an overlay. The following is noted:

- 1) The examiner maintains that a displayed TV signal/program represents “a multimedia presentation” because it comprises both a video media component and audio media component. When teletext data is displayed too, a third graphics/character media component is added to the multimedia presentation.
- 2) The term *transmission*, by definition, simply means: “something that is transmitted”. Being such, teletext data and TV signals/programming represent “different transmissions” even when they are transmitted simultaneously through a common TV channel: i.e. the teletext data represents “something that is transmitted” and the TV signals/programming represent a different “something that is transmitted”.

Given the above, the examiner maintains that the limitation of claims 2 and 37 read on any TV receiver which operated to display selected portions/”pages” of a received teletext data transmission simultaneously with a received television signal/programming transmission [note that the same reasoning that was set forth



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for audio and video signal components in the previous paragraph of this Office action also applies to video, audio, and teletext signal components within the present paragraph].

## **II. The applied prior art:**

In accordance with that discussed above in part I of this paragraph, each of Hutt et al. (figure 4), Bart et al. (figure 1), Oono et al. (figure 3) and Betts (figure 1) disclosed a TV receiver which operated to display selected portions/"pages" of a received teletext data transmission simultaneously with a received television signal/programming transmission. Namely, a TV receiver which comprised each of the following:

- 1) Front end tuning/processing circuitry for receiving a plurality of signals from a selected TV channel, wherein the received signals comprised a video media component/transmission, and audio media component/transmission, and a Teletext media component/transmission;
- 2) Teletext decoding circuitry for "processing" <sup>76</sup> at least a portion of the Teletext media component/transmission to generated displayable graphics/character images; and

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<sup>76</sup> Wherein the *processing* includes steps for extracting, selecting, and decoding portions/pages of teletext data for display .

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3) switching/mixing circuitry for outputting, based on the processing perform by the Teletext decoding circuitry, a multimedia presentation comprising the video component of the received TV signal/programming and the generated graphics/character images overlaid and/or inserted therein.

**33. Claim 51-53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366] as was set forth for claims 2 and 37 in the preceding paragraph of this Office action.**

1) The examiner maintains that such conventional TV receivers inherently received the TV programming that was displayed from some type of “transmitter apparatus”; i.e. be it a broadcast station, a CATV headend, a VCR, ...

2) The examiner takes Official Notice that the “teletext” data, which was conventionally transmitted in the VBI of a conventional television signals, typically <sup>77</sup> comprised coded character/graphics data. More specifically, the

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<sup>77</sup> The examiner acknowledges that in very rare circumstances, e.g. when transmitting thousands of different Chinese characters, teletext data was known to have comprised displayable pixel data. This, however, is a rare exception.

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examiner points out that such transmitted teletext data did not comprise displayable pixel/image data. Rather said teletext data comprised sequences of character/graphics codes wherein each code: identified one of a plurality of pixel patterns that was locally stored in a memory on the receiver side; and identified the location on a display screen at which said identified pixel pattern was to be displayed so as to generate a desired teletext image/frame. In combination, each sequence of the transmitted teletext character/graphics codes identified how ones of the locally stored pixel patterns were to have been retrieved and assembled at the receiver, e.g. via a character generator, so as to generate a displayable image/page. *In light of the preceding discussion, the examiner maintains that an image generated from received teletext character/graphic codes clearly falls within a fair reading of the recited terminology: "locally generated image".*

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**34. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oono et al. [JP 55028691], or Betts [GB #1,556,366].**

1) SEE: The rejection of claims 2 and 37 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366].

1) NOTE: That the teletext decoding circuitry in each of Oono et al. and Betts was controlled by a software driven CPU/MPU; an element of the TV receiver which had to be “programmed” with software to perform its *processing*.

**35. Claims 4, 5, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366], for the same reason that was set forth for claim 2 and 37 above.**

1) With respect to claim 4, it is maintained that the character/graphics images that are produced by the teletext decoders of the applied prior art are in fact images that are locally generated within the disclosed TV receivers.

*NOTE: The examiner takes Official Notice that the “teletext” data, which was conventionally transmitted in the VBI of a conventional*

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*television signals, typically <sup>78</sup> comprised coded character/graphics data. More specifically, the examiner points out that such transmitted teletext data did not comprise displayable pixel/image data. Rather said teletext data comprised sequences of character/graphics codes wherein each code: identified one of a plurality of pixel patterns that was locally stored in a memory on the receiver side; and identified the location on a display screen at which said identified pixel pattern was to be displayed so as to generate a desired teletext image/frame. In combination, each sequence of the transmitted teletext character/graphics codes identified how ones of the locally stored pixel patterns were to have been retrieved and assembled at the receiver, e.g. via a character generator, so as to generate a displayable image/page. In light of the preceding discussion, the examiner maintains that an image generated from received teletext character/graphic codes clearly falls within a fair reading of the recited terminology: “locally generated image”.*

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<sup>78</sup> The examiner acknowledges that in very rare circumstances, e.g. when transmitting thousands of different Chinese characters, teletext data was known to have comprised displayable pixel data. This, however, is a rare exception.

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2) With respect to claim 5, it is noted that either of the two recited alternatives was an inherent part of conventional teletext display: i.e. teletext transmissions contain (I) data and (ii) instructions which are used in the generation of the displayable images.

3) With respect to claim 13, it is noted that the selected portions/pages of teletext data are stored within a page memory the teletext decoders of the applied prior art during the time in which the TV signal/programming are being received.

**36. Claim 14 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oono et al. [JP 55028691], or Betts [GB #1,556,366].**

1) SEE: The rejection of claims 13 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366]. Note:

A) That the teletext decoding circuitry in each of Oono et al. and Betts was controlled by a software driven CPU/MPU which was operatively connected to a memory;

B) The receivers of Oono et al. and Betts process and display analog TV programming; and

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C) The teletext data itself is digital data that represents content of the multimedia television presentation and therefor, rather loosely, contains some form of "television program content".

**37. Claims 38, 39, and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oono et al. [JP 55028691], or Betts [GB #1,556,366].**

1) SEE: The rejection of claims 2 and 37 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366]. Note:

A) That the teletext decoding circuitry in each of Oono et al. and Betts was controlled by a software driven CPU/MPU which was operatively connected to a memory.

**38. Claim 42 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oono et al. [JP 55028691].**

1) SEE: The rejection of claims 38, 39, and 41 under section 102(b) by either 1) Oono et al. [JP 55028691] or 2) Betts [GB #1,556,366]. Note:

A) Telephone interface (10) in figure 3 of Oono et al.

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**39. Claims 2 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hirashima [JP 0049084].**

As is shown on the cover page, Hirashima disclosed a multimedia presentation device for outputting a multimedia presentation comprised of a “real” motion video component, text/graphic video component, and a sub-sound component. The device includes a tuner (1) for receiving a plurality of signals corresponding to different kinds transmissions wherein the different kinds of transmission include: 1) an analog video signal transmission component; 2) a digital character video signal transmission component; 3) an audio signal transmission component; and 4) a sub-sound signal transmission component. When outputting said multimedia presentation, an “instruction” contained within the sub-sound transmission component is detected (i.e. at 22, 23, and 16) and is used to control the processing of a portion of data contained within the digital character transmission component (i.e. at 13, 15, 17, 18, and 19) whereby a portion of data that is processed is used to simultaneously (i.e. “synchronously”) deliver the character portion of the video of the multimedia presentation that is projected onto the display (7).

**[See the PTO obtained translation of Hirashima].**



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**40. Claims 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirashima [JP 0049084] for the same reasons that were set forth for claims 2 and 8 in the preceding paragraph of this Office action**

1) The examiner notes that the term “synchronizing” means: “to cause to occur at the same time; to cause to occur simultaneously”.

2) The examiner notes that the “instruction” in the sub-sound signal of Hirashima caused sequential portions of the digital character transmission component to be selected, processed, and displayed in “synchronism” and/or “simultaneously” with the outputting of corresponding sequential portions of sub-sound signal component itself.

**41. Claims 20, 22-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirashima [JP 0049084] for the same reasons that were set forth for claims 9-11 in the preceding paragraph of this Office action.**

**42. Claims 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al [GB 1,213,357].**

Jackson et al disclosed a multimedia presentation system which comprised:

A) A transmitter station (figure 1), which comprised:

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1) a plurality of multimedia presentation sources ("SOURCE 1" to "SOURCE 3"), wherein each presentation source comprised a video presentation component source (i.e. "V") and an audio presentation component source (i.e. "S");

2) circuitry for combining the plurality of video presentation components into a single video component transmission (i.e. gates G1-G3 and the illustrated "SUBCARRIER NOTCH FILTER");

3) circuitry for adding and tagging each of the audio presentation components with identification/control information (i.e. "IDENT PULSE GEN I");

4) circuitry for combining the plurality of tagged audio presentation components into a single audio component transmission (i.e. BALANCED SAMPLER(s) "B1" to "B3" and the "BALANCED MODULATOR");and

5) means for adding the combined video and combined audio transmissions together to create a combined audio/video component transmission for transmission by a transmitter (i.e. "ADD");and

B) a plurality of receiver stations, one of which is shown in figure 3(a), each of which comprised:

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- 1) user controlled circuitry (i.e. "GATE A PULSE GENERATOR") for "programming" the receiver station to select one of the audio presentation components (i.e. @ "AUDIO' GATE") from the combined audio component transmission for further processing (i.e. @ "FILTER" and "AUDIO AMP") and presentation via an output/speaker device (L/S);
- 2) circuitry (i.e. "TUNED AMP & DETECTOR") for extracting the identification/control information from the selected audio presentation component;
- 3) circuitry (i.e. "GATE V PULSE GENERATOR") for using the extracted identification/control information to select the respective video presentation component (i.e. @ "VIDEO GATE") from the combined video component transmission for further processing (i.e. @ "VIDIO STORE") and display via an output/CRT device (i.e. "T.V. DISPLAY).

**43. Claims 3, 4, 6, 9-11, 13, 16, 20, 21, 23, 24, 26, 29, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al [GB 1,213,357] for the same**

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**reasons that were set forth for claims 2 and 8 in the preceding paragraph of this Office action.**

**44. Claims 29 and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Block et al. [US Patent #4,225,884].**

As is illustrated in figures 3 and 4, Block et al. disclosed a TV transmission system for transmitting and displaying multimedia TV programming presentation which were comprised of: 1) an audio multimedia component; and 2) a video multimedia component. The receiver stations of the Block et al. system, i.e. as illustrated in figure 4, comprised:

- 1) a processor (i.e. 26 and 32) which was “programmed” with information obtained by processing a first control signal which was downloaded to it via an attached telephone line;
- 2) a code detector (64), located within signal processor (26,32), for receiving second control signals (i.e. within SVID) from a remote transmitter station (i.e. figure 2);
- 3) said processor (i.e. 26, 32) which responds to the received second control signal based on the programming obtained by processing said first control signal so as to enable the descrambling and outputting (@ 60, 62)

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of a multimedia presentation that was comprised of an audio multimedia component and a video multimedia component.

**45. Claims 2-5, 20-24, 26, and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Block et al. [US Patent #4,225,884] fort the same reasons that were set forth for claims 29 and 32 in the preceding paragraph of this Office action.**

**The following is noted:**

The audio signal and the video signal described in Block et al. constituted a plurality of discrete multimedia signals/components which inherently originated from different kinds of sources at the transmitter (note the two inputs to figure 3) and which were inherently provided to different kinds display devices at the receiver stations (note the two outputs of figure 4). Both of the multimedia signals/components (audio and video) were provided to the receiver stations of figure 4 from the remote transmitter station of figure 3 and both of the multimedia signals/components (audio and video) were processed by respective processing circuits (i.e. elements 60 and 62 of figure 4) on the receiver station side of the system prior to output/display; i.e. wherein the audio multimedia signals/component was processed (@ 60) based on control data/"instructions" which were contained within the video multimedia signals/component (i.e. within SVID of figure 4). The examiner further notes that element "16" of figure 3

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represents an “intermediate transmitter” as is recited in claim 21; i.e. the transmitter is positioned a point in the distribution network that is (at least) *intermediate* to the video/audio component sources and the receiver stations of figure 4.

**46. Claims 33-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Block et al. [US Patent #4,225,884] fort the same reasons that were set forth for claims 2-5, 20-24, 26 and 37 in the preceding paragraph of this Office action. The following is noted:**

1) As is shown in figure 6, the system disclosed by Block et al. comprised a comparator (92) which operated to compare a code stored within a memory (90) which was located at the receiver station to a code contained within the transmitted video component of the multimedia presentation. The stored code, and hence the comparison, was provided based on an input/response entered (i.e. @30) by the viewer/user.

2) As discussed in lines 47-68 of column 7, the access unit “32” disclosed by Block et al. transmitted codes representing the users inputs/responses (codes representing the actual programs the viewer selected for viewing) to a remote billing computer via telephone lines.

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**47. SECTION XII: (Rejections under 35 U.S.C. 103(a))**

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).**



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**48. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over “standard television receivers/sets”, as exemplified in figure 1 of Lunn [US Patent #4,383,273], for the same reasons that were set forth for claims 2 and 37 above.**

SEE: The rejection of claims 2 and 37 under section 102(b) over “standard television receivers/sets”. Note:

1) With respect to claim 6, it is noted that it was conventional for audio portion of conventional TV signals/programming to have been comprised of a Secondary Audio Program (SAP) signal; i.e. an additional audio media component corresponding to audio of a secondary/different language. It would at least have been obvious to one of ordinary skill in the art for the/a “standard television receivers/set” to have been configured to have received and displayed such “SAP” signals.

**49. Claims 6, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366].**

SEE: The rejection of claims 2 and 37 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366]. Note:

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1) With respect to claim 6, it is noted that it was conventional for audio portion of conventional TV signals/programming to have been comprised of a Secondary Audio Program (SAP) signal; i.e. an additional audio media component corresponding to audio of a secondary/different language. It would at least have been obvious to one of ordinary skill in the art for the TV signals/programs of the applied prior art to have been of such a conventional type.

2) With respect to claim 12, the examiner takes Official notice that it was notoriously well known for TV receivers to have included means for printing desired portions/pages of displayed teletext data. The examiner maintains that it would have been obvious to one skilled in the art to have added such a conventional printing feature to the TV receivers of the applied prior art.

3) With respect to claim 16, the examiner maintains that it would have been obvious for the transmission medium, over which the plurality of signals were transmitted to the TV receivers of the applied prior art, to have been comprised of fiber optic cable; i.e. thereby requiring a cable "box" type device for processing both electrical and optical signals.

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**50. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oono et al. [JP 55028691] or Betts [GB #1,556,366].**

a) See: The rejection of claim 14 under section 102 (b) over Oono et al. [JP 55028691] or Betts [GB #1,556,366].

B) The examiner maintains that it would at least have been obvious to one skilled in the art that the audio portion that was outputted by the receivers which were described by Oono et al. and Betts would have pertained to, and describe, the video content of the multimedia presentation; i.e. such as when the multimedia presentation was a sporting event or a documentary.

**51. Claims 17, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oono et al. [JP 55028691].**

SEE: The rejection of claims 2 and 37 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366]. Note:

a) That Oono et al. is a two-way system in which the teletext that is received was downloaded from a data service server based on requests

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provided from the TV receiver via connections made to the server via a telephone line/signal.

**52. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oono et al. [JP 55028691] or Betts [GB #1,556,366] in view of Barrett [US Patent #4,205,343] .**

1) SEE: The rejection of claims 38, 39, and 41 under section 102(b) by either 1) Oono et al. [JP 55028691] or 2) Betts [GB #1,556,366]. Note that neither of these references discussed a “decrypter”, connected to their CPU/MPU, for decrypting the received teletext broadcasts.

2) Barrett evidences conventional means and desires for encrypting and decrypting teletext broadcasts.

3) The examiner maintains that it would have been obvious to have modified the teletext decoders described by Oono et al. and Betts with decrypting circuitry described in Barrett in order to have allowed the teletext decoders to have received encrypted teletext broadcasts which, as evidenced by Barrett, were known to have been desirable.

**53. Claims 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oono et al. [JP 55028691] or Betts [GB #1,556,366] in view of Barrett [US**

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**Patent #4,205,343] for the same reasons which were set forth in the preceding paragraph of this Office action. The following is note:**

1) The examiner notes that applicant has alleged priority back to the 1981 disclosure. The 1981 disclosure did not disclose means for downloading software to the receiver stations; i.e. the receiver stations in the 1981 disclosure were “preprogrammed” locally. Being such, the examiner can only assume that applicant believes that the recitation in lines 4 and 5 of claim 29 are broad enough to be read on a preprogrammed receiver station. Given such an interpretation, it is maintained that claims 29 and 32 are met for the same reasons which were set forth for claims 40 in the preceding paragraph of this Office action.

**54. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moortgat-Pick [German Patent Publication #2,831,014] in view of the publication “The First Nationwide Live Stereo Simulcast Network” by Schubin.**

**I. The Showing of Moortgat-Pick:**

As is shown in figure 1, Moortgat-Pick disclosed a TV receiver which comprised:

- 1) first processing circuitry ( i.e. @ 1) for receiving and processing analog audio and video media components of a received TV signal;
- 2) second processing circuitry (i.e. @ 8) for receiving and processing an analog radio/audio media component;

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- 4) display elements (i.e. the speaker 7 & the CRT) for producing a multimedia presentation comprised of the video media components and a selected one of the two audio media components; and
- 5) control circuitry (i.e. 4, 5, 10, 13, 16, and 24) for controlling the operation of the TV receiver.

## **II. The Showing of Schubin:**

Schubin has been cited to evidence the fact that it was notoriously well known in the art to have “simulcasted” high quality Radio sound signals and TV signals for a given performance over respective Radio and Television broadcast networks, thereby allowing households to watch the given performance via the television signal while enjoying higher sound via the high quality Radio sound signals .

## **III. Obviousness:**

Why in the world would a viewer wish to use his television set to watch the video portion/component of a TV program yet “replace” the audio portion/component of the TV program with the audio of Radio broadcast (i.e. as was the described purpose of the Moortgat-Pick system) ? Watching “simulcasted” performances/events would have been one of the most obvious answers to this question. Being such, the examiner maintains that it would have at least been obvious to one of ordinary skill in the art to have operated the TV

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receiver disclosed by Moortgat-Pick to have received and presented a simulcasted performance of the type described by Schubin.

**55. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366].**

a) Each of Hutt et al., Bart et al., Oono et al., and Betts, described multimedia presentation devices as was set forth previously [SEE: The rejection of claims 2 and 37 under section 102(b) by any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366].

B) Claim 20 recites that the first signal and the second signal, whose information is used to produce a multimedia presentation, are provided from first and second sources wherein at least the second source is located externally to the presentation device. The following is noted:

1) While claim 20 recites first and second sources, claim 20 never states/recited that the first and second sources are different sources. If the sources are the same, then claim 20 is met by the applied prior art for

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essentially the same reasons which were already addressed for claim 2 [note part "a" of this paragraph]; i.e. obviously the teletext signal and the TV signals which were simultaneously displayed by the presentation devices described by each of Hutt et al., Bart et al., Oono et al., and Betts, came directly/indirectly from a TV station "source" that was located at a remote location external to the given presentation device.

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*For the record, the examiner notes that the same rejection would have been applied had claim 20 specifically recited that the first and second sources were in fact different sources. Specifically, the examiner takes Official Notice that the source of Teletext transmissions and the source of TV program transmission were, within all television networks (i.e. at some point) generated by different sources [i.e. it is simply the nature of the beast].*

**56. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366], for the same reasons that were set forth for claim 20 in the preceding paragraph of this Office action. The following is noted:**



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1) Claim 21 recites an “intermediate transmitter” for receiving and transmitting the first signal and an “intermediate transmitter” for receiving and transmitting the second signal. As has been addressed in the preceding paragraph with respect to the term “source”, claim 21 does not require the two recitation of an “intermediate transmitters” to be recitations of different “intermediate transmitters”. Further it is note that claim 21 fails to define exactly what is meant/encompassed by the recitation “intermediate transmitter”.

2) Given that set forth in part “1” of this paragraph, the examiner maintains that a “transmitter” will be located between any TV broadcast station and the TV presentation device which receives the stations broadcasts; the transmitter is therefor, by definition, an “intermediate” transmitter (i.e. it is located within the TV distribution network at a position that is intermediate to the source(s) of TV/Teletext programming and the presentation devices which receive broadcasts therefrom).

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*For the record, the examiner notes that all local TV broadcast stations which are affiliated with national TV broadcast networks represent “intermediate transmission stations/transmitters” at least with respect to*

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*the network programming that is rebroadcasted by such affiliated stations.*

*Thus, the recitations of claim 21 are also met by the conventional configuration/operation in which a network broadcast station acts as or comprises the source (or sources) of network TV/Teletext programming and the local affiliated station is serving as an intermediate relay/transmitter so as to rebroadcast the national programming to the presentation devices that it locally serves.*

**57. Claim 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of: 1) Hutt et al. [US Patent #3,961,137]; 2) Bart et al. [US Patent #4,218,698]; 3) Oono et al. [JP 55028691]; and 4) Betts [GB #1,556,366], for the same reasons that were set forth for claim 20 above. The following is noted:**

The examiner maintains that the limitations of claims 22 and 23 are met by operation which are inherently part of the conventional teletext decoders found within any one of Hutt et al., Bart et al., Oono et al., and Betts. Specifically:

a) Teletext pages that are desired for display were/are inherently identified by comparing a locally entered/stored teletext page number with the incoming teletext page numbers (i.e. all that is required by claim 22); and

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b) All teletext decoders numerous different “selective transfer devices”; e.g.  
1) gating circuitry to extract the teletext signal from the video signal lines  
at appropriate times/intervals; 2) serial-to-parallel conversion circuitry to  
convert the serial bit stream of the transmitted teletext signal into a serial  
byte stream for further processing; at least one page memory for  
transferring selected bytes of the teletext byte stream to a  
character/graphics generator in order to generate displayable data; etc,...

**58. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over “Mode 2”-type captioning as was described by the documents contained in Appendix III of this Office action.**

**I. “Mode 2”-type Captioning:**

The use of conventional teletext distribution networks as the vehicle for distributing “program related data”, e.g. such as “captioning”, was notoriously well known in the art at the time of applicant’s alleged invention. In designing such teletext networks, it was recognized by those in the art that there would be situations when it would be desirable to simultaneously display different “levels” of captioning at different receivers; i.e. captions representing different languages; captions representing different levels of technical expertise, etc,...

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Unfortunately, the limited bandwidth that was conventionally available to teletext transmission was insufficient to carry different levels of captioning “simultaneously”. Thus, to accommodate such multi level captioning situations, teletext systems were designed to provide “MODE 2”-type captioning. “MODE 2”-type captioning operated as follows:

a) First, all of the levels of captioning were transmitted sequentially through the teletext distribution network well ahead of time at which they “had to be”<sup>79</sup> displayed simultaneously at respective receivers;

B) Next, each of the receivers operated to capture and store the specific caption which pertained to the level of captioning desired/required by the user (i.e. the caption of desired language, expertise, etc,...); and

C) Finally, at the time in the TV programming at which the captions had to be displayed, a “reveal code” was transmitted through the teletext network which cause each of the receivers to have simultaneously displayed the specific caption that each had stored thereby enabling different captions to be simultaneously displayed at different receivers.

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<sup>79</sup> It must be remembered that the “captions” are time sensitive program related data and, being such, must be displayed in specific synchronism with the TV programming.

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With respect to the limitations of claim 24, the examiner maintains that the reveal code of "MODE-2"-type captioning clearly corresponds to the "control signal" of the claim in that it caused/actuated the outputting of a multimedia presentation at each receiver station.

**II. The recitations of claim 24:**

Claim 24 states that the multimedia presentation was outputted to "at least two of a plurality of output device". However, claim 24 does not state where these output devices were located and/or what they comprised.

**III. Obviousness:**

The examiner maintains that the "plurality of output devices" recitation of claim 24 is obviously broad enough to be read on the plurality of display devices which are located at the plurality of receivers that existed within a system that provided "MODE 2"-type captioning and/or, alternatively, that the "plurality of output devices" recitation of claim 24 is broad enough to read on the display device and speaker device which obviously comprised each receiver that existed within a system that provided "MODE 2"-type captioning.

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**59. Claims 2 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Mode 2"-type captioning as was described by the documents contained in Appendix III of this Office action, for the same reasons that were set forth for claim 24 in the preceding paragraph of this Office action.**

The examiner notes that for this rejection, the reveal code of the "Mode 2"-type captioning system corresponds to the recited "second of two transmissions"; i.e. where, again, the term transmission simply means: "something that is transmitted".

**60. Claim 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Mode 2"-type captioning as was described by the documents contained in Appendix III of this Office action, for the same reasons that were set forth for claim 24 above. The following is hereby noted:**

1) The examiner maintains that any teletext decoder which was configured to have provided "Mode 2"-type captioning inherently constituted a "programmed processor" which operated to process and display "Mode 2"-type captioning according to sets of processor instructions whose execution was triggered by transmitted "conceal", "reveal", and/or "erase" bits [i.e. even if the decoder was only "programmed" to the extent that its logic circuitry was hardwired in a fashion which enabled it to respond to the processor instructions in the required way].

However, an alternatively, the examiner takes Official Notice that it was

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notoriously well known in the teletext art to have desirably replaced such hardwired circuitry of conventional teletext decoders with software driven CPUs/MPUs <sup>80</sup>. The examiner maintains that it would have at least been obvious to have done so with a "Mode 2"-type captioning decoder too. [here, the examiner notes that recitations of claim 43 are extremely broad an read on either hardwired or software implementations of the teletext decoder]

2) For any TV network to have provided a "Mode 2"-type captioning feature, it is inherent that at least some portions of the transmitter station of said network had to have actively "*received*" both the TV signals and captioning signals prior to actively "*transmitting*" them; e.g. for example, the transmitter of the transmitter station represents one transmitter station component which had to have received both signals before it could transmitted both signals; [here, the examiner notes that recitations of claim 43 are extremely broad in that they fail: to recite whether the source of received signals is found within, or externally to the recited transmitter station; fails to recite what components constitute the recited "transmitter station"; etc,...];

3) All signals which are transmitted by a transmitter station must be, via the laws of physics, transmitted by the transmitter station before they can be received,

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<sup>80</sup> SEE the showing of Betts [GB #1,556,366].

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e.g. at “*some specific later time*” of receipt, by the receiver stations of the network; [here, again the examiner notes that recitations of claim 43 are extremely broad in that they fail to provide any indication as to what is the recited: “a specific time”]; and

4) It is the step of receiving signals which are to be presented by a receiver station which, inherently, “enables” said receiver to produce/output the presentation that is to be presented; i.e. a receiver station cannot present what has not been provided [here, but once again, the examiner notes that recitations of claim 43 are extremely broad in that they fail to provide any indication as to what causes the receiver stations to be “enabled”] .

**61. Claims 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Mode 2”-type captioning as was described by the documents contained in Appendix III of this Office action, for the same reasons that were set forth for claims 43 and 50 in the preceding paragraph of this Office action. The following is hereby noted:**

1) With respect to claim 44:

The examiner notes that in “Mode 2”-type captioning: each caption is transmitted with an activated “conceal bit” which causes the caption to be stored but not to be



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displayed. Then, at some later time, the display of each caption is initiated by the receipt of an activated "reveal bit". Finally, at some even later time, the display of the caption is extinguished by the subsequent receipt of a deactivated "reveal bit" and/or by the receipt of an activated "erase bit". With respect to the recitations of claim 44, it is the time of this "subsequent receipt" which corresponds to the recited "specific time". The period during which a caption is displayed corresponds to the recited "first interval of time".

2) With respect to claim 45:

The examiner notes that in "Mode 2"-type captioning, there are certainly portions of the TV signal which are displayed by the receiver station prior to the display of a given caption. These portions of the TV signal inherently contain/represent "first images"; i.e. any one of these first images meets the "first image" recitation of claim 45. For clarity, the examiner notes that the "second image" recitation of claim 45 corresponds to the caption itself.

3) With respect to claim 46:

The examiner maintains that one of ordinary skill in the art would have recognized the obviousness of having transmitted "Mode 2"-type captioning from an intermediate "affiliated" TV station within a conventional TV network. In such a station, as in any TV station, "control signals" determine what is transmitted at any

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given time (be they manually generated control signals or automatically generated control signals). The recitations of claim 46 require nothing more.

4) With respect to claim 47:

The examiner notes that the control signal which causes the activation and transmission of the “conceal bit” also, at least indirectly, cause a delay in the transmission of the captioning to the receivers’ displays [i.e. claim 47 does not define what “transmission” is being delayed].

4) With respect to claims 48 and 49:

To the extent of the examiner’s understanding, claims 48 and 49 appear only to require the decoder’s implementation to be that of a software driven CPU/MPU; i.e. the obviousness of which has already been addressed in part “1)” of the preceding paragraph of this Office action.

**62. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the British Patent Document #1,204,190 to “*Mainichi Broadcasting System*” (hereafter Mainichi) in view of conventional TV receiver structure as exemplified by Lunn [US Patent #4,383,273].**

**I. The showing of Mainichi:**

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Mainichi disclosed a TV distribution system for distributing TV signals representing TV programming (i.e. an education program) along with an associated facsimile signals representing information related to said programming (i.e. data, tables, textbooks, and the like) [note lines 25-32 of page 1]. At the origination station, the TV distribution system of Mainichi comprised an encoder (e.g. figure 1) which comprised:

a) an input for receiving a TV signal representing the TV program which was to be distributed/transmitted by the distribution system;

B) circuitry (e.g. 3, 4, 5, 7, 8, 12) for separating and processing “control signals” which were contained within the received TV signal in order to generate gating/clocking signals;

C) a facsimile signal source/transmitter (1) for providing a facsimile signal which represents information that is related to the received TV program;

D) circuitry (2, 6, 10) for converting the provided facsimile signal into digital data and for outputting the digital data in synchronism with vacant horizontal lines in the VBI of the received television signal; and

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E) a mixer (11) for inserting the outputted digital data into the vacant horizontal lines in the VBI of the received TV signal to create a combined signal (14) for distribution/transmission through the TV distribution network.

The combined signal produced by the encoder was then provided to the transmitter of the origination station for transmission/distribution to a plurality of receiver stations via one or more intermediate relay/repeater stations [note lines 1-8 on page 6]. Each of the receiver stations included a conventional TV receiver (15) whose conventional processing circuitry, not shown in figures (note lines 1-3 on page 3), was modified with an appropriately placed splitter (17) for outputting the distributed version of the combined signal to a decoder, wherein the decoder comprised:

a) circuitry (e.g. 3, 4, 5, 7, 8, 12) for separating and processing said "control signals" which were contained within the received TV signal in order to generate gating/clocking signals;

B) circuitry (e.g. 6, 19, 21, 22) for extracting the digital data from the VBI of the TV signal of the combined signal and for converting the extracted data back into a facsimile signal which represents the program related information; and

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C) a facsimile receiver (23) which operates to “record”<sup>81</sup> the facsimile signal so as to make a permanent record thereof [note: lines 65-67 pf page 3; and lines 25-28 on page 1].

## II. Obviousness:

a) While Mainichi did not provide a detail description as to the structure which was used to implement TV receiver (15) of figure 3, the examiner maintains that it would have been obvious to one of ordinary skill in the art from the Mainichi description that this TV receiver (15) was of conventional design; i.e. that it obviously comprised the conventional audio and video component processing circuitry and the conventional audio and video output devices (e.g. a speaker and a CRT) of the *typical* TV receiver<sup>82</sup>.

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<sup>81</sup> Being used in the context of facsimile receiver operations, it would have been clear to one of ordinary skill in the art that the term “record” was used here in Mainichi to refer to some type of printing operation by some type of printer.

<sup>82</sup> For example, the examiner maintains that figure 1 in the US Patent #4,383,273 to Lunn illustrates the fact that conventional TV receivers comprised: audio component processing sections (20); audio component output devices (22); video component processing sections (24); video component output devices (26); and a signal processing section (28) which includes circuitry for processing incoming “control signals” such as horizontal and vertical synchronizing signals.

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B) The examiner notes that the decoder shown in figure 3 of Mainichi has no way of selecting/filtering the digital data that is received and passed to the facsimile receiver (23) and therefor, as long as the facsimile receiver was turned on, it would have inherently/obviously "recorded"/printed all of the program related information that was outputted from the decoder.

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The examiner notes the following:

- 1) Claim 25 has been addressed above in terms of the "speaker and printer" alternative implementation.

**63. Claims 2, 4, 12, 13, 16, 20, 21, 23, 26, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the British Patent Document #1,204,190 to "Mainichi Broadcasting System" (hereafter Mainichi) in view of conventional TV receiver structure as exemplified by Lunn [US Patent #4,383,273] for the same reasons that were set forth for claims 24 and 25 in the preceding paragraph of this office action.**

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**64. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over conventional TV/Teletext distribution systems in view of the publication “a Public Broadcaster’s View of Teletext in the United States” by Gunn et al.**

**I. Conventional TV/Teletext Distribution Systems:**

The following has been provided to do nothing more than set forth/review the context in which the Gunn et al. publication was written:

1) The examiner takes *Official Notice* that TV distribution systems were notoriously well known in the art at the time of applicant’s alleged invention. These TV distribution systems operated to distribute scheduled TV programming from a program originating transmitter station to a plurality of local household receiver stations via some sort of connecting TV distribution network; wherein, either:

a) The TV distribution network comprised intermediate TV transmission stations which acted as repeaters for relaying the broadcasted TV programming to the household receiver stations [i.e. such as satellites, CATV headends, affiliated TV stations, etc,...]; or

B) The origination station itself comprised such an intermediate TV transmission station which acted to relay broadcasted TV programming to the household receiver

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stations [i.e. the origination station itself was a CATV headend, an affiliated TV station, etc,...]; or

C) The origination station directly broadcast the TV programming to the household receivers without going through an intermediate station (i.e. such as by satellite).

2) The examiner takes *Official Notice* that teletext distribution systems were also notoriously well known in the art at the time of applicant's alleged invention. These teletext distribution systems were known to have associated the teletext service provider with the origination stations of the TV distribution systems, as described above in part "1)" of this section, thereby allowing pages of teletext information to be embedded within the VBI of the TV programming being transmitted/broadcast by said associated origination stations and thereby allowing the embedded teletext information to be distributed along with the TV programming.

## **II. The showing of Gunn et al.:**

Given the conventional TV and Teletext distribution networks which existed at the time of the Gunn et al. publication, the examiner notes the following:



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1) The Gunn et al. publication shows that those skilled in the art had indeed recognized the need/desire to have used conventional teletext distribution networks as vehicles for distributing program-related teletext data; i.e. wherein a given TV viewer would not only tune his TV receiver to receive a desired TV show/program, but the viewer would also tune his receiver to receive an associated program-related teletext broadcast which went with, and added something to, the viewer selected TV program/show [note the paragraph at the top of the fourth page of the publication which begins: "With program-related teletext..."]; and

2) The Gunn et al. publication set forth a specific application for such a *hybrid* TV/ Teletext system in which:

a) The viewer selected program was the TV show: "WALL STREET WEEK";

B) The program-related teletext broadcast which went with the selected TV show was "computer software" for analyzing viewer stock portfolios (i.e. wherein transmitting computer software as pages of a normal teletext service was well known in the art and was referred to as: "Telesoftware"<sup>83</sup>); and

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<sup>83</sup> Note lines 10-17 under the heading "ORACLE TELESOFTWARE" on page 560 of the publication "Telesoftware-

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C) Wherein each household receiver station comprised:

- 1) a conventional TV receiver for receiving and displaying the selected "WALL STREET WEEK" program/show; and
- 2) a home computer into which the associated computer program was downloaded so that a viewer could analyze his stock portfolio using the downloaded software based on audible instructions emitted from the TV receiver.

[see lines 2-17 lines of page 5 of the Gunn et al. publication which begins: "Or imagine an episode of the popular American public television program on the stock market and American economy Wall Street Week..."].

**III. Obviousness:**

The examiner maintains that it would have been well within the level of one skilled in the art to have modified conventional TV/Teletext distribution networks so as to have provided the program-related teletext services

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Value Added Teletext" by Hedger et al. [IEEE Transactions on Consumer Electronics, Vol. CE-26, August 1980]. Note, for the record, that lines 5-20 in column 2 on page 564 of this same publication described similar stock portfolio calculating Telesoftware too.

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which were described as having been desirable by Gunn et al. More specifically, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified said conventional TV/Teletext distribution networks to have provided the "Wall Street Week" embodiment/application of a program-related teletext service as was taught as having been desirable by Gunn et al..

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The examiner notes the following:

- 1) The "control signal" of claim 24 is met by the downloaded "Telesoftware"; and
- 2) Claim 25 has been addressed above in terms of the "computer and television receiver" alternative implementation of claim 25.

**65. Claims 2-6, 20, 21, 26, 28, 29-31, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over conventional TV/Teletext distribution systems in view of the publication "a Public Broadcaster's View of Teletext in the United States" by Gunn et al for the same reasons that were set forth for claims 24 and 25 in the preceding paragraph of this Office action.**

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**66. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation.**

**I. PREFACE:**

The examiner takes Official notice that “interactive display systems” were notoriously well known in both the television and movie arts at the time of applicant’s alleged invention; wherein these “interactive display systems” comprised:

- 1) a source of video and/or audio clips which, taken as a whole, represented many versions of the same video and/or audio presentation;
- 2) an input device for receiving inputs and/or responses from a user; and
- 3) a selection and/or assembling device which, based on the inputs/responses of the user, stringed together the subset of the video and/or audio clips so as to create the one of the many versions of the video and/or audio presentation which corresponds, e.g. was specifically tailored to, the inputs/responses of said user.

Thus, for example, a user might queried to provide inputs which would determined the course of a given video and/or audio presentation so as determine whether the

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presentation would be presented with a happy ending or, alternatively, with a sad ending.

The examiner maintains that the system described in the Zaboklicki prior art represents nothing more than one specific example of such notoriously well known “interactive display system” art. In the Zaboklicki implementation, “the source” of video and audio clips (e.g. “fragments”<sup>84</sup>) comprised a remote TV transmitting station which transmitted the entire “pool” of video and/or audio clips, wherein the “pool” of clips represented all of the many versions of the given TV presentation. In Zaboklicki, “the selection and/or assembling device” comprised a computer controlled receiving device, one of which was located at each of a plurality of TV receiving stations. In operation, the Zaboklicki system functioned to download computer software, in the form of “Telesoftware”, from the remote broadcast station to each of the computer controlled receiving devices located at each receiving station. This downloaded software was then loaded and run by each computer at each receiving station thereby giving each computer (and each receiver station) the intelligence that was needed to independently string together that sequence of the transmitted “pool” of audio and/or video clips/“fragments” that produced the version of the presentation that corresponded to, e.g. was

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<sup>84</sup> Which comprised audio clips, video clips, and teletext image clips in the Zaboklicki implementation.

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tailored to, the specific inputs/responses of the respective user. The Zaboklicki configuration resulted in a system in which the display of a specific interactive/“dialogue” television presentation could be simultaneously tailored in “parallel”<sup>85</sup>, via downloaded software, to the specific needs/desires of each user at each receiver station. Understanding this concept alone would, by itself, have been enough to have enabled one of ordinary skill in the art to have made and used the invention that was disclosed within this Zaboklicki publication; i.e. being that the alleged novelty of Zaboklicki actually rested in the concept/idea of *improving* on “prior art” interactive/dialogue systems by using downloaded “Telesoftware” as the vehicle for providing the intelligence that was needed to simultaneously produce different versions of an interactive presentation at respective receiving stations.

## **II. Applicant’s Latest Responses:**

1) Again, it is maintained that all of applicant’s allegations that the Zaboklicki disclosure was not enabling of that which it disclosed are founded within the unrealistically low level of skill in the art that has been adopted by applicant when dealing with this applied reference. For example, applicant has even gone so far as

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<sup>85</sup> The downloading of “Telesoftware” in order to perform “parallel” processing at computer controlled receivers of Zaboklicki is not unlike the “parallel” processing/configuration of applicant’s own alleged invention(s) [note lines 13-20 on page 427 of applicant’s instant specification].

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to allege that one of ordinary skill in the art would not have understood the meaning of terminology that was, in fact, notoriously well known in the art at the time of applicant's alleged invention (e.g. "dialogue television" being but one example of the notoriously well known terminology that applicant has alleged would not have been understood).

2) The examiner also notes that the art rejections which are based on "Zaboklicki" are based **solely** on German Patent Document # DE 2,904,981 and the *certified* translation of this document that was obtained by the PTO. To date, applicant has failed to provide any proof which shows this *certified* translation to be incorrect/erroneous/invalid. Until such proof is provided, the Office will continue to believe that the *certified* translation obtained by the PTO is correct/accurate/valid.

3) In their attack on the Zaboklicki showing, applicant now focusses much of their efforts on identifying discrepancies that exist between the *certified* translation of German Patent Document # DE 2,904,981 and other members of this patent document's "*Patent Family*". The examiner points out that if the *certified* translation of German Patent Document # DE 2,904,981 is in fact correct/accurate/valid, then any discrepancies and/or inconsistencies which might

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exist between the translated document and its “family” are irrelevant<sup>86</sup>. Again, if applicant wishes to challenge the validity of the PTO’s certified translation of German Patent Document # DE 2,904,981, then applicant must do so with proof/evidence (e.g. such as with an affidavit from applicant’s own certified translator) which shows that the PTO’s certified translation is in fact wrong and/or in error.

### **III. The System Structure Disclosed by Zaboklicki :**

- a) Zaboklicki disclosed an interactive/”dialogue” TV programming distribution and display system that comprised a *centralized* TV

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<sup>86</sup> Zaboklicki DE 2,904,981 includes a section labeled “List of References” [see pages 19-23 of the provided Zaboklicki DE 2,904,981 translation]. This section not only lists most of the elements which are shown in the Zaboklicki figures but, in many instances, this section provides *additional* details as to how the illustrated elements work and operate; e.g. *additional* details that are not provided within the other sections of the Zaboklicki DE 2,904,981 patent document. For example, the “List of References” section of Zaboklicki DE 2,904,981 explicitly identifies the downloaded “digital processing program” of the Zaboklicki DE 2,904,981 disclosure to be notoriously well known “Telesoftware” (e.g. computer software that was downloaded to the computer of the receiver stations via teletext distribution). Being such, it is significant to note that this “List of References” section of the Zaboklicki DE 2,904,981 does not appear within all of the members of its patent family; e.g. most notably Zaboklicki GB 2,016,874. Thus, applicant’s attempt to focus the current issues onto the teachings of Zaboklicki GB 2,016,874, and away from the teachings of Zaboklicki DE 2,904,981, represents nothing less than an attempt to have the significant “List of References” section of Zaboklicki DE 2,904,981 removed from current consideration. The examiner rejects such action as improper.



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transmitting station (not shown in the figures) and a plurality of receiving station (e.g. one embodiment of which is shown in figure 3). The transmitting station functioned to distribute/transmit/broadcast collections of TV programming “fragments” to the plurality of receiver stations, wherein each collection of said programming “fragments” belonged to a respective interactive TV programming presentation. The TV programming “fragments” themselves were comprised of at least three different media types:

- 1) “moving” video programming segments transmitted, in the form of conventional TV video signal components, simultaneously and sequentially through a pluralities of conventional TV channels;
- 2) audio programming segments transmitted, either in the form of conventional TV audio components or as separate radio signals, through a audio channels which were part of the video signal transmission or, alternatively, through separate radio channels; and
- 3) displayable pages of “teletext” data received in conventional teletext transmission via ones of said pluralities of conventional TV channels.

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**B)** As noted above, the interactive/dialog TV distribution system disclosed by Zaboklicki comprised a plurality of TV receiver stations which included the embodiment that is shown in figure 3 of the Zaboklicki document. This illustrated receiver station comprised four *basic* elements:

- 1) a modified TV receiver (54);
- 2) a modified teletext decoder (56);
- 3) a programmable processor (i.e. elements 6, 7, 39, and 40); and
- 4) a host of peripheral input/output elements (i.e. 23, 34, 35, 37, 50, 51, and 52).

**Specifically, these four basic elements of the receiver station are:**

- 1) Said “programmable processor”, e.g. the first of said five *basic* elements, which included:**

- a) input terminals/ports (39) for receiving various different input signals;
- b) output terminals/ports (49) for outputting various different output control signals; and
- c) a CPU (6) and RAM (7) for generating the various output control signals based on the different input signals under the control of computer software which had been

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downloaded to the receiver station, from the transmitter station side, in the form of “Telesoftware”<sup>87</sup>.

**2) Said “modified teletext decoder”, e.g. the second of said five *basic* elements, which included:**

- a) circuitry (36, 40) for extracting the software/“Telesoftware” that was used to program CPU (6) from received TV programming (25);
- b) circuitry (36, 40) for extracting program “fragment” identification codes from the received TV programming

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<sup>87</sup> Here, it is important to note that:

- 1) the applied Zaboklicki document explicitly identifies the disclosed “digital processing programming” as having comprised “Telesoftware”;
- 2) the term “Telesoftware” had a specific well known meaning in the art and that this meaning would have been known and understood by those of ordinary skill in the art when reading the Zaboklicki document [e.g. note the publication “TELESOFTWARE-VALUE ADDED TELETEXT” by Hedger et al which was cited by applicant]; and
- 3) a basic knowledge and understanding of this “Telesoftware” terminology contributed much to understanding and absorbing the teachings of the entire Zaboklicki document.

The point being:

- 1) that Zaboklicki was written to level of skill in the art that existed at that time; and
- 2) it is improper for applicant to try to have the Zaboklicki document read/judged in a vacuum.

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wherein the extracted ID codes are used by the CPU, under software/“Telesoftware” control, to identify and/or locate ones of the transmitted program fragments;

c) circuitry (36, 41, 44, 42) for selecting, extracting, and processing pages of teletext data corresponding to desired text/graphics images selected by ones of the control signals provided from the output terminals/ports (49) of the programmable processor;

**3) Said “modified TV receiver”, e.g. the third of said five *basic* elements, which included:**

a) at least one internal tuner for tuning to a selected/desired TV channel under control of one of the control signals (27) provided from the output terminals/ports (49) of the programmable processor;

b) an output circuit (55) for outputting the video portion of the selected/desired TV channel to the “modified teletext decoder” in order to locate, extract, and process the teletext data representing:

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1. The downloaded "Telesoftware"/ software use to program the programmable processor;
2. The fragment Identification codes needed by the programmable processor to locate required ones of the transmitted program fragments;
3. The character/graphic codes which are needed to generate the desired displayable teletext images

@42.

- c) An audio component on/off device (43) for turning on/off (i.e. selecting) ones of the "additional" audio channels/components based on the control signal that is provided from the output terminals/ports (49) of the programmable processor; and
- d) a switcher/multiplexer (45) that controls the display of the displayable teletext images from the teletext decoder (@42) under the control of the control signal that is provided from the output terminals/ports (49) of the programmable processor.

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**4) The miscellaneous peripheral components , e.g. the fourth of said five *basic* elements, which include:**

a) peripheral input elements for inputting signals into the receiver station:

1. a remote control transmitter (23) for providing signals indicative of viewer inputs/responses;
2. An interface unit (34) for providing signals indicative of the user's responses to an input terminal/port (@ 39) of the programmable processor;
3. a introduction circuit for providing "initial viewer data" to an input terminal/port (@ 39) of the programmable processor;
4. a local information storage source (50) which, under control of a control signal that is provided from the output terminals/ports (49) of the programmable processor, provides locally stored video signal fragments and locally stored fragment identifiers to respective inputs of the modified receiver and the programmable processor; and

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5. a local video camera (not shown in the figures)  
which can be used to generate local video for  
incorporation into the presentation.

#### **IV. The Operation of the System Disclosed by Zaboklicki :**

Zaboklicki described a television distribution network which operated to transmit a plurality of *interactive* TV presentations to a plurality of TV receiving devices located throughout the TV network. Each of these *interactive* TV presentations comprised the following *basic* components:

a) Computer software (i.e. transmitted as “Telesoftware”<sup>88</sup>); and

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<sup>88</sup> The term “Telesoftware” was notoriously well known in the art and was used conventionally within the Zaboklicki document to refer to “computer software” that was transmitted, as “pages” an extended teletext service, in the VBI of the transmitted TV signals [NOTE: items 3, 40, and 41 from the “List of References” which begins on page 19 of the PTO translation of the Zaboklicki document].

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B) a collection of TV programming “fragments”<sup>89</sup> which, taken together, represented many variations/versions of the same interactive TV presentation (i.e. by selectively receiving and displaying different subsets of the TV programming fragments via a notoriously well known process of “branching”, the receivers within the Zaboklicki system were able to “interactively” create different variations/versions of the same presentation<sup>90</sup>).

On the transmitter side, the system disclosed by Zaboklicki operated to transmit the computer software and a collection TV programming fragments that were

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<sup>89</sup> Again, it is noted that the transmitted TV programming “fragments” included:

- 1) different segments of motion video which were transmitted simultaneously and sequentially over a plurality of TV channels;
- 2) different segments of audio which were transmitted simultaneously and sequentially over a plurality of audio channels; and
- 3) different teletext pages representing different character and graphic images which were transmitted in the form of packetized teletext pages (i.e. as coded character/graphics data inserted into the VBI of a transmitted TV signal).

<sup>90</sup> The downloaded “Telesoftware” (computer software) provided the intelligence which was needed to select and display (i.e. “branch” through) the respective collection of programming fragments based on the local user’s inputs/responses thereby producing a specific presentation that was tailored to the needs/desires of the specific local user.



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associated with each of the interactive TV presentations that had been requested by respective ones of the users. On the receiver side, the computer of each receiving device received, loaded, and executed the transmitted computer software which was associated with the interactive TV presentation that had been selected by that user. By running this downloaded software, each computer obtained the instructions/“intelligence” that was needed to identify, select, and display that sequence of the programming fragments which represented the variation/version of the interactive presentation that corresponded to each user’s specific inputs and responses. In other words, each receiver used downloaded “Telesoftware” to put together and display a selected sequence of programming “fragments” based on the user’s inputs and responses; i.e. specifically, an interactive/“dialogue” multimedia TV presentation whose content was tailored to each of the user’s specific inputs/responses.

**V. Contrary to Applicant’s Allegations, the Zaboklicki Structures/Elements Were Clearly Described and Enabled**<sup>91</sup>:

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<sup>91</sup> Contrary to applicant’s arguments, the examiner maintains that, taken together,

1) the description provided by the “List of References” which begins on page 19 of the provided Zaboklicki

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Given that which is set forth above, the examiner hereby takes the following positions:

1) The examiner maintains that implementing the “third *basic* element” of the receiver stations, e.g. the “modified TV receiver” of the type shown in figure 3 of Zaboklicki, would have been well within the level of one of ordinary skill in the art at the time of applicant’s alleged invention.

Specifically, the examiner maintains that one skilled in the art would have known how to have built a modified TV receiver that was capable of being controlled by externally supplied control signals so as:

- a) to have selectively tuned the receiver to receive and display different TV channels;
- b) to have selectively received and displayed graphic/character images provided from a teletext decoder; and
- c) to have selectively received and outputted sound derived from a plurality of different audio and/or radio channels.

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translation,

2) the figures and the written descriptions pertaining thereto, and

3) the Zaboklicki claims,

would have been more than enough to have enabled one of ordinary skill in the art to have understood, made, and used the system which was disclosed by the Zaboklicki document (particularly the figure 3 embodiment which has been relied on in making present/past section 102 and 103 art rejections).

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**[THE EXAMINER ASKS: “WHAT IS IT ABOUT THIS MODIFIED RECEIVER STRUCTURE THAT APPLICANT ALLEGEDLY DOES NOT UNDERSTAND AND/OR DOES NOT BELIEVE COULD HAVE BEEN MADE/USED?”]**

2) The examiner maintains that implementing the “second *basic* element” of the receiver stations, e.g. the “modified teletext decoder” of the type shown in figure 3 of Zaboklicki, would have been well within the level of one of ordinary skill in the art at the time of applicant’s alleged invention. Specifically, the examiner maintains that one skilled in the art would have known how to have built a modified teletext decoder which was capable of receiving, recognizing, decoding, and outputting pages of teletext data representing:

- a) Telesoftware [i.e. computer software];
- b) program “fragment” identifiers; and
- c) displayable character/graphic images.

**[THE EXAMINER ASKS: “WHAT IS IT ABOUT THIS MODIFIED TELETEXT DECODER STRUCTURE THAT APPLICANT ALLEGEDLY DOES NOT UNDERSTAND AND/OR DOES NOT BELIEVE COULD HAVE BEEN MADE/USED?”]**

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3) The examiner maintains that implementing the “first *basic* element” of the receiver stations, e.g. a “programmable processor” of the type shown in figure 3 of Zaboklicki, would have been well within the level of one of ordinary skill in the art at the time of applicant’s alleged invention.

Specifically, the examiner maintains that one skilled in the art would have known how to have built a programmable processor which was:

a) capable of being programmed via “Telesoftware” (computer software) which was provided from a teletext decoder;

b) capable of being controlled by the “Telesoftware” (computer software) to generate & output said control signals that were needed to control said “modified TV receiver” by

analyzing/processing:

1. the programming fragment identifier codes provided from the modified teletext decoder;
2. initial user data provided by initialization circuitry; and
3. inputted user responses/inputs.

**[THE EXAMINER ASKS: “WHAT IS IT ABOUT THIS PROGRAMMABLE PROCESSOR STRUCTURE THAT APPLICANT ALLEGEDLY DOES NOT UNDERSTAND AND/OR DOES NOT BELIEVE COULD HAVE BEEN MADE/USED?”]**

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**SO THAT THERE IS NO MISUNDERSTANDING,**  
**APPLICANT IS HEREBY ASKED TO SPECIFICALLY**  
**IDENTIFY THOSE CONCEPTS/STRUCTURES OF THE**  
**ZABOKLICKI FIGURE THREE RECEIVER STATION**  
**EMBODIMENT/SYSTEM, AS APPLIED AGAINST THE**  
**PENDING CLAIMS WITHIN THIS OFFICE ACTION, THAT**  
**APPLICANT IS STILL ALLEGEDLY UNABLE TO**  
**GRASP/UNDERSTAND; I.E. A ZABOKLICKI FIGURE**  
**THREE SYSTEM/EMBODIMENT WHICH HAS BEEN**  
**DISCUSSED/ADDRESSED/EXPLAINED BY THE EXAMINER**  
**IN AGONIZING DETAIL THROUGHOUT THE PRESENT**  
**PROSECUTION** <sup>92</sup>.

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<sup>92</sup> Note Appendix II of this Office action.

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**ALTERNATIVELY, IF APPLICANT NOW UNDERSTANDS**  
**AND GRASPS THE CONCEPTS/STRUCTURES OF THE**  
**ZABOKLICKI FIGURE THREE SYSTEM AS**  
**DISCUSSED/APPLIED WITHIN THIS OFFICE ACTION,**  
**THEN APPLICANT IS SPECIFICALLY ASKED TO IDENTIFY**  
**THOSE OF THESE CONCEPTS/STRUCTURES WHICH**  
**APPLICANT FEELS COULD NOT HAVE BEEN MADE, USED,**  
**AND/OR PRACTICED BY ONE OF ORDINARY SKILL IN**  
**THE ART AT THE TIME OF APPLICANT'S ALLEGED**  
**INVENTION** <sup>93</sup>.

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<sup>93</sup> Applicant continues in his attempt to have the Zaboklicki reference removed from consideration by characterizing this reference as being:

“so vague and indefinite in its description of *the technology* that virtually any reliance on the publication as prior art in the instant application can only be based on speculation and conjecture....[it] is not an enabling publication.”

The examiner notes that “*the technology*” utilized by the Zaboklicki invention, (namely: teletext technology; “Telesoftware” technology; “dialogue”/interactive television technology; and TV receiver technology), were all notoriously well known in the art at the time that the Zaboklicki disclosure was written that there simply was no need for this to have been regurgitated within the

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**AND FINALLY, IF APPLICANT NOW UNDERSTANDS**  
**AND GRASPS THE CONCEPTS/STRUCTURES OF THE**  
**ZABOKLICKI FIGURE THREE SYSTEM AS**  
**DISCUSSED/APPLIED WITHIN THIS OFFICE ACTION, AND**  
**IF APPLICANT NOW AGREES THAT THESE**  
**CONCEPTS/STRUCTURES WOULD HAVE BEEN**  
**ADEQUATELY DESCRIBED/ENABLED BY THE**  
**ZABOKLICKI DISCLOSURE AT THE TIME OF**  
**APPLICANT'S ALLEGED INVENTION, THEN APPLICANT IS**  
**ASKED TO SPECIFICALLY IDENTIFY THOSE FEATURES**  
**OF THE PENDING CLAIMS WHICH ALLEGEDLY**

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Zaboklicki disclosure itself. Once again, applicant has improperly attempted to have the Zaboklicki disclosure viewed in the context of a vacuum rather than the context of the level of skill in the art within which it was originally written [e.g. NOTE: U.S. Patent #4,634,386 to Tamakki; U.S. Patent #3,008,000 to Morchand; the 1/2001 PTO translation of document DE 2,550,624; the article "TELESOFTWARE-VALUE ADDED TELETEXT" by Hedger et al.; etc,...].

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**DISTINGUISH THE CLAIMS OVER THE ZABOKLICKI**  
**SHOWING.**

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**V. Zaboklicki as applied against claims 24 and 25:**

With respect to the recitations of claims 24 and 25, the examiner notes the following:

- A) The receiver station disclosed by Zaboklicki *obviously* received a control signal from a remote transmitter source [e.g. the receiver stations received control signals representing the “Telesoftware” and/or the program “fragment identifiers”];
- B) The receiver stations disclosed by Zaboklicki *obviously* outputted a multimedia presentation based on said received control signals [e.g. said “Telesoftware” and the program “fragment identifiers” were used as the basis for controlling/identifying which of the video/audio/teletext program fragments were presented];
- C) The receiver stations disclosed by Zaboklicki *obviously* outputted said multimedia presentation at least two of a plurality of output devices [e.g. the output devices comprised the video display of the modified TV



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receiver, the speaker of the modified TV receiver, and the printer of the receiver station for outputting different media components];

D) The receiver station disclosed by Zaboklicki *obviously* included a plurality of local sources too [ e.g. including a described camera (not shown in the figures), a local video storage device of the receiver station, and even (via one possible interpretation of the claim recitations) the modified teletext decoder of the receiver station itself].

**67. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] for the reasons which were set forth above in the rejection of claims 24 and 25 based on the PTO obtained Zaboklicki translation.**

See the preceding paragraph of this Office action for details as to the specific grounds of this rejection. The examiner further notes the following:

1) The examiner notes that Zaboklicki clearly recognized the fact that the audio program “fragments” could be provided to the receiver stations via “*radio*” channels/transmissions as an alternative to multiple channel sound portions of conventional TV channels [note the last five lines on page 10 and the first line on page 11 of the PTO obtained translation]. While this discussion was provided in the context of Zaboklicki’s figure 2 system

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configuration, one skilled in the art would have recognized the obviousness of having extended such a teaching to other of Zaboklicki's system configurations (namely, to the configuration of figure 3).

**68. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation**

See the preceding paragraph of this Office action for details as to the specific grounds of this rejection.

**69. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation.**

1) See the preceding paragraph of this Office action.

2) The following is noted:

A) The downloaded "Telesoftware" described in Zaboklicki contained the control signals and the software which was needed to program the receiver stations described in Zaboklicki [i.e. obviously corresponding to the recited "first control signals" of claim 29];

B) Each of the transmitted TV program fragments described in Zaboklicki included a corresponding "fragment" identification code which allowed desired/required ones of the TV program fragments to be located,

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identified and select or discarded for display/presentation by the receiver stations described in Zaboklicki [i.e. obviously corresponding to the recited second control signals of claim 29];

C) Each of the receivers stations described, based on the loading/running of the software that was downloaded via the “Telesoftware”, **responded** to those of the fragment identification codes which identified desired programming fragments by **outputting** the identified fragment for display/presentation [i.e. obviously corresponding to the steps of “responding” and “outputting” as recited in claim 29].

**70. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation for the same reasons that were set forth for claim 29 in the preceding paragraph of this Office action. The following is hereby noted:**

1) As described in Zaboklicki, ones of the program fragments were comprised of displayable teletext data pages which were inherently digital signals [i.e. obviously corresponding to the “digital signal” that was recited in claim 31].

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**71. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation for the same reasons that were set forth for claims 30 and 31 in the preceding paragraph of this Office action.**

**The following is hereby noted:**

During the receipt and display of a dialogue TV program presentation, the receiver station disclosed by Zaboklicki:

- 1) Outputted and displayed a first fragment of the TV presentation to the viewer wherein this first presented fragment required a response from the viewer [i.e. obviously, this first fragment in Zaboklicki corresponds to the recited “first signal” of claim 33];
- 2) Received a response inputted by the user in response to the outputted/displayed first program [i.e. obviously, this viewer response in Zaboklicki corresponds to the recited “user response” of claim 33];
- 3) Processed the viewers response, under the control of the downloaded “Telesoftware”, to obtain a next program fragment identification code which identified the next program fragment which was to be located, selected, and displayed in accordance with the viewer’s inputted response [i.e. obviously, the obtained fragment identification code in Zaboklicki

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corresponds to the recited “second data stored at the receiver station” of claim 33];

4) “Prescreened” the incoming transmitted program fragments for an incoming fragment identification code which matched the obtained identification code thereby identifying the receipt of the next desired program fragment for presentation/display [ i.e. obviously, the received fragment identification code in Zaboklicki corresponds to the received “first data signal” recited in claim 33];

5) Received the next desired program fragment whose receipt had been identified by the matching of the respective fragment identification codes [i.e. obviously, the next desired program fragment in Zaboklicki corresponds to the “received second signal” recited in claim 33]; and

6) Outputted and displayed the multimedia dialogue TV presentation which included segments which were comprised of the first and next desired programming fragments [i.e. obviously, this outputting of fragments in Zaboklicki corresponds to the “outputting” step that is recited in claim 33].

**72. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki [DE 2,904,981] based on the PTO obtained Zaboklicki translation for**

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**the same reasons that were set forth for claim 33 in the preceding paragraph of this Office action.**

**The following is hereby noted:**

While not explicitly illustrated as being part of his figure 3 receiver station embodiment, Zaboklicki did describe a feature in which the receiver stations of his system were equipped with circuitry for communicating the inputted viewer responses to presented programming fragments of the dialogue programming back to a remote transmission station via a return link made over telephone lines [note: claims 16-19 and 31-33 of the Zaboklicki translation; lines 14-25 on page 12 of the Zaboklicki translation; the description of figure 4 in lines 1-18 on page 17 of the Zaboklicki translation; etc,...]. The examiner maintains that it would have been obvious to one of ordinary skill in the art, if it was not inherent, to have added this feature to the receiver station structure shown in figure 3 of Zaboklicki.

**73. Claims 52, 54, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the publication “Vertical Interval Signal Applications” by Etkin in view of the publication “AN AUTOMATED PROGRAMMING CONTROL SYSTEM FOR CABLE TV” by Stern.**

**I. PREFACE (the examiner’s best guess as to what is being claimed):**

The examiner’s best guess is that the “transmitter apparatus” of claims 52, 54, and

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55 allegedly corresponds to both the “origination station” and the “intermediate transmission station” of applicant’s originally filed written description wherein:

- 1) the “transmitter” of the claims allegedly corresponds to the transmitter that is located at the origination station;
- 2) the “second receiver” of claim 54 allegedly corresponds to the receiver at the intermediate transmission station which receives a transmission from the transmitter of the origination station;
- 3) the “memory device” of claim 54 allegedly corresponds to the signal recorders at the intermediate stations which record signals for delayed broadcast;
- 4) the “first receiver” of the claims allegedly corresponds to the receiver located at a receiver station which receives broadcasts from the intermediate station; and
- 5) the “controller” of claim 55 allegedly corresponds to the scheduling computer located at the intermediate station which controls the operation of the intermediate station based on a stored transmission schedule.

If the examiner’s best guess as to what is actually being claimed is in fact in error, then clarification on the part of applicant is hereby requested. If the examiner’s best guess is correct, then the following rejection is applied; i.e. in any event, the

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following rejection is applied to the extent of the examiner's understanding of what is being claimed.

**II. The Showing of Etkin:**

The 1970 publication by Etkin clearly shows that, at the time of applicant's alleged invention, those of ordinary skill in the art had long recognized the fact that the VBI of broadcasted TV programming represented a vacant portion of the TV broadcast spectrum which could be exploited for "other uses" [note the first 12 lines under the heading "*Vertical Interval Applications*" in the third column of page 30]. Etkin proceeded to provide a list of ten different uses/applications for the VBI of such TV transmission which he recognized as having been desirable uses/applications. Significantly, the eighth listed desirable use/application pertained to a system in which a regional TV transmission station, which transmitted regular TV programming to its regional CATV headends during the daytime hours, was used during nighttime "dark hours" to download TV programming for later/delayed re-broadcast by its respective headends [note the discussion under the heading "*8. Unattended VTRs remote controlled*" in the second column on page 32]. More specifically, during "dark hours", the regional transmission station transmitted TV programming containing vertical interval control signals which caused transmitted TV programming to be automatically



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recorded by unattended VTRs located within one or ones of the CATV headends. Etkin recognized that such an automated downloading procedure was desirable in that it solved two of the most vexing problems faced by the CATV industry in 1970; e.g. it eliminated the need/"problems" of having had to make recorded copies of TV programming (i.e. referred to as "dubbing") for manual distribution to and from (i.e. referred to as "bicycling") the respective CATV headends. While the Etkin publication did not provide details as to how such an automated recording system was to have been implemented, the examiner takes Official Notice that such details were in fact notoriously well known in the art <sup>94</sup>.

### **III. The Showing of Stern:**

Stern has been cited for its description of a conventional automated CATV headend which operated to have automatically cablecasted a large amount of scheduled TV programming to a plurality of household receiver "stations" via a given number of available CATV channels. The TV programming which was

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<sup>94</sup> Not knowing what applicant might be willing to refute, the examiner hereby cites the following in support of his position:

1) WO 80/02093 to Vikene; 2) US #4,390,901 to Keiser; 3) the publication "Code accompanying TV program turns on video cassette recorder in proposed scheme" by Gosch; and 4) the publication "The Vertical Interval: A General-Purpose Transmission Path" by Anderson. [all of these documents are already of record within the present prosecution].

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automatically outputted by the CATV headend for cablecasting comprised large numbers of:

- 1) "locally originated or locally controlled" TV programs; and
- 2) TV programs which were "picked-up off-the-air".

In more detail, the conventional CATV headend described by Stern included the following components:

- 1) Some sort of "offline" data network which created a Program Schedule that at least identified each TV program which was scheduled to be cablecasted, as well as the channel and time at which it was to cablecasted, by the circuitry of the CATV headend [note lines 11-20 in the second column of page 124];

- 2) Some sort of "on-line" controller, which was operatively connected to the "offline" data network, and which generated and outputted the control signals that were needed for controlling many/most/all of the switching and machine control tasks that were required in order to have automatically provided and outputted the scheduled TV programs at the times/channels indicated via Program Schedule that was created by (and provided from) the "offline" data network [note lines 1-48 in the first column on page 124]; and

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3) A matrix switching circuit and a variety of "machines" (e.g. VTRs, audio carts, film chains, etc,...), which were controlled by the control signals which were outputted by the "on-line" processor, in order to have actively provided and outputted the scheduled TV programs at the times/channels indicated via Program Schedule that was created by (and provided from) the "offline" data network.

#### **IV. Obviousness:**

The examiner maintains that it would have been obvious to one of ordinary skill to have used the TV program distribution system disclosed by Elkin to have downloaded TV programming to the automated CATV headend of Stern given that the purpose of the Elkin system was to eliminate two of the most vexing problems which were known to have been associated with such conventional CATV systems. Stated somewhat differently, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified the automated CATV headend disclosed by Stern, according to the teachings of Elkin, with the circuitry that was required to have controlled unattended VTRs to automatically

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record TV programming that was provided to it, from its off-the-air signal sources, during “dark hours”.<sup>95</sup>

74. Claim 57 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Television/Teletext distribution in the UK as exemplified in the publication “TELETEXT FIELD TRIALS IN THE UNITED KINGDOM” by Sherry and the publication “ORACLE on Independent Television” by Green et al.<sup>96</sup>

**I. The showing of Sherry and Green et al.:**

Sherry and Green et al. have been cited for their discussion of the conventional “*Independent Television*” distribution network that was used in Great Britain at the time of applicant’s alleged invention. More specifically, figure 2 of Sherry represents the Teletext/Television distribution network which comprised:

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<sup>95</sup> In spite of applicant’s arguments to the contrary, the examiner continues to maintain that further evidence as to the obviousness of having automatically downloaded TV or Radio programming for delayed broadcast is clearly found in the teachings of a previously applied Australian Patent Document #74,619/74 to Hetrich [note the last 4 lines on page 10 and the first 4 lines on page 2].

<sup>96</sup> Here, the examiner notes that Green et al. has been relied on, for the most part, to establish the context in which the Sherry publication was written.

Art Unit:

A) An origination network transmission station located in London which comprised:

- 1) A teletext data source (i.e. “*ORACLE*”) for producing a teletext data stream/transmission;
- 2) A network television programming source for producing a network television program signal/transmission;
- 3) An insertion circuit for inserting the produced teletext data stream/transmission into the VBI of the produced network television program signal/ transmission to produce a combined network television program signal/transmission (wherein the combined network television program signal/transmission includes the teletext data stream/transmission and the network television program signal/transmission); and
- 4) Transmitting circuitry for transmitting the combined network television program signal/transmission to at least one regional television transmission station;

**[represented by the block labeled “ORACLE” in figure 2]**

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B) A first "Video Network" for carrying the transmitted combined network television program signal/transmission to said at least one regional television transmission station;

C) At least one "regional television transmission station" which comprised:

- 1) Receiving circuitry for receiving the combined network television program signal/transmission;
- 2) A regional television programming source for producing a regional television program signal/transmission;
- 3) Regional switching circuitry for selectively outputting either the received combined network television program signal/transmission or the produced regional television program signal/transmission for transmission to at least one local television transmission station;
- 4) A "data bridge" for extracting the teletext data stream/transmission from the combined network television program signal/transmission and for inserting the extracted teletext data stream/transmission into the regional television program signal/transmission thereby allowing the teletext data stream/transmission to be passed onto the at least one local station even when the network television programming signal/transmission

Art Unit:

is not passed to the at least one local television transmission station (i.e. even when the regional television program signal/transmission has been selectively outputted for transmission by the regional switching circuitry); and

5) Transmitter circuitry for transmitting the combined regional television program signal transmission outputted by the switching circuitry to the at least one local television station (e.g. wherein the outputted combined regional television program signal transmission comprises the selected one of the combined network television program signal/transmission and the produced regional television program signal/transmission with the extracted teletext data stream/transmission inserted thereto);

**[represented by the block labeled “Programme Source” of figure 2]**

D) A second “Video Network” for carrying the transmitted combined regional television program signal/transmission to said at least one local television transmission station;

E) At least one “local television transmission station” which comprised:

Art Unit:

1) Receiving circuitry for receiving the combined regional television program signal/transmission;

2) A local television programming source for producing a local television program signal/transmission;

3) Local switching circuitry for selectively outputting either the received combined regional television program signal/transmission or the produced local television program signal/transmission for transmission to at least one local transmitter network which is illustrated in figure 3;

4) A "data bridge" for extracting the teletext data stream/transmission from the combined regional television program signal/transmission and for inserting the extracted teletext data stream/transmission into the local television program signal/transmission thereby allowing the teletext data stream/transmission to be passed on to the at least one local transmitter network even when the combined regional television programming signal/transmission is not passed on to the at least one local transmitter network (i.e. even when the local television program signal/transmission has been selectively outputted for transmission by the local switching circuitry); and



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5) Transmitter circuitry for transmitting the combined local television program signal transmission outputted by the local switching circuitry to the at least one local transmitter network (e.g. wherein the outputted combined local television program signal transmission comprises the selected one of the combined regional television program signal/transmission and the produced local television program signal/transmission with the locally extracted teletext data stream/transmission inserted thereto);

**[represented by the block labeled “Local Studio” of figure 2]**

F) A third “Video Network” for carrying the transmitted combined local television program signal/transmission to said at least one local transmitter network of figure 3;

G) The at least one local transmitter network of for transmitting the combined local television program signal/transmission to the local household television/teletext receiver stations serviced thereby.

By distributing the television program transmissions and the teletext data stream/transmission in the manner described above, it is maintained that the

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*“Independent Television”* television/teletext distribution network described in Sherry and Green et al. inherently enabled the output, at the plurality household receiver stations, of respective multimedia presentation simultaneous and sequential multimedia presentations consisting of:

- 1) video information derived from the video signal/transmission of the received combined local television program signal/transmission;
- 2) audio information derived from the audio signal/transmission of the received combined local television program signal/transmission; and/or
- 3) teletext information received from the teletext stream/transmission of the received combined local television program signal/transmission.

## **II. Differences and Obviousness:**

The examiner maintains that claim 57 differs from the conventional television/teletext distribution system of the UK, as described by Sherry and Green et al., only in that the publication of Sherry and Green et al. failed to explicitly describe the conventional television/teletext distribution system of the UK as having comprised “at least one *transmitted* control signal” which served as a basis for transmitting at least a first signal of the multimedia presentation. Nonetheless, the examiner maintains that one skilled in the art would have recognized the fact that each of the television transmission stations of the described UK

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television/teletext distribution network (i.e. the “network station”, the “regional stations”, and even the “local stations”) obviously comprised at least one “control room” from which many different types of “control/instruction signals” were *transmitted* including ones which controlled the selection and transmission of the television programming which was ultimately received and displayed at the household receiver stations as audio and video components of the multimedia presentation(s). While not currently needed, the examiner notes that there are many other types of transmitted control signals which obviously/inherently exist within the network which would also have met the “transmitted instruction” recitation of claim 57; i.e. claim 57 is just so/too broad. For example: 1) the transmitted horizontal and vertical sync signals of the TV programming signals which controlled/instructed the insertion and/or bridging circuitry of the network as to the times at which the teletext data stream/transmission was to be transmitted (note figures 4 and 5 of Green et al.); 2) the instructions which were transmitted from the Oracle computer at the network station to determine what pages of teletext data were to have been transmitted what times (note figure 8 of Green et al.); etc,...

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**75. Claim 58 and 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Television/Teletext distribution in the UK as exemplified in the publication “TELETEXT FIELD TRIALS IN THE UNITED KINGDOM” by Sherry and the publication “ORACLE on Independent Television” by Green et al., as was set forth in the preceding paragraph of this Office action, further in view of the publication “TELETEXT SIGNAL GENERATION EQUIPMENT AND SYSTEMS” by Mothersole.**

1) The examiner notes that, as portrayed by Sherry and Green et al., the “data bridges” which were located within the regional and local TV stations of the described UK television/teletext distribution system were all described as being of the “asynchronous” variety [e.g. Note the discussion under the heading “2. THE INDEPENDENT TELEVISION NETWORK” on page 409 of Sherry; and figure 5 of Green et al.]. For the record, the examiner note that the only reason “asynchronous data bridges” were and could be used was because, at that time, the network television station was the only station which comprised a teletext data source; i.e. an “asynchronous data bridge” is only capable of passing existing teletext data which was all that was needed at the regional and local television stations at the time because they lacked teletext data sources of their own.

2) Nonetheless, those skilled in the art had already recognized the fact that the operators of the regional and local television stations obviously desired their own

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regional/local teletext data whereby they could insert their own regional/local teletext pages and receive the review associated therewith themselves. Being such, as evidenced in figure 4(a) and 4© of Mothersole, more advanced/complicated “data bridges” had been developed which allowed “intermediate” television stations (e.g. the regional and/or local stations): 1) to select and identify those teletext magazines and pages of the received teletext data stream/transmission which were to be passed to their regional/local transmitter for transmission; 2) to select and identify those teletext magazines and pages of the received teletext data stream which were not to be passed and thus deleted from the received teletext data stream/transmission; and 3) to add their own locally generated teletext data pages and magazines to the vacancies in the teletext data stream created by the deletion of the received magazines/pages.

3) The examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified the conventional television/teletext distribution network as portrayed by Sherry and Green et al. so as to have included the *improved* data bridges described in Mothersole thereby allowing the regional/local television stations to have desirable added replaced selected pages/magazines of the incoming teletext data stream/transmission with locally generated pages/magazines prior to retransmission. The examiner notes the following:

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- a) The data bridge of the type shown in figure 4(a) of Mothersole clearly functioned so as to have delayed and rescheduled the transfer and retransmission of the incoming identified teletext pages/magazines which were to be passed to the transmitter for retransmission (i.e. note the first full paragraph in the first column on page 349 of Mothersole);
- b) The teletext magazine and page numbers of the teletext data stream constituted “*identifiers*” which were not only used to identify teletext pages/magazines within the teletext stream/transmission which were to be passed or deleted by the bridge, but were also used to schedule/control/“instruct” what and when any given teletext page/magazine was to have been transmitted (i.e. again, note figure 8 of Green et al., the first full paragraph in the first column of Mothersole, etc,...).

In summary, the examiner maintains that the additional limitations recited in claims 58 and 60 read on the *improved* data bridging circuitry shown in figures 4(a) of Mothersole when such circuitry was located, at least obviously, within one of the regional “intermediate” transmission stations of the UK network.

**76. Claims 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Television/Teletext distribution in the UK as exemplified in the publication**

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**“TELETEXT FIELD TRIALS IN THE UNITED KINGDOM” by Sherry and the publication “ORACLE on Independent Television” by Green et al., in view of the publication “TELETEXT SIGNAL GENERATION EQUIPMENT AND SYSTEMS” by Mothersole, for the reasons that were set forth for claims 58 and 60 in the preceding paragraph of this Office action.**

The examiner maintains that the “selective transfer device” and its operation, as recited in claims 61 and 62, read on the *improved* data bridging circuitry shown in figures 4(a) of Mothersole when such circuitry was located, at least obviously, within one of the regional or local “intermediate” TV transmission stations of the UK network.

**77. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honbashi [JP 53-068124].**

**I. PREFACE:**

Claim 61 includes recitations which positively use/recite the following labels: 1) an “intermediate transmitter apparatus”; 2) an “intermediate transmitter”; 3) a “remote transmitter”; and 4) a “control signal detector”. However, claim 61 never defines the context in which these labels are actually being used:

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- A) What makes the *intermediate transmitter apparatus* “intermediate”?  
(i.e. with respect to what structure is it the “intermediate” of?);
- B) What makes the *intermediate transmitter apparatus* a “transmitter”?  
(i.e. what and to what is it “transmitting” ?);
- C) What makes the *intermediate transmitter* “intermediate”? (i.e. with respect to what structure is it the “intermediate” of?);
- D) What makes the *intermediate transmitter* a “transmitter”? (i.e. what and to what is it transmitting?);
- E) What makes the *remote transmitter* “remote”? (i.e. with respect to what structure is it “remote” too ?);
- F) What makes the *remote transmitter* a “transmitter”? (i.e. what and to what is it “transmitting” ?); and
- G) What makes the control signal detector a “detector”? (i.e. in what way is it performing “detection” ?).

## **II. The Showing of Honbashi:**

As is shown in figure 2, Honbashi disclosed a commercial message broadcast system which comprised:

- A) A selective transfer device/component which included:
  - 1) input side cross point switching circuitry (31-35);



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- 2) a plurality of VTR video storage units/locations (21-25);
- 3) output side cross point switching circuitry (41-45);
- 4) an output terminal (46); and
- 5) a programmable controller (71,51) for generating the instructions that were used to control the VTRs and both switching circuits; and

B) an “intermediate transmitter” (not shown in the figures) for broadcasting/cablecasting commercial messages/programming provided from the output terminal (46) of the selective transfer device/component to a plurality of receiver stations; and

C) a “remote” commercial message/program source and “transmitter” (11) for transmitting commercial messages/programs to the selective transfer device/component.

As disclosed by Honbashi, the selective transfer device/component operated:

- 1) to receive the commercial messages/programs which were transmitted to the selective transfer device/component from the “remote” commercial message/program source/“transmitter” (11); and

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2) to transfer these received commercial messages/programs to its output terminal (46) by applying a specific delays to each of the received commercial messages/programs wherein the specific delays are determined according to a desired commercial message/program broadcast schedule.

### **III. Differences:**

Claim 61 differs from the showing of Honbashi only in its use of the term “detector” in the label “a control signal detector”; i.e. the examiner maintains that the selective transfer device/component described by Honbashi was clearly controlled by many control signals which were communicated to and thereby the showing of Honbashi clearly meets the functional recitation of “communicating” that has been attributed to the “control signal detector” label of applicant’s claim.

### **IV. Obviousness:**

While not explicitly stated by Honbashi, the examiner maintains that it would have been obvious to one of ordinary skill in the art that programmable controller (71) of the Honbashi system comprised some sort of “input interface device” for allowing the user to enter control data, e.g. such as the desired commercial message/program broadcast schedule, into the system. The examiner maintains that this input device inherently comprised a “control signal detector” for detecting

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“control signals” contained within the entered data and for “communicating” the detected control signals to the selective transfer device/component for controlling the operation thereof.

**78. Claims 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honbashi [JP 53-068124] for the same reasons that were set forth for claim 61 above.**

**79. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honbashi [JP 53-068124], for the same basic reasons that were set forth for claim 64 above, as supported by the publication “AN AUTOMATED PROGRAMMING CONTROL SYSTEM FOR CABLE TV” by Stern. The examiner notes the following:**

The examiner notes that Honbashi indicated that his VTR (11) operated to locate and retrieve desired recorded commercial messages/programs based on some type of addressing scheme [note the paragraph which begins in 23 on page 4 of the PTO obtained translation]. However, Honbashi gives few details as to exactly how this addressing scheme leaving such details up to the level of one of ordinary skill in the art.

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The examiner takes Official notice that it was notoriously well known in the video recording art to have implemented the addressing scheme that is required by the VTRs in Honbashi using a control track on the tape that is encoded with time codes or cuing signals and, in cases where such a control track was not available, by embedding/multiplexing the time codes or cuing signals within the video/audio portion of the programming itself. In all of these cases, to locate the programming that was to be retrieved, said time codes or cuing signals had to be reproduced during the running of the tape and compared with externally provided signal which represented the desired storage location of the desired programming; i.e. when the reproduces time code or cuing signal matched the externally provided signal, the desired location/program had been found.

The examiner maintains that one skilled in the art would have at least recognized the obviousness of having implemented the “addressing scheme” described and required in Honbashi using conventional time code or cuing signal techniques <sup>97</sup>. In such an implementation, the time code or cuing signal that was reproduced from the tape would have constituted the “at least one control signal” that is recited in claim 65.

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<sup>97</sup> For the record, attention is directed to the fifth paragraph beginning in line 39 of the first column on page 124 of the 1980 publication “AN AUTOMATIC CONTROL SYSTEM FOR CABLE TV” by Stern for a discussion as to the context in which the teachings of Honbashi should/must be viewed.

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**80. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honbashi [JP 53-068124], as supported by the publication “AN AUTOMATED PROGRAMMING CONTROL SYSTEM FOR CABLE TV” by Stern, for the same reasons that were set forth for claim 65 in the preceding paragraph of this Office action.**

1) The examiner notes that the households which received the audio<sup>98</sup> and video components of the commercial messages/programs outputted by the selective transfer device/component constitute the recited “receiver stations”.

**81. Claims 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker [EP 0,152,251].**

**PREFACE:**

For reasons which have been addressed in detail above (note “SECTION I” of this Office action), it is maintained that none of the currently pending amended claims are entitled to the alleged 1981 priority date.

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<sup>98</sup> For the record, the examiner notes that the commercial messages/programs described in Honbashi clearly comprised separately processed, but in an interlocked fashion, audio and video components [note lines 20-22 on page 4 of the translation].

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**The showing of Baker:**

Baker disclosed a broadcasting system as is illustrated in the figure. The system comprised:

1) A plurality of “*receiver stations*” (e.g. @ 2) each of which comprised a display device (e.g. @6) for displaying a respective “outputted” *personalized “multimedia presentation”*. Each of the “*outputted*” *personalized* multimedia presentations was comprised of user specific foreground image information which was superimposed over a common/shared background image [note the last 3 lines on page 5 and the first line on page 6]:

A) The shared/common background image information being obtained from a standard TV picture signal received at receiver 6; and

B) The specific/unique foreground image information was obtained by decrypting (@22) user specific/unique teletext pages which were also received at receiver 6 (e.g. wherein receiver 6 operated to superimpose @22).

In one embodiment, the receiver of each receiver station (2) included a “Telsoftware” adaptor couple to a computer (e.g. a “LEVEL 4” teletext decoder) whereby the receiver station could be “programmed” with

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downloaded decryption algorithms and keys in order to enable the receiver to decrypt the user specific/unique teletext data which was received over the manually selected TV channel [note lines 23-32 on page 7]; e.g. wherein:

- A) The downloaded decryption algorithm obviously corresponds to the “*first control signal*” of applicant’s claims; and
- B) The downloaded decryption key, or alternatively at least a portion of the encrypted teletext page information, corresponds to the recited “*at least one second control signal*” (e.g. the required decrypting “process” is performed “*in response to*” the both the received decryption “key” and the received teletext data that is decrypted).

**82. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker [EP 0,152,251] for the same reason that was set forth for claims 29 and 33 above. The following is noted:**

- A) With respect to claim 30, it is note that the “decryption algorithm” clearly contains “a sequence of processor instructions” which are executed at the “command” of both the received “key” and portions of the teletext data;

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B) With respect to claim 31, it is noted that teletext data is a digital signals which appears to have a “television program content” in the context that is now being claimed.

**83. Claims 2-5, 8, 13, 14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker [EP 0,152,251] for the same reason that was set forth for claims 29 and 33 above. The following is noted:**

- 1) With respect to claim 2: The TV picture signal and the teletext data transmissions in Baker represent “two transmissions of different kinds”.
- 2) With respect to claim 3: The receiver station in Baker was “programmed” in accordance with the downloaded “decryption algorithm” so as to process at least one of the “two transmittance of different kinds” (e.g. the teletext data transmission was processed).
- 3) With respect to claims 4 and 5: The displayed teletext “information” in Baker was “locally generated” image information for reasons thoroughly addressed in this Office action.
- 4) With respect to claim 14: The examiner maintains that the teletext data in Baker appears to have comprised a “television program content” in the context of the recitation.



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5) With respect to claim 16: It is noted that the receiver in Baker clearly processed a wide range of electrical signals. In one obvious implementation/application, e.g. a fiber optic implementation [note lines 5-9 on page 1], the receiver in Baker would process optical signals too.

6) With respect to claims 17 and 18: It is noted that, in Baker, channel selection requests and teletext data requests were both transmitted upstream to the external information source(s).

**84. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker [EP 0,152,251] for the same reason that was set forth for claims 29 and 33 above. The following is noted:**

1) With respect to claim 20: It is noted that the downloaded “decryption algorithm” in Baker corresponds to the recited “first signal” of claim 20 in that, by being processed, it enabled the receipt and display of the multimedia presentations. The “second signal” of the claims corresponds to the teletext transmission of Baker. [other interpretations are available too]

2) With respect to claim 21: The examiner notes that switching station (3) in Baker corresponds to the recited “intermediate transmission station”.

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**85. Claims 24, 26-28, 37-41, 43, 48-53, and 57 are rejected under 35**

**U.S.C. 103(a) as being unpatentable over Baker [EP 0,152,251] for the same reason  
that was set forth for claims 29 and 33 above.**

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86. The "Administrative Requirement" of the last Office action is hereby incorporated by reference into this Office action.

87. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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88. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Andrew Faile** whose telephone number is **(703) 305-4380**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(703) 305-4700**.

**David E Harvey**  
**Primary Examiner**  
**TC 2614**  
**(703) 305-4365**  
**8/01**

  
**DAVID E. HARVEY**  
**PRIMARY EXAMINER**

Art Unit:

**APPENDIX I: (Zaboklicki: arguments which have**

been reproduced from the file history of

S.N. 08/469,107)

Art Unit:

**I. The Zaboklicki reference (summarized):**

“Dialogue television”, *per se*, was notoriously well known in the art at the time that Zaboklicki was published<sup>99</sup>. This fact clearly explains why little effort was made by Zaboklicki to explain/define the meaning of the “dialogue television” terminology.

Applicant’s assertion that one skilled in the art would not have known what was meant by the term “dialogue television” is based on, or clearly attempts to portray, an unrealistically low level of skill for one of ordinary skill in the art.

Because “dialogue television” systems were already well known to those of ordinary skill in the art at the time Zaboklicki was published, one skilled in the art certainly would have expected the stated objective of the Zaboklicki disclosure to be something more than simply providing a basic/conventional “dialogue television system”. And indeed, the Zaboklicki publication clearly lived up to such expectations. Specifically, in reading the Zaboklicki publication, one finds that the stated objective of the Zaboklicki disclosure was to provide an *improved* dialogue television system. More specifically, the stated objective of the Zaboklicki disclosure was to provide the a dialogue television system **for facilitating the mass reception of dialogue television programming**

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<sup>99</sup> The examiner notes that term “dialogue television” was often used in European literature as a synonym for “interactive television”. Being such, the examiner continues to reject applicant’s assertion that one skilled in the art would not have known what was meant by the term “dialogue television” as used in the context of the Zaboklicki disclosure.

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**by a plurality of independent television receivers.** This was clearly the key feature which Zaboklicki believed distinguished his disclosed dialogue television system over dialogue television systems of the “prior art”.

To achieve this stated objective, Zaboklicki disclosed a dialogue television system in which at least one “dialogue television program”<sup>100</sup> was transmitted for “mass reception” by each of a plurality of television receivers. Each of these television receivers comprised programmable processing circuitry for independently receiving, processing, presenting and displaying the transmitted dialogue television program, under the control of downloaded computer software, by independently performing the following steps:

- a) by presenting the viewer(s) at the receiver location with a first displayed “program fragment”<sup>101</sup> of the selected dialogue television program (e.g. the presentation of a query which required a response from the viewer(s));

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<sup>100</sup> The term “dialogue television program” was used in Zaboklicki to refer to television programming which comprised a plurality of television “program fragments”; i.e. wherein the term “program fragments” referred to distinct pieces/segments of the dialogue television program. On the receiver side of the Zaboklicki system, only selected ones of these program fragments were displayed/presented in response to a viewer’s inputs thereby assembling a television program presentation that was tailored to the requirements of said viewer as defined by his/her inputs.

<sup>101</sup> The examiner notes that the term “program fragment” was used in Zaboklicki to refer to pieces/segments of a dialogue television program which comprised: a) a page of displayable teletext data; b) a segment of displayable audio programming; and/or c) a segment of displayable video programming.

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b) by accepting an input from the viewer(s) corresponding to his/her response to the first displayed program fragment (e.g. a required “yes” or “no” response to the query);

c) by presenting the viewer(s) with a next displayed “program fragment” of the selected dialogue television program wherein said next displayed fragment was selected in response to, and pertained directly to, the viewer’s response to the first displayed fragment (e.g. an explanation as to why his/her “yes”/“no” response to the presented query was right or was wrong); and

d) by presenting the viewer(s) with additional displayed “program fragments” of the dialogue television program which require additional responses from the viewer(s) and from the system (e.g. by repeating steps a-c for additional queries of the dialogue presentation).

For the record, it is noted that such interactive exchanges between the system and the viewer created, in effect, an interactive “*dialogue*” between the system and the viewer; hence the name “*dialogue/interactive television*”.

As with most (i.e. if not all) “*dialogue*”/interactive television systems, great effort in terms of labor had to be made by the creator of its “*dialogue*”/interactive television



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programming in order to ensure that each receiver received all of the program “fragments” that it required when “branching” through the program fragments of the dialogue program. Specifically, the creator of dialogue/interactive television programming had to be sure that the system would always know what fragments had to be received and displayed given each and every scenario/sequence of responses which could ever possibly be entered by any viewer. Specifically, during any given interactive exchange between a viewer and the system, each of the Zaboklicki receivers had to be capable of receiving, selecting, and displaying the specific program fragment of the dialogue/interactive program being presented which correspond to the viewer’s entered response. More specifically, if the viewer entered a “yes” response to a presented query, then receiver had to be capable of selecting and displaying the received program fragment which responded to this entered “yes” response while, at the same time, the receiver also had to be capable of having selected and displayed the received “alternative” program fragment which responded to an entered “no” response had the viewer entered a “no” response instead of the entered “yes” response; i.e. because the receiver had no way of knowing in advance how a given viewer would respond to each query, each receiver had to receive all of the program fragments which could be required even though many of them would not be required/used/selected/displayed/presented because they corresponded to the alternative responses which might have been entered, but were not entered, by the given viewer.

These program fragments, which required but were not used, constituted the “surplus” of

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fragments discussed in Zaboklicki document <sup>102</sup>. To be perfectly clear, because the Zaboklicki system had to be able to present a given viewer with the appropriate system response during each interactive exchange (e.g. the system had to receive and present a first system response/fragment when a viewer entered a “yes” response to a given query and had to receive and present a second different system response/fragment when the viewer alternatively entered a “no” response to the given query), and because the Zaboklicki system did not know which system response would be needed in advance of the exchange, all program fragments (i.e. a *surplus* of fragments) had to be transmitted for each interactive exchange so that the appropriate program fragment was always available for selection and display no matter how a viewer answered a given query (e.g. both the system response that was needed if/when the viewer entered a “yes” input to a given query and the *alternative* system response that was needed if/when the viewer alternatively entered a “no” input to the same query had to be available even though only one would ever be selected/displayed). The non-selected/”extra ones of said received program fragments which were not used/displayed were simply discarded/”dropped”; i.e. hence, the “*drops*” discussed in the Zaboklicki disclosure <sup>103</sup>.

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<sup>102</sup> As before, the examiner rejects applicant’s assertions that one skilled in the art would not have understood what Zaboklicki meant by the term “surplus” of fragments; i.e. applicant’s assertion is based on, or is an attempt to establish, an unrealistically low level of skill in the art.

<sup>103</sup> As before, the examiner rejects applicant’s assertions that one skilled in the art would not have understood what

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To perform the operations discussed above, each of the receivers in the Zaboklicki system had to be programmed so as to “know” how to locate, select, and display those of the transmitted program fragments which were needed to assemble the dialogue television presentation. To provide this knowledge (i.e. the crux of the Zaboklicki invention), each receiver in Zaboklicki received a transmitted “*digital processing program*”, in the form of downloaded “*Telesoftware*”<sup>104</sup>, along with the surplus of transmitted program fragments. This “*Telesoftware*” programmed a processor/CPU within each receiver with the computer software “instructions” that were necessary to locate, select, and display the ones of the surplus of transmitted program fragments so as to assemble the dialogue television program presentation that was assembled based on the responses of the respective viewer. [note item 40 and 41 on page 21 of the Zaboklicki translation].

As to the structure needed to implement the Zaboklicki receivers, the Zaboklicki disclosure left little to ones imagination. In fact, Zaboklicki provides various block diagrams which represent the required receiver structure of which the most detailed is that of figure 3. The functions performed by each block within these diagrams was clearly

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Zaboklicki meant by the term “drops”; i.e. applicant’s assertion is based on, or is an attempt to establish, an unrealistically low level of skill in the art.

<sup>104</sup> The term “Telesoftware” was used in a conventional manner in the Zaboklicki reference so as to refer to the transmission of computer software in the form of digital teletext data that was carried/embedded in the vertical blanking intervals of the video program fragments which comprised the transmitted dialogue television program.

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stated/identified by the functional labels which were provided under the heading "LIST OF REFERENCES" (note pages 19-23 of the PTO obtained translation) and, in almost all cases, are set forth and explained in much greater detail via the written description and claims of the Zaboklicki disclosure. For example, the following is noted with respect to figure 3 of the Zaboklicki disclosure:

a) Element "54" represents a TV receiver which includes a tuner for selecting and demodulating a single broadcasted TV signal transmission wherein said selected transmission represents a selected portion (e.g. "fragment") of a multichannel dialogue television broadcast. a video signal is then extracted from the selected/demodulated transmission wherein said video signal contains embedded teletext data comprised of Telesoftware, displayable teletext pages, fragment identification codes; and various other types of command/control signals. The receiver (54) outputs the said video signal to an output (i.e. @25);

B) Element "56" represents a teletext decoder which receives said video signal that was outputted (@25) from the receiver. Said teletext decoder operates: (@36) to receive the outputted video signal and to process/"prescreen" the teletext data embedded therein; (@40) to process/"prescreen" those portions of the prescreened teletext data which represent said Telesoftware and said fragment identification codes; (@41) to select and decode displayable teletext page data based on page selection codes received (via element 40) from a programmable

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processor (@6); (@57) to detect teletext command/control signals; (@ 42) to convert the selected displayable teletext page data into a displayable video signal and to output said displayable video signal to the TV receiver for display; (@40) to output said processed/prescreened Telesoftware and fragment identification codes to an input (@39) of said programmable processor (@6); and (@6) to program said programmable processor via said processed/prescreened Telesoftware so as to output (@40) various control signals for controlling the selection and display of the received program fragment based on the entered responses from the viewer (via element 34), based on locally provided initial user data (@35), and based on the prescreened fragment identification codes. It is noted that the control signals output from the programmable processor (@ 40) are used to control the tuner of the TV receiver (@27) to tune to receive video fragments, to control the teletext decoder to select teletext page fragments, etc,...

## **II. Applicant's allegation that the Zaboklicki reference is not enabling:**

Applicant continues to take the position that the Zaboklicki reference is not enabled as applied to the pending claims. With respect to these argument, the examiner notes the following:

A) First, applicant is again reminded that the teachings found in Zaboklicki must not be read in a vacuum. To the contrary, the teachings found in Zaboklicki

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must be read in light of the level of skill in the art which existed at the time of applicant's alleged invention. The examiner points out that interactive/"dialogue" television transmission systems of the type to which Zaboklicki was directed, and the technologies on which the Zaboklicki disclosure was based <sup>105</sup>, were all notoriously well known in the art at the time that the Zaboklicki disclosure was published [note: US Patent No. #3,008,000 to Morchand; the "second" translation

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<sup>105</sup> Applicant continues in his attempt to remove the Zaboklicki reference from consideration by portraying this reference as being: **"so vague and indefinite in its description of *the technology* that virtually any reliance on the publication as prior art in the instant application can only be based on speculation and conjecture....[it] is not an enabling publication."** It is noted that this position also seems to be applicant's excuse for never directly addressing the grounds of rejection which were/are based on the Zaboklicki reference during the prosecution of applicant's 329 co-pending applications; i.e. applicant now fails to explicitly state what it is within the Zaboklicki reference that applicant does not understand and/or believes would not have been enabled.

In response to applicant's allegation, the examiner simply points out that **"*the technologies*"** utilized by the Zaboklicki disclosure, (e.g. teletext distribution/display, "Telesoftware" distribution/execution, interactive/dialogue TV signal structure/format/display, TV receiver structure/tuning/display, etc,...), were all notoriously well known in the art at the time of the Zaboklicki invention, and it is this conventional state of these arts/technologies which serves as the backdrop/context in which the Zaboklicki disclosure/teachings would have been viewed by those of ordinary skill in the art. Applicant's error is that he has improperly chosen to view the Zaboklicki disclosure in a vacuum. Simply stated, the description provided by Zaboklicki was sufficient to have enabled one to have made and used the invention(s) as described in Zaboklicki and as applied against pending claims.

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of the German Patent document #2,550,624 obtained by the Office in January of 2001; US Patent #4,634,386 to Tamaki; US Patent #4,609,358 to Sangster; US Patent #4,264,924 to Freeman; etc,...). Given this level of conventional skill, the examiner maintains that one skilled in the art would have at least understood the Zaboklicki disclosure as having shown all that was set forth in part "I." of this paragraph.

B) While the examiner does not dispute the fact that effort is required in order to discern the meaning of the Zaboklicki disclosure, the examiner rejects applicant's assertions that the objectives and system implementations of the Zaboklicki reference were "ill-defined" and/or "unenabled". [SEE: the summary of Zaboklicki set forth in part "I." of this paragraph]

C) Applicant acknowledges that the Zaboklicki reference states that the goal of the disclosed system was to facilitate mass reception of "dialogue television". Applicant, however, argues that the Zaboklicki reference is not enabled because it failed to explain what actually constituted "dialogue television" [see lines 1-11 on page 45 of applicant's arguments filed 8/13/97 filed in S.N. 08/469,107]. This is absurd. Again, the use of the term "dialogue television" was notoriously well known in the art and its meaning within the context of the Zaboklicki reference would have been clear to those skilled in the art without the need of additional

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explanation. [SEE: the summary of Zaboklicki set forth in part "I." of this paragraph]

D) Having first admitted that he does not even understand the objectives of the Zaboklicki disclosure [note lines 4-6 on page 45 and lines 4-6 on page 46 of applicant's arguments filed in S.N. 08/469,107], applicant goes on to allege that the explanations given by Zaboklicki as to how such objectives were to have been achieved/implemented could not have been understood by those of ordinary skill in the art [i.e. a case in which applicant first admits that he is totally blind, but then authoritatively characterizes that which allegedly does not see]. Applicant even goes so far as to allege that those skilled in the art would not have even understood what various terminologies used in the Zaboklicki disclosure meant; e.g. "data surplus for drops"; "a digital processing program for the individual data fragments provided in the telecast", etc... [see lines 16-18 on page 45 of the arguments filed 8/27/97 in S.N. 08/469,107]. The examiner rejects applicant's allegation. One skilled in the art would have understood Zaboklicki's use of said terminologies and would have understood Zaboklicki's explanation as to how its explicitly stated objectives were to have been achieved. [SEE: the summary of Zaboklicki set forth in part "I." of this paragraph].

E) Again, the examiner reminds applicant that the Zaboklicki disclosure should not be read in a vacuum. Multichannel interactive TV display systems, *per*



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se, were notoriously well known in the art as has been evidenced by applicant's own cited "prior art" and the "prior art" cited in part "A)" of this section. At the time it was drafted, the alleged novelty of Zaboklicki clearly rested in its stated goal of having provided an interactive/"dialogue" TV program system which enable interactive TV programming to be transmitted for mass reception and display by a plurality of receivers [see part "B)" above]; i.e. not in simply having had provided an interactive/"dialogue" TV program system. As described, Zaboklicki achieved this goal by transmitting a "surplus" television program fragments along with the intelligence (i.e. "Telesoftware" as was explicitly stated) and the control signals that were needed to control each receiver to interactively select and display ones of the "surplus" of transmitted program fragments in response to inputs/responses from respective viewers.

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**APPENDIX II:** (claim to priority; “different” subject matter)

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Applicant alleges that many/most/all of his pending claims derive the support that is required under section 112-1 from the "*WALL STREET WEEK*" embodiment that was described in the current disclosure; wherein said current disclosure was originally filed on 9/11/1987 (i.e. hereafter "applicant's 1987 disclosure). During the present prosecution, applicant has alleged that these same pending claims are entitled to priority based on a "*WALL STREET WEEK*" embodiment that was described in the disclosure of a parent application filed 11/3/81 (i.e. hereafter "applicant's the 1981 disclosure).

Since applicant's 1987 disclosure is different from applicant's 1981 disclosure, and since applicant's 1987 disclosure did not formally incorporate the 1981 disclosure into the 1987 disclosure via an "*incorporation by reference*", the pending claims are only entitled to 1981 priority for the concepts that are common to both applicant's 1987 disclosure and applicant's 1981 disclosure. While the "*WALL STREET WEEK*" embodiment that is described in applicant's 1987 disclosure and the "*WALL STREET WEEK*" embodiment that is described in applicant's 1981 disclosure have their similarities, the actual methods/details/structures used to carry out these two "*WALL STREET WEEK*" embodiments are quite different. The following is provided to exemplify such differences:

- a) It is noted that: 1) applicant's 1987 disclosure references figure 1 of the 1987 disclosure as illustrating the receiver structure that was used to implement the

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1987 "*WALL STREET WEEK*" embodiment [note the discussion which begins in line 21 on page 20 of applicant's 1987 disclosure]; and 2) applicant's 1981 disclosure references figure 6c of the 1981 disclosure as illustrating the receiver structure that was used to implement the 1981 "*WALL STREET WEEK*" embodiment [note the discussion which begins on line 31 of column 19 of US Patent #4,694,490]. While these two figures use a common label "MICROCOMPUTER" and reference numeral "205" to identify one element of the respective structures, the identified elements are clearly different in structure and operation; i.e. showing **that it would be erroneous for one to assume** that common labels and common reference numerals were used in applicant's 1981 and 1987 disclosures as an indication of common elements. The fact that commonly labeled elements in applicants 1981 and 1987 disclosures represent different structures/operation is evidenced in the following:

1) the "MICROCOMPUTER" (205) of applicant's 1987 disclosure actually comprised the circuitry required for overlaying locally generated graphics over the related/received TV signal broadcast whereas, in contrast, the "MICROCOMPUTER" (205) of applicant's 1981 disclosure did not comprise such circuitry but instead outputted locally generated graphics to the TV receiver so that they could be overlaid over a related/received TV signal broadcast;

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2) the "MICROCOMPUTER" (205) of applicant's 1987 disclosure actually comprised the circuitry required for receiving, loading, and running downloaded computer *software* (i.e. the disclosed "program instruction set") which was used to control the "MICROCOMPUTER"(205) of applicant's 1987 disclosure to execute functions defined by ones of later received discrete instructions whereas, in contrast, the "MICROCOMPUTER" (205) of applicant's 1981 disclosure was pre-programmed with computer *software* which was used to control the "MICROCOMPUTER"(205) of applicant 1981 disclosure to execute functions defined by ones of received discrete instructions;

B) In view of the differences in structure that is set forth in part a) of this paragraph, it is clear that the method used to overlay graphic images on a related/received TV signal broadcast in the 1987 "*WALL STREET WEEK*" embodiment is quite different from the method used to overlay graphic images on a related/received TV signal broadcast in the 1981 "*WALL STREET WEEK*" embodiment. Most notably, in the 1981 "*WALL STREET WEEK*" embodiment the overlay method was performed by cuing a microcomputer with instructions signals (e.g. cuing signals) which caused the microcomputer to execute ones of locally stored software instructions which were required to generate, output, and overlay

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locally generated graphics onto a received/related video signal broadcast whereas, in sharp contrast, in the 1987 "*WALL STREET WEEK*" embodiment the overlay method was performed by first **downloading software** to the microcomputer and then cuing the microcomputer with instructions signals (e.g. cuing signals) which caused the microcomputer to execute the downloaded software to generate, output, and overlay locally generated graphics onto a received/related video signal broadcast.

C) The examiner agrees that applicant is entitled to the 1981 priority date only for those claims of the present application which are limited to subject matter that was **common** to both of applicant's 1981 and 1987 disclosures. Under the present circumstances <sup>106</sup>, it is maintained that applicant is not entitled to the 1981 priority date for claims which the **same/common support** can not be shown to exist in both of applicant's 1981 and 1987 disclosures. More specifically, the examiner rejects any allegation that applicant is entitled to the priority of their 1981 disclosure for claims which depend from their 1987

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<sup>106</sup> The present disclosure: 1) comprises the 1987 disclosure and is, at best, a CIP of the disclosure filed in 1981; and 2) comprises the 1987 disclosure into which the 1981 disclosure has not been incorporated (i.e. neither literally nor by reference).

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disclosure when it can be shown/alleged that each claim has different interpretations which allow them to be read on applicant's 1987 "*WALL STREET WEEK*" embodiment (via a first interpretation) and on applicant's 1981 "*WALL STREET WEEK*" embodiment (via a second interpretation that is different from the first); i.e. priority to the 1981 disclosure should/will only be given if applicant can show that the way that the claims are being interpreted is the same for both disclosures ( i.e. if the teachings on which each claim is based is **common** to both disclosures). To permit otherwise, would improperly create a tool by which an applicant could obtain the earlier filing date of a first filed invention, for a later filed invention, by carefully drafting subsequently filed claims in a manner which allows said drafted claims to be read on both inventions via different interpretations of the same claims. In the present application, it would be improper for the examiner to give a 1981 priority date to claims that are directed to applicant's 1987 "*WALL STREET WEEK*" embodiment even if it can be shown that the same claims can be interpreted in a manner which allows them to be read on applicant's 1981 "*WALL STREET WEEK*" embodiment; i.e. unless it can show that the support that is provided for the claims by both disclosures is in fact the same/common to both disclosures. Because the disclosed structures and processes used to implement applicant's 1987 "*WALL STREET WEEK*" embodiment clearly

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differ from the disclosed structures and processes used to implement applicant's 1981 "*WALL STREET WEEK*" embodiment (note: parts a and B of this paragraph), the examiner maintains that the subject matter which is actually common to both disclosures, e.g. that subject matter of the 1987 disclosure which is actually entitled to priority of the 1981 disclosure, is very small indeed.



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**APPENDIX III:**(“MODE 2” captioning)

**“MODE 2”-TYPE CAPTIONING AS DESCRIBED:**

- A) On pages of 137 and 138 of “THE CBS/CCETT NORTH AMERICAN BROADCAST TELETEXT SPECIFICATION (EXTENDED ANTIOPE)” which was published on 5/20/81; and
- B) On page 72 of Appendix B of a Petition that was filed on 7/29/80 with the FCC

CBS/CCETT  
NORTH AMERICAN  
BROADCAST TELETEXT  
SPECIFICATION

(EXTENDED ANTIOPE)

MAY 20, 1981

KC006348

## 7.0 APPLICATIONS

The preceding specification may be used for a multitude of applications; this document will address only two of them, broadcast teletext and captioning. Chapter 8 will describe the subset of rules that will be used for these two services.

### 7.1 Broadcast Teletext

Broadcast teletext is a system which transmits a collection of pages in a cyclical fashion. The pages are organized into groups called magazines. The pages in broadcast teletext are transmitted as complete messages and there is no interaction between the user's decoder and the data base. The user's decoder grabs the pages as they come by in the cycle by means of a page number which is assigned to each page. Pages may also be grabbed through the record header specification bytes as described in Chapter 5.

Each page of the magazine consists of one or more records and is identified by a page number which is the value of the address bytes A1 A2 and A3. In the case of a multi-record page each record is identified by the record header. (See Chapter 5).

Certain pages may be identified by their content and can be grabbed by means of the Y bytes. Examples of these pages are index pages, cover pages, etc.

Through use of the session layer commands it is also possible for a teletext message to contain additional information for use by sophisticated decoders (multipage decoders, for example) that will allow the decoder to automatically capture and store associated pages. Examples may be the sub-index page of a particular section of pages or in the case of a decoder with many pages of memory all the pages in a given category selected by the user.

This interaction at the session level can make the cyclical broadcasting of pages appear to the user as if he were accessing a tree structured data base.

## 7.2 Hybrid Broadcast/Interactive Teletext

Because of the strict adherence to the ISO layered architecture it is also possible to have a hybrid system using a broadcast link in one direction and a lower bandwidth link in the other (telephone line, return cable channel, etc.). In this case pages could be either captured from the cycle or could be individually requested via the return channel.

KC006385

Through use of the "Y" bytes, program related pages can also be transmitted. Program related pages are those pages that are transmitted with a television program and are intended to be a complement to the television program. One example of a program related page is captioning.

### 7.3 Captioning

Captioning is a program related teletext message that is transmitted to the decoder and superimposed over the program video at a pre-designated time. The captioning message functions in a manner similar to a normal teletext message except that instead of having to select each page individually the user selects a classification of captions and a level (from 1 to 9) and the decoder automatically displays and erases the appropriate captions at the proper times.

In the case of captioning the session level identifies the fact that the message is a caption. A caption message is characterized by the fact that it is displayed, not over a blank screen, as in the case of normal teletext, but rather over program video. Depending on decoder manufacturers' option, the caption may be displayed keyed over the video or inserted into the video in a box.

Captions are transmitted to the decoder with a bit in the header set so that the caption is captured and put into memory but not displayed. This way many different versions of the same caption may be sent and each decoder can capture the version it chooses. When the caption is to be displayed a simple control packet is sent with the caption type designator equal to the caption to be displayed along with a reveal bit. This causes the caption to be displayed over the program video. To erase the caption another message is sent to the decoder telling the decoder to erase the page and wait for the next caption.

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5A

RECEIVED

JUL 29 1980 R-  
F.B.I.

OFFICE OF THE SECRETARY JUL 20 1980

Before the  
Federal Communications Commission  
Washington, D.C. 20554

OFFICE OF THE SECRETARY

In re

Amendment of Part 73, Subpart E of  
the Rules Governing Television  
Broadcast Stations to Authorize  
Teletext

RECEIVED

JUL 20 1980

RM No.

OFFICE OF THE SECRETARY

TCM-3727

TO: The Commission

PETITION FOR RULEMAKING

CBS Inc. ("CBS"), pursuant to Section 1.401 of the Commission's Rules, hereby petitions the Federal Communications Commission for the issuance of rules which would allow television broadcast licensees to transmit teletext. Adoption of teletext rules and standards is essential at this time to permit implementation by United States broadcasters, such as CBS, of this major technological advance, already in use in other countries, and to channel the United States development of teletext into practical public service in furtherance of the Commission's mandate to "encourage the larger and more effective use of radio in the public interest."\*

\* Section 303(g), Communications Act of 1934, as amended.



ORIGINAL  
FILE

*RM-3727*

Appendix B

CBS

Broadcast Teletext System Standard

Date: 7/29/80

Prepared by: W.C. Nicholls  
R.P. Seidel

Reviewed by: W. Connolly

Approved by: J.A. Flaherty

2B.

#### 7.11.2.1 Mode 1 Captioning

Where only a few captions are to be sent and the timing with program video or audio is not critical, each caption record is sent with the Y caption flag raised ( $Y1_3$  b6 = 1). This implies two things to the decoder: provide transparent background and suppress the page display. The caption is displayed upon the reception of ETX/EOT, which occurs only at the end of the record.

#### 7.11.2.2 Mode 2 Captioning

When many captions are sent, at various levels and in various languages, forming classes, all the varieties for a given class of captions are sent far enough ahead to allow the decoder to store the one selected. The Y caption flag ( $Y1_3$  b6 = 1) is raised on each one, implying transparent background and suppress page display. The conceal flag ( $Y1_3$  b8 = 1) should also be raised. After all varieties of a given caption are sent, one additional record is sent with the conceal flag low [(equal reveal)  $Y1_3$  b8 = 0]. This single command causes all decoders which have been storing a class of captions to display it. This last command is seen by all decoders, regardless of what page number they may have been instructed to look for because this page has no number and has the alarm flag raised in the Y's ( $Y1_1$  b8 = 1).

#### 7.11.2.3 Caption Removal

To remove a class of captions and leave a blank screen, an alarm page is sent with the conceal flag raised, ( $Y1_3$  b8 = 1). This method is effective for either type of caption.

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**APPENDIX IV:** (*ancillary/insertion signaling systems*)

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The following represents but four examples of *ancillary/insertion signaling system* prior art:

a) The publication "A System of Data Transmission in the Field Blanking Period of the Television Signal" by P.R. Hutt published in June of 1973 (cited by applicant) illustrates: the basic configuration of such distribution systems including the insertion circuitry needed for inserting formatted ancillary/insertion signals into the VBI of the TV programming which was to be distributed by the TV network; the TV network for distributing the TV programming containing the inserted ancillary/insertion signals; and the data separating circuitry at TV receiving sites for separating the formatted ancillary/insertion signals from the distributed TV programming and for using the information/data contained within the separated ancillary/insertion signals to perform various control and monitoring functions at the receiving site (note figures 36 and 37 on page 38 of the publication). A list of no less than 20 different monitoring and control functions which could be performed at the receiving sites via the information/data carried

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*by said inserted ancillary/insertion signals is also provided via the section/paragraph that bridges pages 43 and 44 of this publication. Significantly, teletext services (i.e. "ORACLE service") was one of these 20 listed applications;*

*b) The publication "Vertical Interval Signal Applications" by Harry A. Etkins which was published in April of 1970 in Broadcasting Engineering, also illustrates circuitry for encoding and distributing ancillary/insertion signals in the VBI of distributed TV programming (note figures 1 and 2) and also provides a list of no less than 10 different monitoring and control functions which could be performed at the receiving sites via the information/data carried by said inserted ancillary/insertion signals [note the list which begins in the last column on page 30 and extends to the last column on page 32 of the publication]. Significantly, one of the applications for the ancillary/insertion signals that was discussed was the automatic recording of TV programming at intermediate headend CATV location in order to "solve two of the most vexing problems in cable TV program*

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*distribution, dubbing [i.e. taping duplicate copies] and bicycling [i.e. manually transporting the duplicate copies to the respective CATV headends]";*

c) *The publication "ANCILLARY SIGNALS FOR TELEVISION-INNOVATIONS AND IMPLICATIONS" which was a Final Report that was published by the U.S. DEPARTMENT of COMMERCE in September of 1975. This publication explicitly evidences the fact that the VBI of distributed TV programming was an obvious choice for ancillary signal insertion/distribution because it had "the greatest potential for meeting the basic requirement that ancillary signals are not visible in the picture area" [note lines 7-15 on page 19], and the publication provides a list of no less than 20 different monitoring and control functions which could be performed at the receiving sites via the information/data carried by said inserted ancillary/insertion signals [note the list which begins on page 38 of the publication and extends to page 39 of the publication];*

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d) *The publication "The Vertical Interval: A General-Purpose Transmission Path" by Ted V. Anderson which was published in September of 1971 (cited by applicant) which also evidenced the desirability to have used the VBI of distributed TV programming as a general-purpose transmission path for carrying and distributing ancillary/insertion signals containing information/data pertaining to no less than 10 different listed control and/or monitoring functions [note: the "Abstract" on page 77 of the publication; the first seven lines under the heading "Introduction" on page 77 of the publication; the discussion in the first paragraph under the heading "Conclusion" on page 81 of the publication; etc,...].*

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**APPENDIX V:***(The Content/Scope of Applicant's 1981 and 1987*

*Disclosures as Alleged by Applicant's Own Web*

*Page)*



## PERSONALIZED MEDIA COMMUNICATIONS



To learn more about the technologies that support the PMC System, and define many elements of the convergence of communications and computing in a networked environment, click on the areas of interest below. To see the patent or patents related to each technology, click on the patent number at the end of each section.

To review a summary of PMC's patent activity and to access links to each of the seven issued United States Patents it holds, [click here](#).

- [Personalizing Media](#)
- [Locating Signals](#)
- [Synchronizing Signals](#)
- [Reprogramming Signals](#)
- [Generating Local Video Overlays](#)
- [Automating Servers](#)
- [Automated Transmission and Insertion of Programming and Advertising](#)
- [Automation of Multimedia and Multiple Media Presentations at End-User Sites](#)
- [Customizing On-Screen Program Guides](#)
- [One Touch VCR Recording](#)
- [Intelligent Agents](#)
- [Pay-Per-View Promotion and Acquisition](#)
- [Interactive Television Transmission and Response](#)
- [Impulse Purchasing](#)
- [Metering](#)
- [Monitoring](#)
- [Decryption](#)
- [Conditional Access Authorization](#)
- [Programming Access Control](#)

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### Personalizing Media

Systems designed for the creation and communication of PMC's personalized video and audio media.

To view the Representative Patents, click on the number below:  
[4,965,825](#), [4,694,490](#), [4,704,725](#)

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## **Locating Signals**

Locating embedded digital signals in variable locations, within a transmission. The system employs microprocessors to locate each embedded signal and to identify what function to perform in response to the signal.

To view the Representative Patents, click on the number below:  
[5,335,277](#)

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## **Synchronizing Signals**

Controlling the synchronization of signals through the timing of their decryption as, for example, in the MPEG-2 System.

To view the Representative Patents, click on the number below:  
[5,335,277](#), [5,109,414](#)

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## **Reprogramming Signals**

Receiving a signal in a broadcast transmission that identifies a changing signal in the broadcast.

One example is channel mapping, a method to dynamically move channels while maintaining a consistent channel number for the viewer. For example, on a given cable system CNN always appears to the viewer on channel 15 while, transparent to the viewer, the cable system actually carries CNN on one or more channels, other than channel 15.

To view the Representative Patents, click on the number below:  
[5,335,277](#)

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## **Generating Local Video Overlays**

Displaying information about a given television program via locally generated video overlays. The overlay may contain information about the television program such as program provider, program title, description, rating, start time, end time. etc.

To view the Representative Patents, click on the number below:  
[5,335,277](#)

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### **Automating Servers**

Providing automation capacity for server nodes, especially in recording and routing data packets on time-shifted and systematically delayed bases.

To view the Representative Patents, click on the number below:  
[5,109,414](#)

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### **Automated Transmission and Insertion of Programming and Advertising**

Using control signals to automate the transmission, reception and insertion of any type of programming and/or advertising content to computer network servers, local cable systems, broadcast affiliates or other such intermediate stations.

For example, in order to avoid lengthy delays in accessing Web sites, popular sites are "broadcast" or "streamed" to multiple intermediate servers. The broadcast stream includes instructions to the servers to receive and store specific Web sites for local user access.

In a cable environment, satellites transmit spot commercials to a cable system's headend. The cable system automatically selects its commercials, maintains them in inventory, sets them up on video tape players or servers and inserts them into network transmissions on a scheduled basis. The system also automates the administrative aspects of the local operations.

To view the Representative Patents, click on the number below:  
[5,109,414](#)

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### **Automation of Multimedia and Multiple Media Presentations at End-User Sites**

Automating media centers by controlling a wide variety of user's peripheral equipment including computers, printers, television sets, radios, VCRs, recorders and compact disk, CD-ROMS, telephone equipment, etc.

To view the Representative Patents, click on the number below:  
[5,109,414](#), [5,335,277](#)

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## **Customizing On-Screen Program Guides**

Allowing users to generate customized program guides such as one based on themes or favorite channels.

To view the Representative Patents, click on the number below:

[5,335,277](#)

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## **One Touch VCR Recording**

Enhancing VCR recording functionality by providing the capacity to record programming for later use with the touch of one button.

To view the Representative Patents, click on the number below:

[5,335,277](#)

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## **Intelligent Agents**

Viewing or recording choices based on a working knowledge of individual viewer's interests. Whenever viewers make actual program choices, the system updates its data base of specific viewer interests.

To view the Representative Patents, click on the number below:

[5,335,277](#)

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## **Pay-Per-View Promotion and Acquisition**

Systems which facilitate the promotion (i.e., a request by a viewer for information about the program such as a preview or on-screen description via text), the ordering of a program, the storage of orders and the transmission of order information to a remote source.

To view the Representative Patents, click on the number below:

[5,335,277](#), [5,233,654](#)

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## **Interactive Television Transmission and Response**

Management of the transmission of and user responses to interactive television programming.

To view the Representative Patents, click on the number below:  
5,233,654

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### **Impulse Purchasing**

Enabling viewers ordering products offered on television to have related pertinent information, such as a credit card number, automatically incorporated in their order.

To view the Representative Patents, click on the number below:  
5,233,654

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### **Metering**

Automatically accounting for units of content that users are authorized to receive, and/or transactions made by users, maintaining records of usage/transactions and automatically transmitting this information to data collection stations.

To view the Representative Patents, click on the number below:  
5,233,654

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### **Monitoring**

Monitoring the use of content in a wide range of environments. Audience members can input responses to a device which includes a processor, to process input, assemble records that include additional information, and transmit the records to a central computer for analysis.

To view the Representative Patents, click on the number below:  
4,965,825

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### **Decryption**

A system for varying code locations and decryption techniques, offering easily implemented high levels of security.

To view the Representative Patents, click on the number below:  
5,335,277

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### **Conditional Access Authorization**

A system to authorize permission for the execution/re-execution of previously downloaded source code.

To view the Representative Patents, click on the number below:

[5,335,277](#)

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### **Programming Access Control**

A local program lockout feature to block access to unauthorized users, e.g. children, for viewing certain channels and/or content.

To view the Representative Patents, click on the number below:

[5,235,277](#)

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### **Patents**

Personalized Media Communications, L.L.C. currently has seven issued U.S. patents and over three hundred patents pending. All seven issued patents are based on disclosure filed in the U.S. Patent and Trademark Office in 1981. Extensive coverage is also being prosecuted internationally based on a second disclosure which was filed in 1987. Two patents have been received in Japan (No. 2676710 and No. 2690676) and one in Australia (No. 624087). In addition, the European Patent Office has recently published the first (No. 0382764) in what is expected to be a series of patents.

The newest patent, U.S. Patent No. 5,887,243, covers methods for the ordering of cable and satellite pay-per-view programming, the integration of Web content into television programming, and the personalization of broadcast television programming.

The pay-per-view ordering methods covered by the patent relate to functionality contained in analog, advanced analog and digital cable set-top converters, as well as satellite receivers. Specific functions include ordering a program, selecting the viewing time for the program, viewing a promotional preview for the program and viewing other information such as the program's rating or the viewer's credit balance.

The integration of Web content into television programming as covered by the

patent is a process for automatically linking relevant Internet content with television content in order to provide a richer broadcast presentation.

The system for the personalization of television programming covered by the patent is technology that enables unlimited numbers of viewers of traditional broadcast television to simultaneously receive programming that has specific relevance for each viewer. Viewer-specific segments, based on the viewer's profile and the program, are simultaneously produced at each viewer's receiver and combined into the context of the program at relevant moments to create a personalized presentation.

Each of the U.S. Patents held by PMC is listed below. To read the patent, click on the patent number in which you are interested:

- [U.S.Pat. No. 4,694,490](#)
- [U.S.Pat. No. 4,704,725](#)
- [U.S.Pat. No. 4,965,825](#)
- [U.S.Pat. No. 5,109,414](#)
- [U.S.Pat. No. 5,233,654](#)
- [U.S.Pat. No. 5,335,277](#)
- [U.S.Pat. No. 5,887,243](#)



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Art Unit:

**APPENDIX VI:** (*The publication “Does Supreme Court  
Precedent Sink Submarine Patents” by  
Timothy R. DeWitt; PTC Foundation of the  
Franklin Pierce Law Center; 1998)*)



38 IDEA 601 (Cite as: 38 IDEA: J.L. &amp; Tech. 601)

IDEA: The Journal of Law and Technology 1998

Courtesy  
Bill L.**DOES SUPREME COURT PRECEDENT SINK SUBMARINE PATENTS?**

By Timothy R. DeWitt [FNa1]

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**I. Introduction**

**\*601** Time and time again, clients seek assistance in defending patent infringement lawsuits brought by the owners of "submarine" patents. These patents often spend a decade or more as pending applications in the Patent and Trademark Office only to surface as issued patents at the height of commercial viability, wreaking havoc on well established industries. These submarine patents often leave entire industries scrambling for a defense because the long pendency of the applications permits the applicants to write claims that directly cover industry-standard products.

Perhaps it is time to fight fire with fire - to sink the submarine patents with "submarine" Supreme Court decisions. More than a hundred years ago the Supreme Court began a line of decisions that condemned the practice of enlarging the scope of patents many years after their issuance. [FN1] Although the condemnation originated in the context of broadening reissues, it spread to continuation and divisional practice by way of analogy. [FN2] Over time a number of factors, ranging from incomplete codification to "modification by treatise," [FN3] have served to obscure these still-valid decisions to the point that accused infringers neglect to raise and vigorously argue them in the district courts.

Recently however, with the seemingly ever-increasing number of submarine patents, these long-overlooked Supreme Court decisions have been thrust back into the public eye. The most notorious recent **\*602** development, of course, is the highly publicized "flip-flop" of the Nevada district court in *Ford Motor Company v. Lemelson*. [FN4]

The heightened interest in the Supreme Court decisions, and *Webster Electric Co. v. Splitdorf Electric Co.* in particular, [FN5] began in June of 1995 when a Nevada magistrate judge issued a Report and Recommendation which found Jerome Lemelson's [FN6] patents unenforceable on summary judgment due to Lemelson's delay in prosecuting those patents. [FN7] In April, 1996, the district court judge adopted the magistrate's Report and Recommendation. [FN8] The Report and Recommendation, published together with the district judge's two paragraph adoption of the Report and Recommendation, presented a detailed analysis of both the reissue statute and the doctrine of laches. [FN9]

With respect to reissue, Ford Motor had argued that the two-year limitation on filing broadening reissues should apply as an absolute bar to continuation and divisional application practice. [FN10] The magistrate noted that no relationship, express or implied, existed in the statutory scheme between the reissue section, 35 U.S.C. § 251, and the continuing application section, 35 U.S.C. § 120. [FN11] Accordingly, the magistrate found that the statutes themselves did not mandate the application of the two-year limitation on broadening reissues to continuing application practice. [FN12]

The magistrate also considered the public policy implications of Ford Motor's argument and found that public policy weighed against applying the two-year limit to continuing applications. [FN13] In particular, the magistrate found that:

The legal conclusion urged by Ford would encourage inventors to hide their disclosures by not taking patents. Instead, they would choose to abandon **\*603** pending applications to avoid the imposition of § 251's two year reissue limitation in favor of continuation practice which would remain otherwise unlimited by statute. Such a result would ratify the "submarine" practice Ford seeks to defeat. [FN14]

Accordingly, the court refused to construe the reissue statute as necessarily limiting the use of continuing applications. [FN15]

The magistrate proceeded to analyze Lemelson's prosecution activities under the doctrine of laches. [FN16] The magistrate began the analyses with the broad foundation of laches generally: "equity aids the vigilant, not those who slumber on their rights." [FN17] Laches, of course, does not require reliance or intent as do other equitable defenses such as estoppel or fraudulent delay. [FN18] Rather, the

doctrine is applied where there is no statutory period of limitation on the party's right to enforce his interest. [FN19]

Preliminarily, the magistrate noted the distinction between laches and equitable remedies generally:

Although the majority of case law on laches involves parties' delays in bringing suits to enforce rights, courts have extended equitable rules to parties' activities in the patent application process. [FN20]

The magistrate then cited inequitable conduct [FN21] and file wrapper estoppel [FN22] as two examples of equity reaching into the prosecution of patents. [FN23]

This distinction between the patent defense commonly known today as "laches" and equitable remedies generally has become particularly important in view of a later decision issuing from the District Court \*604 for the Northern District of California which attempted to mechanically apply Federal Circuit law on laches to the prosecution of a patent. [FN24] The result of that court's mechanical analysis was the striking of the defendants' laches defense. [FN25]

In particular, the court in *Advanced Cardiovascular Systems, Inc. v. Medtronic, Inc.* applied the laches analysis set forth by the Federal Circuit in its landmark decision in *A.C. Auckerman Co. v. R.L. Chaides Construction Co.* [FN26] The Auckerman decision held that the laches delay period begins when the patentee has notice that it has a cause of action against the defendant for infringement. [FN27] If the laches elements are satisfied, the patentee is barred from collecting damages prior to filing suit. [FN28] As the Medtronic court found, this laches defense defined in Auckerman is wholly inappropriate for delays in prosecuting the patent. [FN29] The patentee cannot have knowledge of its cause of action prior to issuance of the patent because no cause of action exists until the patent issues. The Medtronic court's analysis, however, fails to consider equitable remedies generally.

Contrary to the court in Medtronic, the magistrate in *Ford Motor* analyzed the defense in terms of Supreme Court precedent on the general application of equity in patent cases rather than mechanically analyzing the defense under the laches principles set forth by the Federal Circuit in Auckerman. [FN30] This general application of equity to prosecution delays may be referred to as "inequitable delay."

The Ford Motor magistrate's general equity analysis began with a discussion of the Federal Circuit's decision in *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.* [FN31] In that case, the Federal Circuit affirmed a district court's finding of no laches in an infringement suit based on a patent which issued more than twenty years after the application was filed. [FN32] The Federal Circuit's decision addressed two issues relevant to prosecution delays. First, the Federal Circuit considered whether the patentee bore responsibility for the delay and found that the \*605 delay was due to the Patent Office and not the applicant. [FN33] Second, the Federal Circuit considered whether it should set an arbitrary limit on the acceptable length of prosecution regardless of who bears responsibility for the delay. The Federal Circuit declined to set an arbitrary limit:

The delay in patent issuance that we here confront is appallingly long. The culprit, however, was not SGK but the tortuous interference practice. We are without authority to set our own arbitrary limit. [FN34]

The critical aspect of the Federal Circuit's decision is that it did not state that laches cannot apply to delays in prosecuting a patent.

The magistrate next considered the Supreme Court's decisions in *Crown Cork & Seal Co. v. Ferdinand Gutmann Co., Inc.* [FN35] and in *Webster Electric Co. v. Splitdorf Co.* [FN36] The Webster Electric decision found laches due to an applicant's lengthy delay in prosecuting the patent application. [FN37] The later Crown Cork decision clarified Webster Electric by explicitly stating that no fixed two-year presumption of laches exists for continuation applications. [FN38]

The magistrate in *Ford Motor Co.* then analyzed Lemelson's conduct to determine whether it was reasonable. The magistrate found the conduct to be unreasonable because Lemelson did not present the subject claims to the patent office until decades after he first filed his application; and on that basis, the magistrate found Lemelson's patents to be unenforceable. [FN39] The district judge later adopted the magistrate's Report and Recommendation. [FN40]

Nearly a year after it first adopted the magistrate's Report and Recommendation finding Lemelson's patents invalid and unenforceable, the Nevada district court reversed its decision on reconsideration.

[FN41] The Nevada district court based its reversal on a perceived judicial "reluctance to equitably restrict patent continuation practice" [FN42] and a misreading of Supreme Court precedent. The court itself acknowledged that the cases upon which it relied did not squarely address the issue of equity in the \*606 context of the prosecution of a patent. The court characterized its reliance as follows:

While it is true that these cases do not squarely address the applicability of the equitable doctrine of laches in the context of 35 U.S.C. § 120, the tenor of these cases expresses an unwillingness to judicially circumscribe the delays inherent in the operation of statutory schemes. [FN43]

The court's analysis in this regard was wholly off the mark. The equity issue relating to submarine patents is not simply the amount of time the patent spent in prosecution, but rather whether the patentee abused the statutory scheme with an unreasonable delay that operated to the detriment to others. None of the cases relied upon by the Nevada court addressed the equitable aspect of the issue. Instead, all those cases dealt with attempts to create mechanical judicial limitations of statutory schemes. [FN44] Such a practice would obviously be improper.

The decisions in *Ford Motor Co.* and *Medtronic* actually highlight a critical point of the early Supreme Court decisions addressing inequitable delay. In particular, a mechanical limitation on the use of continuation practice will be inherently unfair to owners of patents whose issuance was delayed through no fault of their own. A governmental agency such as the Patent Office inherently suffers bureaucratic delays which should not serve to prejudice patentees. Instead, the statutory scheme should assume honesty and good faith on the part of applicants and permit, as it does, unlimited continuation application practice. Courts of equity, on the other hand, should preclude abuse of the system.

## II. Submarine Patents and Double Patenting

The patent laws provide applicants with several procedural vehicles for prosecuting their patent claims, several of which may be used to delay issuance of a patent. Those vehicles include continuation, continuation-in-part, divisional, and reissue applications. [FN45] A continuation application is one that claims the benefit of the filing date of an earlier application. An application whose subject matter is disclosed in accordance with 35 U.S.C. § 112 in an earlier filed U.S. application may claim the benefit of the filing date of that earlier application if it was filed before the patenting or abandonment or termination of proceedings \*607 on the first application or on an application similarly entitled to the benefit of the filing date of the first application. [FN46]

A continuation-in-part application likewise may claim the benefit of the filing date of an earlier application to the extent the claims of the later application are supported by the disclosure of the earlier application. [FN47] A divisional application permits an applicant to file a second patent application having the same disclosure as an earlier filed application, and to obtain the benefit of the filing date of the earlier application when two or more distinct inventions are disclosed and supported by the disclosure. [FN48] In each of these practices, the earlier application typically will either issue into a patent or go abandoned shortly after the filing of the continuation, continuation-in-part, or divisional application.

These practices often result in a series of patents issuing from a single disclosure. At least one well-established limitation, double patenting, does exist. The basic concept of double patenting is that the same invention cannot be patented more than once, since that would result in a second patent which would expire after the term of the first patent and extend the time of the protection. [FN49] Only the claims are compared when assessing double patenting. [FN50] Two types of double patenting exist: same invention and obviousness-type. [FN51]

Same invention double patenting arises under 35 U.S.C. § 101, which permits "a" patent for any new and useful process, machine, manufacture or composition, or any new and useful improvement thereof. [FN52] For same invention-type double patenting to exist, the two patents must be drawn to identical subject matter. [FN53] The test is whether \*608 the claims of the two patents cover the same subject matter. [FN54] However, the fact that claims of one patent dominate the claims of another does not necessarily mean that the patents claim the same invention. [FN55]

Obviousness-type double patenting is a judicially created doctrine grounded in public policy. [FN56] The doctrine prohibits the issuance of claims in a second patent which are not patentably distinct from those in a first patent. [FN57] The question involved in obviousness-type double patenting is whether the

claimed invention in the second patent or application, in light of the prior art, constitutes a merely obvious variation of the invention defined in the claims of the first. [FN58]

A patentee can overcome an obviousness-type double patenting problem by submitting to the Patent Office a terminal disclaimer stating that the second patent will expire with the first. [FN59] A terminal disclaimer "is not an admission of obviousness of the later-filed claimed invention in light of the earlier-filed disclosure." [FN60] It raises neither a presumption nor estoppel as to the merits of an obviousness-type double patenting claim. [FN61]

Double patenting, however, does not prevent the issuance of submarine patents because it is too easy for applicants to avoid the double patenting rejection. In particular, an applicant could file a very general patent application with very few generic claims. As the industry develops, the applicant could then add new claims to pending continuation applications to cover the specific features which have now become valuable in the marketplace. Since those specific features did not appear in the few claims of the earlier patent, there can be no double patenting rejection. In this manner the applicant delays issuance of claims on each particular feature until the feature becomes commercially important.

### **\*609 III. Equity Should Bar Recovery For Infringement Where the Patentee Unreasonably Delayed the Prosecution of the Patent and Intervening Adverse Rights Exist**

Under the still-valid Supreme Court decision in *Webster Electric*, equity should bar recovery for patent infringement where the patentee unreasonably delayed the prosecution of the patent and adverse intervening rights exist. In *Webster Electric*, the Supreme Court analogized abuse of continuation practice to abuse of reissue practice and found that patent-in-suit to be unenforceable due to the patentee's unreasonable delay in prosecuting the patent. [FN62] The foundation for that analogy remains intact and the doctrine should be applied today to submarine patents.

#### **A. The Foundation Of The Reissue Analogy**

Reissue applications arose from Supreme Court precedent recognizing the need of patentees to correct mistakes which would unjustly deny them their rights under the patent laws. [FN63] The early cases encompassed only narrowing reissues. [FN64] Without explanation, however, the Supreme Court eventually permitted broadening reissues. [FN65]

The Patents Acts of 1832 and 1836 codified the power to reissue and specified the requirements for reissue as follows: (1) the original patent be "inoperative or invalid"; (2) the failure to comply with the patent laws be due to "inadvertence, accident or mistake, and without any fraudulent or deceptive intention"; and (3) the reissued patent be "for the same invention" as the original patent. [FN66] The Patent Act of 1870 added a prohibition on new matter. [FN67]

**\*610** In time, the Supreme Court began to permit broadening reissues. In *Miller v. Brass*, the Supreme Court described the initial purpose of reissues as follows:

It will be observed that [while] the law authorizes a reissue when the patentee has claimed too much, so as to enable him to contract his claim, it does not, in terms, authorize a reissue to enable him to expand his claim. The great object of the law of reissues seems to have been to enable a patentee to make the description of his invention more clear, and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. [FN68]

Several years after the enactment of the reissue statute, Congress enacted the requirement that the applicant "particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery." [FN69] Although it had been customary prior to that time to append a claim to most specifications, it was the first statutory requirement to do so. [FN70] The Supreme Court analyzed the issue of broadening reissues under this framework as follows:

Now, in view of the fact that a reissue was authorized for the correction of mistakes in the specification before a formal claim was required to be made, and of the further fact that when such formal claim was required express power was given to grant a reissue for the purpose of making a claim more narrow than it was in the original, without any mention of a reissue for the purpose of making a claim broader than it was in the original, it is natural to conclude that the reissue of a patent for the latter purpose was not in the mind of Congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the Patent

Office know the fact, that the constant struggle between the office and applicants for patents has reference to the claim. The patentee seeks the broadest claim he can get. The office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made. [FN71]

Thus, it came to be that applicants could broaden their patent claims through reissue.

Initially, no time limit existed for an applicant to file a broadening reissue. The statutes did not specifically mention broadening reissues and did not specifically mention any time limit on filing them. [FN72] \*611 Eventually, the Supreme Court recognized that applicants were abusing the process:

But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them. [FN73]

In response to the abuse and despite the absence of any such restriction in the statutory scheme, the Supreme Court began placing limitations on reissues.

The first restriction on broadening reissues was that of diligence. Stated concisely, the Supreme Court held:

The granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void. [FN74]

Thus, the courts, not Congress, imposed a diligence requirement on the filing of broadening reissues.

The two-year limitation on broadening reissues arose via the Supreme Court's analogy to the law of public use:

[W]hile no invariable rule can be laid down as to what is reasonable time within which the patentee should seek for the correction of a claim which he considers too narrow, a delay of two years, by analogy to the law of public use before an application for a patent, should be construed equally favorable to the public, and that excuse for any longer delay than that should be manifest by the special circumstances of the case. [FN75]

Later, Congress codified the two-year limitation. [FN76]

Today, reissue applications permit an applicant to correct errors made in a previously issued patent: a reissue application which seeks to enlarge the scope of an issued patent must be filed within two years after the patent issues while a reissue application which does not seek to broaden the coverage of a patent may be filed at any time. [FN77] This two year limitation in "[t]he reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights." [FN78]

\*612 The provisions of the patent statutes generally relating to applications apply to applications for reissue patents, and there may be more than one reissue patent for distinct and separate parts of the thing patented. [FN79] Thus, continuation, continuation-in-part, and divisional applications may be filed claiming priority to a reissue application. [FN80] The Federal Circuit described the specific effect of paragraphs 2 and 3 of the reissue statute as follows:

Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on [the patentee's] continuation reissue application than upon a continuation of an original application.. [FN81]

Thus, the Federal Circuit has clearly stated that the law that applies to traditional continuation applications equally applies to reissue continuation applications.

The two-year limitation on asserting claims broader than those in the original patent remains in effect with respect to divisional or continuation reissue applications. [FN82] In other words, an applicant may not submit broadened claims for the first time more than two years after the issuance of the original patent. [FN83] In *Graff*, the Federal Circuit considered this exact issue and reached the following conclusion:

On this case, the public had no notice that broadening was being sought until after the two-year period. We discern no justification for imposing this degree of uncertainty upon the public. [FN84]

The two-year limitation on the filing of broadened claims arises from the notice function of patent claims established by the requirements of 35 U.S.C. § 112. In particular, the primary purpose of the requirement in the patent laws that patent claims distinctly claim the subject matter the applicant considers to be his invention is "to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights." [FN85] In other words, patent claims serve the \*613 notice function of advising the public as to what is protected and what remains open to the public. [FN86]

#### B. The Notice Function And The Two Year Limitation On Broadening Patent Claims

Consistent with the notice function of the claims, the law is well-settled that "subject matter disclosed but not claimed in a patent application is dedicated to the public." [FN87] This principle dates back as far as the Supreme Court decision in *Miller v. Brass Co.* [FN88] and has been consistently reiterated and upheld by the Supreme Court for more than a hundred years. [FN89]

In *Miller*, the Supreme Court vigorously attacked a patentee's practice of enlarging the scope of a patent's claim many years after its issuance. [FN90] The Court recognized that if a patentee believes he is entitled to broader claims than those issued in the original patent, and uses due diligence in returning to the Patent Office, his application may be entertained and, upon a proper showing, broader claims may be issued. [FN91] "But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public \*614 of that which is not claimed." [FN92] To protect the public while at the same time permitting a patentee with due diligence to prosecute broader claims than in the original patent, the Court held that:

Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or reissue the patent for such cause. [FN93]

Thus, if a patentee desires to prosecute broader claims than those in the original patent, the patentee must do so with due diligence or lose any rights it may have to those broader claims.

These principles underlie the two-year time limit set forth in the reissue statute. "The purpose of the law that a broadening reissue must be applied for within two years after patent grant is to set a limited time after which the public may rely on the scope of the claims of an issued patent." [FN94] In other words, "no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent." [FN95]

[ The essence of the notice function is that, at some point in time, the public should be entitled to know the exact scope of the patent protection. Permitting a patentee to continuously alter or enlarge the scope of the patent protection completely frustrates this function.

#### C. Analogizing Continuation Practice to Reissue Practice

The Supreme Court has applied this principle, by analogy, to invalidate divisional and continuation applications. [FN96] The analogy has a sound logical foundation because the use of continuation and divisional applications to indefinitely delay the filing of broadening claims circumvents the purpose and spirit of the statutes. [FN97] In particular, if \*615 continuation and divisional applications may be used to submit broadened claims for an indefinite period of time after the issuance of the first patent, there can be no finality or certainty of patent rights. [FN98] Thus, the public interest in finality and certainty is completely frustrated.

The Supreme Court set forth the foundation for the analogy in its still-valid decisions in *Miller* and *Webster Electric*.

### 1. The *Miller v. Brass Co.* Decision

In *Miller v. Brass Co.*, the Supreme Court considered the validity of a broadening reissue patent filed fifteen years after the issuance of the original patent. [FN99] The Court found diligence, or the lack thereof, to be the key issue:

If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in returning to the Patent Office, and says "I omitted this," or "my solicitor did not understand that," his application may be entertained, and, on a proper showing, correction may be made. But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or reissue the patent for such cause. [FN100]

The Court continued on to consider the practice of altering a patent after others in the industry have produced new forms of improvement:

It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms. Such a process of expansion carried \*616 on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights, and sleeps upon them, justly loses them. [FN101]

Thus, the Supreme Court found that the practice of continuously altering the scope of a patent to cover developing commercial applications was wholly inappropriate when the patentee had unreasonably delayed in presenting its claims to the patent office.

[The condemned practice in *Miller* should be distinguished from the practice of writing claims to cover competitors' products when no unreasonable delay has occurred. Such practice is entirely proper and has been upheld by the Federal Circuit. [FN102] Therefore, the key to the *Miller* decision is the unreasonableness of the applicant's delay in the prosecution, not the writing of claims to cover competitors' products.

### 2. The *Webster Electric* Decision

The facts in *Webster Electric Co. v. Splitdorf Electric Co.* evidenced a long history of continuation and divisional applications. [FN103] The patentee, Kane, filed his first patent application in 1910. [FN104] A patent covering the same subject matter issued to the Podlesaks in 1913, and a reissue patent was also granted in 1915. [FN105] Later in 1915, Kane filed a divisional application which copied the claims of the Podlesak patent, thereby invoking an interference which the Podlesaks eventually won. [FN106] In 1916, Kane was issued a patent on his first application. Thereafter, in June, 1918, Kane amended his divisional application to recite new claims which were allowed and issued into the patent-in-suit in September 1918. [FN107] The claims that issued in 1918 "were for the first time presented to the Patent Office, by an amendment to a divisional application eight years and four months after the filing of the original application, [and] five years after the date of the original Podlesak patent. . . ." [FN108]


\*617 In a later case, the Supreme Court summarized its findings in *Webster Electric* as follows:

[W]e found that Kane, deeming their subject matter not invention, did not intend to assert them, and, prior to 1918, did not entertain an intention to have them covered by patent. During all of this time their subject matter was disclosed and in general use; Kane and his assignee simply stood by and awaited developments. It was upon the reasons so stated that this Court declared "We have no hesitation in saying that the delay was unreasonable, and, under the circumstances shown by the record, constitutes laches, by which the petitioner lost whatever rights it might otherwise have been entitled to." [FN109]



The Supreme Court stated its ultimate conclusion in Webster Electric as follows:

Our conclusion, therefore, is that in cases involving laches, equitable estoppel or intervening private or public rights, the two-year time limit prima facie applies to divisional applications and can only be avoided by proof of special circumstances justifying a longer delay. In other words, we follow in that respect the analogy furnished by the patent reissue cases. [FN110]

Therefore, the Webster Electric decision implies that the two-year limitation of reissues applies to divisional and continuation applications. 


### 3. The Crown Cork & Seal Decision: Limiting Webster Electric to Cases of Intervening Adverse Rights

In Crown Cork & Seal Co. v. Ferdinand Gutman Co., the Supreme Court upheld Webster Electric, but limited its scope by distinguishing it from the stated facts. In particular, the Court in Crown Cork addressed the question:

Does this Court's decision in Webster Electric Co. v. Splitdorf Co. mean that, even in the absence of intervening adverse rights, an excuse must be shown for a lapse of more than two years in presenting claims in a divisional application regularly filed and prosecuted in accordance with patent office rules? [FN111]

The Court answered the question in the negative by finding that absent adverse intervening rights, the patentee need not show an excuse for a lapse of more than two years in presenting new claims in a divisional application. [FN112] The Crown Cork Court refused to shift the burden of proof \*618 to the patentee merely because the delay exceeded two years. The Court did not overrule Webster Electric. However, in dicta, it limited Webster Electric to cases in which intervening adverse rights and some evidence of abandonment exists. The Supreme Court later implicitly recognized that adverse intervening rights can render divisional and continuation applications invalid. [FN113]

### 4. Interpreting Webster Electric After Crown Cork & Seal

 The Webster Electric court used the terminology "intervening adverse rights" in the context of its analogy to the reissue cases. Thus, one must consult the reissue cases decided contemporaneous with and prior to Webster Electric to determine the proper meaning of that terminology. Upon doing so, it is abundantly clear that "adverse intervening rights" arise from public uses, manufactures or sales of products, and are not limited to interfering patents. [FN114] The inclusion of public uses and sales as giving rise to "intervening adverse rights" is further evident from the Court's decision in Muncie Gear Works v. Outboard, Marine & Mfg. Co. [FN115] The Court in Muncie characterized the difference between the date on which an invention is used in public by an unauthorized user as opposed to an authorized user as "critical." [FN116] Therefore, the rights must be "interfering," i.e., arising before the applicant presents the broadened claim to the patent office, and must be "adverse," i.e., without authorization of the patentee.

The foundation for the Supreme Court's decision in Webster Electric remains on solid ground. In particular, the Supreme Court based the decision in Webster Electric on an analogy to the law applying to reissue applications. That Supreme Court law applying to reissues has now been codified establishing a strict rule that broadened claims may not be filed in a reissue more than two years after the issuance of the original patent.

### \*619 IV. The Federal Circuit Has Implicitly Recognized The Webster Electric Defense

The Federal Circuit has acknowledged Webster Electric type defenses in dicta on two occasions, most recently in Stark v. Advanced Magnetics, Inc. [FN117] The court in Stark considered the issue of whether an inventor who is excluded from a patent must act diligently in seeking correction of inventorship. Although the issue in Stark is different than inequitable delay, the Federal Circuit's dicta relating to diligence generally is enlightening. [FN118] The Federal Circuit addressed lack of diligence generally as follows:

Lack of diligence may be an appropriate basis for barring legal action when there is an affirmative obligation on the claimant to act promptly and without significant pause in establishing a legal right. The common law has recognized that varying degrees of diligence may be required, depending on the circumstances. For example, a higher degree of diligence is appropriate when the claimant is



chargeable with injury or disadvantage to another due to the claimant's failure to act expeditiously . . . .  
[FN119]

The Federal Circuit concluded that there are circumstances where diligence is an appropriate requisite to pursuit of a particular legal right, whether or not the defense of laches or estoppel may be invoked against the claimant. [FN120]

Unquestionably, the Stark decision leaves the door open to general equitable defenses arising from lack of diligence or unreasonable delay. The Federal Circuit tied the significance of the lack of diligence to the injury a delay may cause to others. [FN121] With respect to the correction of inventorship, the court specifically noted that the statutes and regulations did not require diligence. [FN122] However, the court held that "[w]hether diligent action is required in a particular case must be determined on the facts of that case." [FN123] Thus, despite the absence of a statutory or regulatory time limitation, the Federal Circuit mandated case by case consideration of the diligence requirement. [FN124]

**\*620** Unreasonable delay in the prosecution of a patent likewise should be the subject of case by case consideration by the court. Where intervening adverse rights exist, as was the case in Webster, the case for an equitable remedy is strong. More specifically, the injury likely to occur to others due to an applicant's unreasonable delay is great. As noted by the Federal Circuit in Stark:

[T]he graver, more important, or valuable the interests involved, and the more imminent the peril, the more is the vigilance required to constitute diligence. [FN125]

The graveness of the injury to others when a submarine patent issues years after entire industries have adopted a particular technology cannot be understated. On the other hand, if no intervening adverse rights exist, the likely injury to others is minimal. Thus, one can see the importance of adverse intervening rights under the Federal Circuit's general test for equitable remedies based on lack of diligence.

The second Federal Circuit decision recognizing this type of defense is Studiengesellschaft Kohle mbH v. Northern Petrochemical Company. [FN126] In that case, the Federal Circuit addressed a defense that the patentee was guilty of laches or other inequitable delay in the prosecution of the patent-in-suit. The Federal Circuit did not state that no such claim exists. Instead, it evaluated the delay and found that responsibility for the delay rested with the PTO's interference procedures rather than any actions of the patentee. Accordingly, the Federal Circuit stated:

[W]e discern no error in the conclusion that SGK had not delayed inequitably and that the prolonged period of pendency was due to the PTO and not the applicants. [FN127]

Based on these two Federal Circuit decisions, the Federal Circuit may be receptive to a Webster Electric argument. It is worth noting that the Federal Circuit has never cited Crown Cork, but it has cited Webster Electric for the exact proposition set forth in this paper: "[N]o one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent . . . ." [FN128]

#### **\*621 V. Ford Motor Company v. Lemelson: an Extraordinary Misreading of Webster Electric**


The recent decision from the District Court for the District of Nevada in Ford Motor Company v. Lemelson, [FN129] does not diminish the significance or applicability of Webster Electric to unreasonable prosecution delays when adverse intervening rights exist. As a preliminary matter, the decision in Ford Motor Co. is simply wrong. The court in Ford Motor Co. based its decision on the assumption that Webster Electric is limited to interferences. [FN130] That assumption is clearly incorrect. Webster Electric was not a decision on an appeal from an interference decision. It was an appeal from a decision in a lawsuit for infringement of a patent. [FN131] As such, it cannot possibly be limited to interferences.

The Nevada court apparently was confused by the reference in Webster Electric and Crown Cork to "adverse intervening rights." That language cannot mean that there must be an interference because no interference existed in Webster Electric. Rather, it references the rights of another which arise after the filing of the first patent application, but before the broadened claims are added to the continuation or divisional application. The concept of intervening rights is well known in the reissue context, and in view of Webster Electric's explicit analogy to reissue, it is clear that the reference to "adverse intervening rights" is a reference to reissue-type intervening rights rather than a reference to an interference.

This interpretation of the meaning of adverse intervening rights is supported by the notice function of patents. In particular, the public has an undeniable interest in the finality and certainty of patent rights. [FN132] Once a patent issues, and after a reasonable amount of time, the public should be able to rely on the fact that "subject matter disclosed but not claimed in a patent application is dedicated to the public." [FN133] Where a sufficient amount of time has passed due to an applicant's unreasonable delay, the public should be permitted to practice unclaimed subject matter disclosed in an issued patent.

**\*622** The Nevada district court's confusion may in part have been caused by a well-known treatise on patent law. [FN134] The treatise confuses the facts of *Chapman v. Wintroath*, [FN135] an early Supreme Court decision relating to interferences, with the facts of *Webster Electric* and concludes that *Webster Electric* has been codified in 35 U.S.C. § 135(b), which relates only to interferences.

The *Chapman* case considered the issue of whether an applicant for a patent may copy the claims of an issued patent twenty months after the issuance of the patent to provoke an interference in the patent office. The Supreme Court found that the applicant could copy the claims of the issued patent under the facts of the case, but it seemed to assume the validity of applying the two-year statutory period for filing claims conflicting with an issued patent.



In the Act of 1939, Congress dealt expressly with the interference problem considered in *Chapman* by providing that no application may be amended to add a claim "for the same or substantially the same subject matter" as a claim of an issued patent more than one year from the date the patent issued. [FN136] That statute does not apply as a defense in an infringement lawsuit. It is limited to interferences and, thus, cannot possibly codify the holding of *Webster Electric*, which did not involve an interference.

The treatise incorrectly groups *Chapman* and *Webster Electric* together as being codified by 35 U.S.C. § 135(b) and concludes that "[p]ossible implications of *Webster Electric* outside the interference context were dispelled by the Supreme Court in *Crown Cork & Seal v. Ferdinand Gutmann Co.*" [FN137] That conclusion ignores the express language of the *Crown Cork* decision itself:

It is clear that, in the absence of intervening adverse rights, the decision in *Webster Electric v. Splitdorf Co.* does not mean that an excuse must be shown for a lapse of more than two years in presenting the divisional application. [FN138]

The *Crown Cork* decision unequivocally states "in the absence of adverse intervening rights." It does not limit *Webster Electric* to interferences.

In any event, the misconception in the treatise polluted the district court's analysis in *Ford Motor Co.* That mistaken confusion between "interferences" and "adverse intervening rights" should not be continued.

#### **\*623 VI. Conclusion**

The Federal Circuit has acknowledged that general equitable remedies relating to lack of diligence exist in patent cases. In view of the Supreme Court's decision in *Webster Electric* and its own decisions in *Stark* and *Studiengesellschaft*, the Federal Circuit should recognize inequitable delay as an equitable defense when intervening adverse rights exist.

With respect to the two-year limitation on broadening reissues, that limitation clearly should not apply as a mechanical limitation of continuation and divisional applications. Courts have repeatedly rejected such mechanical time limitations. [FN139] Perhaps instead of serving as a time limitation on continuation and divisional applications, the two-years should serve as a limitation on the doctrine of inequitable delay, i.e., a prosecution delay less than two years cannot be unreasonable.

Regardless of the applicability of the two-year limitation on reissues, courts should consider and apply the defense of inequitable delay in appropriate cases.

FNa1. Of Counsel, Arnold & Porter in Washington, D.C.

FN1. *Miller v. Brass Co.*, 104 U.S. 350 (1881).

FN2. *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463 (1924).

FN3. See *infra*, footnote 134 and accompanying text.

FN4. 40 U.S.P.Q.2d (BNA) 1349, 1362 (D. Nev. 1996), on reconsideration, 42 U.S.P.Q. (BNA) 1706 (D. Nev. 1997), appeal denied, 124 F.3d 227 (Fed. Cir. 1997).

FN5. 264 U.S. 463 (1924).

FN6. Jerome Lemelson is possibly the most notorious patentee in history, being a party in cases resulting in no fewer than fifty-four (54) published decisions.

FN7. Lemelson, 40 U.S.P.Q.2d 1349 (D. Nev. 1996).

FN8. *Id.* at 1350.

FN9. *Id.* at 1350-1351.

FN10. *Id.* at 1353.

FN11. *Id.* at 1354.

FN12. *Id.*

FN13. *Id.*

FN14. *Id.*

FN15. *Id.*

FN16. *Id.*

FN17. *Id.* (quoting Henry L. McClintock, *Handbook on the Principles of Equity* 52 (2d ed. 1948)).

FN18. *Id.* at 1354-55.

FN19. *Id.* at 1355 (citing 1 Dan B. Dobbs, *Law of Remedies*, § 2.4(4) (2d ed. 1993).

FN20. *Id.*

FN21. Inequitable conduct refers to an equitable defense that renders patents unenforceable when the applicant fails to disclose material information during the prosecution of the patent with an intent to deceive the patent office. *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178, 33 U.S.P.Q.2d (BNA) 1823, 1826-27 (Fed. Cir. 1995).

FN22. File wrapper estoppel limits the application of the doctrine of equivalents by binding the applicant to limitations which were made more specific or added to the claims in response to a rejection issued by the patent examiner during the prosecution of the patent application. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136, 52 U.S.P.Q. (BNA) 275, 279 (1942).

FN23. *Ford Motor Co.*, 40 U.S.P.Q.2d at 1355.

FN24. *Advanced Cardiovascular Sys. v. Medtronic, Inc.*, 41 U.S.P.Q.2d (BNA) 1770, 1774-75 (N.D. Cal. 1996).

FN25. *Id.*

FN26. 960 F.2d 1020, 22 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1992).

FN27. *Id.* at 1032, 22 U.S.P.Q.2d at 1328.

FN28. *Id.* at 1037, 22 U.S.P.Q.2d at 1333.

FN29. Advanced Cardiovascular Sys., 41 U.S.P.Q.2d at 1774.

FN30. Ford Motor Co., 40 U.S.P.Q.2d at 1356-7.

FN31. 784 F.2d 351, 228 U.S.P.Q. (BNA) 837 (Fed. Cir. 1986).

FN32. Id. at 356, 228 U.S.P.Q. at 841.

FN33. Id.

FN34. Id. at 357, 228 U.S.P.Q. at 842.

FN35. 304 U.S. 159 (1938).

FN36. 264 U.S. 463 (1924).

FN37. Id. at 465-6.

FN38. Crown Cork & Seal Co., 304 U.S. at 168.

FN39. Ford Motor Co., 40 U.S.P.Q.2d at 1358-61.

FN40. Id. at 1350.

FN41. Ford Motor Co., 42 U.S.P.Q.2d at 1711.

FN42. Id. at 1708.

FN43. Id. at 1708.

FN44. The district court cited a Federal Circuit decision that dealt exactly with a proposed arbitrary limit to the length of a patent issuing from a continuation. Studiengesellschaft Kohle mbH, 784 F.2d 351, 228 U.S.P.Q. 837 (Fed. Cir. 1986).

FN45. 35 U.S.C. §§ 120, 121, 251.

FN46. 35 U.S.C. § 120.

FN47. 35 U.S.C.A. § 120, note 4 (West 1984).

FN48. 35 U.S.C. § 121.

FN49. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279-80, 23 U.S.P.Q.2d (BNA) 1839, 1845 (Fed. Cir. 1992); Stark v. Advanced Magnetics, Inc., 29 F.3d 1570, 1576, 31 U.S.P.Q.2d (BNA) 1290, 1296 (Fed. Cir. 1994) ("We take judicial notice that multiple patents are not permitted on the same invention, and that there must be differences among the six patents.").

FN50. Ortho Pharm. Corp. v. Smith, 959 F.2d 936, 943, 22 U.S.P.Q.2d (BNA) 1119, 1125 (Fed. Cir. 1992); General Foods Corp., 972 F.2d at 1277-78, 23 U.S.P.Q.2d at 1843.

FN51. In re Longi, 759 F.2d 887, 892, 225 U.S.P.Q. (BNA) 645, 648 (Fed. Cir. 1985); Carman Indus., Inc. v. Wahl, 724 F.2d 932, 940, 220 U.S.P.Q. (BNA) 481, 487 (Fed. Cir. 1983).

FN52. 35 U.S.C. § 101.

FN53. Longi, 759 F.2d at 892, 225 U.S.P.Q. at 648; Ortho Pharm., 959 F.2d at 940, 22 U.S.P.Q.2d at 1123.

FN54. Carman Indus., 724 F.2d at 940, 220 U.S.P.Q. at 487.

FN55. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 U.S.P.Q. (BNA) 678, 681 (Fed. Cir. 1986).

FN56. *Longi*, 759 F.2d at 892, 225 U.S.P.Q. at 648.

FN57. *Id.*

FN58. *Ortho Pharm.*, 959 F.2d at 940, 22 U.S.P.Q.2d at 1123.

FN59. *Id.*, 22 U.S.P.Q.2d at 1123; *Longi*, 759 F.2d at 894, 225 U.S.P.Q. at 649.

FN60. *Quad Envtl. Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 U.S.P.Q.2d (BNA) 1392, 1394 (Fed. Cir. 1991)

FN61. *Id.*, 20 U.S.P.Q.2d at 1394; *Ortho Pharm.*, 959 F.2d at 941-42, 22 U.S.P.Q.2d at 1124 (citing *Quad Envtl. Tech. Corp.*).

FN62. *Webster Elec. v. Splitdorf Elec. Co.*, 264 U.S. 463, 466-8 (1924).

FN63. The Patent Acts of 1790 and 1793 contained no statutory provision authorizing the reissue of a defective patent. The Supreme Court first recognized an inherent power to reissue in *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 229 (1832).

FN64. *Philadelphia & Trenton R.R. Co. v. Stimpson*, 39 U.S. (14 Pet.) 448, 449 (1840); *Stimpson v. West Chester R.R. Co.*, 45 U.S. (4 How.) 380, 382 (1846); *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 82-3 (1853).

FN65. Compare *Battin v. Taggart*, 58 U.S. (17 How.) 74, 84 (1854), and *Morey v. Lockwood*, 75 U.S. (8 Wall.) 230, 240-1 (1868), with *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 575 (1863), and *Case v. Brown*, 69 U.S. (2 Wall.) 320, 328 (1864).

FN66. Act of July 3, 1832, ch. 162, § 3, 4 Stat. 559.

FN67. Act of July 8, 1870, ch. 230, § 53, 16 Stat. 198.

FN68. 104 U.S. 350, 353.

FN69. *Id.* at 354.

FN70. *Id.*

FN71. *Id.*

FN72. Act of July 3, 1832, ch. 162, §§ 3, 4 Stat. 559; Act of July 8, 1870, ch. 230, § 53, 16 Stat. 198.

FN73. *Miller*, 104 U.S. at 354-355.

FN74. *Id.* at 355.

FN75. *Ives v. Sargent*, 119 U.S. 652, 662 (1887).

FN76. 35 U.S.C. § 251.

FN77. *Id.*

FN78. *In re Graff*, 111 F.3d 874, 877, 42 U.S.P.Q.2d (BNA) 1471, 1474 (Fed. Cir. 1997).

FN79. 35 U.S.C. § 251[2-3]; *Id.* at 876, 42 U.S.P.Q.2d at 1473.

FN80. *Graff*, 111 F.3d at 876, 42 U.S.P.Q.2d at 1473.

FN81. *Id.* at 877, 42 U.S.P.Q.2d at 1473.

FN82. *Id.*

FN83. *Id.*

FN84. *Id.*, 42 U.S.P.Q.2d at 1473-74.

FN85. *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581, 37 U.S.P.Q.2d (BNA) 1365, 1372 (Fed. Cir. 1996) (quoting *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)).

FN86. *McClain v. Ortmayer*, 141 U.S. 419, 424, (1891) ("The object of the patent law in requiring the patentee [to distinctly claim his invention] is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them."); *Athletic Alternatives*, 73 F.3d at 1581, 37 U.S.P.Q.2d at 1372 ("Where there is an equal choice between a broader and a narrower meaning of a claim, . . . we consider the notice function of the claim to be best served by adopting the narrower meaning."); *Hoganas AB v. Dresser Indus. Inc.*, 9 F.3d 948, 951, 28 U.S.P.Q.2d (BNA) 1936, 1939 (Fed. Cir. 1993) (holding that the function of claims is "putting competitors on notice of the scope of the claimed invention."); *Rengo Co. Ltd. v. Molins Mach. Co.*, 657 F.2d 535, 551, 211 U.S.P.Q. (BNA) 303, 321 (3d Cir. 1981) ("[The claim's] purpose is to demarcate the boundaries of the purported invention, in order to provide notice to others of the limits 'beyond which experimentation and invention are undertaken at the risk of infringement.'") (quoting *Norton Co. v. Bendix Corp.*, 449 F.2d 553, 555, 171 U.S.P.Q. (BNA) 449, 450 (2d Cir. 1971)).

FN87. *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106, 39 U.S.P.Q.2d (BNA) 1001, 1006 (Fed. Cir. 1996) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 19 U.S.P.Q.2d 1500 (Fed. Cir. 1991)).

FN88. 104 U.S. 350 (1881).

FN89. See, e.g., *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 85 U.S.P.Q. (BNA) 328 (1950).

FN90. 104 U.S. at 355.

FN91. *Id.* at 352.

FN92. *Id.*

FN93. *Id.*

FN94. *In re Fotland*, 779 F.2d 31, 33, 228 U.S.P.Q. (BNA) 193, 194 (Fed. Cir. 1985).

FN95. *Graff*, 111 F.3d at 877, 42 U.S.P.Q.2d at 1474 (quoting *Wollensak v. Reiher*, 115 U.S. 96, 100 (1885)); accord *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 467-68 (1924).

FN96. See, e.g., *Webster Elec.*, 264 U.S. at 470-71.

FN97. See, e.g., *Woodbridge v. U.S.*, 263 U.S. 50, 56 (1923) ("Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim."); *Kendall v. Windsor*, 62 U.S. (21 How.) 322, 329 (1858) ("It is the unquestionable right of every inventor to confer gratuitously the benefits of his ingenuity upon the public, and this he may do either by express declaration or by conduct equally significant with language -such, for instance, as an acquiescence with full knowledge in the use of his invention by others; or he may forfeit his rights as an inventor by a willful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others.").

FN98. Compare *Graff*, 111 F.3d at 877, 42 U.S.P.Q.2d at 1474, with *Woodbridge*, 263 U.S. at 56.

FN99. At the time of the *Miller v. Brass Co.* decision, the original patent term was fourteen years and could be extended an additional seven years.

FN100. 104 U.S. at 352.

FN101. *Id.* at 355.

FN102. *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874, 9 U.S.P.Q.2d (BNA) 1384, 1390 (Fed. Cir. 1988) (It is not "improper to amend or insert claims intended to cover a competitor's product the applicant's attorney has learned about during the prosecution of a patent application.").

FN103. 264 U.S. 463 (1924).

FN104. *Id.* at 463-64.

FN105. *Id.*

FN106. *Id.*

FN107. *Id.*

FN108. *Id.* at 465.

FN109. *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159, 166 (1938) (citations omitted).

FN110. *Webster Electric*, 264 U.S. at 471.

FN111. *Crown Cork*, 304 U.S. at 160-61 (citations omitted).

FN112. *Id.* at 167-68.

FN113. *General Talking Pictures Corp. v. Western Elec. Co.*, 304 U.S. 175, 183 (1938), reh'g granted, 304 U.S. 587 (1938) ("In the absence of intervening adverse rights for more than two years prior to the continuation applications, they were in time.").

FN114. See *Keller v. Adams-Campbell Co.*, 264 U.S. 314, 317 (1924); *Abercrombie & Fitch Co. v. Baldwin*, 245 U.S. 198, 209-10 (1917).

FN115. 315 U.S. 759, 53 U.S.P.Q. (BNA) 1 (1942).

FN116. *Id.* at 767, 53 U.S.P.Q. at 5.

FN117. 29 F.3d 1570, 1576, 31 U.S.P.Q.2d (BNA) 1290, 1294 (Fed. Cir. 1994).

FN118. *Id.* at 1574, 31 U.S.P.Q.2d at 1292-93.

FN119. *Id.*

FN120. *Id.*

FN121. *Id.* at 1575, 31 U.S.P.Q.2d at 1294.

FN122. *Id.*; see also 37 C.F.R. § 1.324.

FN123. 29 F.3d at 1575, 31 U.S.P.Q.2d at 1294.

FN124. *Id.*

FN125. *Id.* at 1574, 31 U.S.P.Q.2d at 1293 (quoting 26A C.J.S.Diligence at 943-44 (1956)).

FN126. 784 F.2d 351, 228 U.S.P.Q. (BNA) 837 (Fed. Cir. 1986).

FN127. *Id.* at 356, 228 U.S.P.Q. at 841.

FN128. *In re Fotland*, 779 F.2d 31, 33, 228 U.S.P.Q. (BNA) 193, 194 (Fed. Cir. 1985).

FN129. 42 U.S.P.Q.2d 1706 (D. Nev. 1997), appeal denied, 124 F.3d 227 (Fed. Cir. 1997).

FN130. *Id.* at 1710.

FN131. *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463, 464, ("The bill alleges that the Splitdorf Electrical Company had infringed claims 7 and 8 of Kane patent, 1,280,105 . . .").

FN132. *In re Graff*, 111 F.3d 874, 877, 42 U.S.P.Q.2d (BNA) 1471, 1474 (Fed. Cir. 1997).

FN133. *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106, 39 U.S.P.Q.2d (BNA) 1001, 1006 (Fed. Cir. 1996).

FN134. See 4 Donald S. Chisum, *Patents*, § 11.05[1][b], 11-263 (1997).

FN135. 252 U.S. 126 (1920).

FN136. See 35 U.S.C. § 135(b).

FN137. Chisum, *supra* note 134, at 11-264.

FN138. *Crown Cork*, 304 U.S. 159, 167-168 (1938) (emphasis added).

FN139. *Id.* at 161.



Art Unit:

**APPENDIX VII:** (*The State of the TV Art On and Before 1981*).

Art Unit:

**The following discussion has been provided to establish the level of skill in the art which existed at the time of applicant's alleged invention and, therefor, to set forth the context in which the applied prior art of record must be viewed.**

I. The examiner notes that local television broadcast stations, which served small regional areas of a country (e.g. the USA), often lacked the financial resources required to create enough original television programming to fill their daily broadcast schedules. Thus, these local television stations became "*affiliates*" of a national television broadcast network (e.g. NBC, ABC, CBS, etc,...) whereby the national television network created original network television programming which could be transmitted to, and commonly rebroadcast by, all of the local affiliate stations <sup>107</sup>. This arrangement allowed the cost of creating such original programming to be divided among all of the affiliate stations thereby reducing the cost to any one of the affiliates. <sup>108</sup>

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<sup>107</sup> The examiner notes that the existing national *radio* networks/companies naturally evolved into the national *television* networks/companies because the existing radio infrastructure which functioned to create and distribute radio programming could be extended and applied quite naturally to the creation and distribution of television programming. Thus, when applicant argues that one skilled in the art would not have understood that TV and Radio distribution systems are analogous arts, applicant is doing nothing less than ignoring "HISTORY", i.e. once again applicant's arguments are so wide of the mark that they seem nothing less than silly/absurd.

<sup>108</sup> SEE the first 23 lines in the second full paragraph on page 85 of the article "Master Control Techniques" by Marsden which was published in volume 9 of the "Journal of the Television Society" in 1959.

Art Unit:

2. While in practice it was feasible to fill the affiliate stations' entire local broadcast schedules with network programming, such was not desirable. Specifically, there still remained a need to supplement said network programming with locally originated programming tailored specifically to the needs and interests of the local audiences (e.g. local news programs, local commercials, etc,...). <sup>109</sup>
3. To accomplish the above, an arrangement was established in which a national broadcast station would nationally broadcast network programming to all of its affiliate stations in accordance with a strict network broadcast schedule. This strict network broadcast schedule included scheduled "breaks"/"AVAILS" in the network programming which were then made available to the local affiliate stations for the purpose of inserting locally originated programming. <sup>110</sup> This locally originated programming was known to have included previously broadcasted

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<sup>109</sup> Note: the first 23 lines in the second full paragraph on page 85 of the article "Master Control Techniques" by Marsden which was published in volume 9 of the "Journal of the Television Society" in 1959.

Note: lines 2-9 in the second column on page 806 of the article "The Automation Of Small Television Stations" by Young et al. which was published in volume 80 of the "Journal of the SMPTE" in October of 1971.

<sup>110</sup> Note: the last 11 lines on page 810 of the article "The Automation Of Small Television Stations" by Young et al. which was published in volume 80 of the "Journal of the SMPTE" in October of 1971.

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network programming which had been recorded for delayed rebroadcast.<sup>111</sup> The resulting combined programming was then broadcast to the local audiences the affiliate stations.

4. Early on, the local affiliate stations produced and inserted their own local programming into the network programming via a switching network which was controlled manually. However, as technology progressed, methods for automating various aspects of the program insertion/switching process developed. Such developments included:

1) The development of automatic scheduling computers which could be programmed to execute a list of scheduled programming events whereby the list of events automatically controlled the sequence in which scheduled programming was produced and broadcasted from a respective broadcast. Such computers were used to automate both the network television stations and affiliate television stations.<sup>112</sup>

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<sup>111</sup> SEE: lines 25-41 in column 4 of U.S. Patent # 4,025,851 to Haselwood et al. which was published on 5/24/77.

<sup>112</sup> Note: the last 11 lines on page 810 of the article "The Automation Of Small Television Stations" by Young et al. which was published in volume 80 of the "Journal of the SMPTE" in October of 1971.

Note: U.S. Patent # 3,761,888 to Flynn which was published on 9/25/73.

Note: U.S. Patent # 3,627,914 to Davies which was published on 12/14/71.

Note: the publication "Microprocessor For CATV Systems" by Tunmann et al. Which was published by the Tele-

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2) The development of automated program cuing systems which included: equipment located at the national network for embedding cuing signals into the broadcasted network programming whereby said cuing signals identified the beginning and the end of each scheduled "break" in network programming; and equipment located at the affiliate stations which used the embedded cuing signals to determined the respective beginning and the respective end of each scheduled network "break" and, based on this determination, automatically cause its own scheduled local programming to be inserted into said "breaks" prior to "*rebroadcast*".<sup>113</sup>

5. Because ones of the affiliate stations were located in different time zones, equipment was required to compensate the broadcasted network programming for these time zone differences; i.e. if the same network programming was to be broadcasted at the same local time throughout the entire country. This compensation was accomplished by delaying the broadcasted network programming which was provided to a given one of the affiliate stations, via a network of recording devices, as a function of the time zone in which the given affiliate station was located. Early on, due to the high cost of this delay

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Engineereing Corp on 4/30/1978.

<sup>113</sup> SEE: Australian Patent Document S.N. 074,619 by Hetrich which was published 4/29/1976.

SEE: U.K Patent Document S.N. 959,374 by Germany which was published 5/27/1964.

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equipment, compensation was provided only at the central network station.<sup>114</sup> But subsequently, as the cost of the delay equipment came down and as the use of highly expensive satellite transmission paths increased, said delay equipment began be located within ones of the affiliate station locations.<sup>115</sup> In any event, when network programming was delayed in this manner, it was understood that any “program related data” that was carried with the network programming (e.g. such as the network cuing signals; network program monitoring codes; etc,...) also had to be delayed by the delay equipment in order to have maintained their precise timing relationship with said network programming.<sup>116</sup>

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<sup>114</sup> Note: the article “Automatic Control of Video Tape Equipment at NBC, Burbank” by Byloff which was published by the National Broadcasting Company, Inc. in 1959.

<sup>115</sup> SEE: the publication “Video Banks Automate Delayed Satellite Programming” by Chiddix which was published in 1978.

SEE: the publication “The Digitrol 2~ Automatic VTR Programme Control” by Skilton which was published on pages 60-61 of the “International Broadcast Engineer” in march of 1981.

Note: lines 25-41 in column 4 of U.S. Patent # 4,025,851 to Haselwood et al. which was published on 5/24/77.

<sup>116</sup> SEE: the first 7 lines in the first full paragraph of the third column on page 39 of the publication “Video Banks Automate Delayed Satellite Programming” by Chiddix which was published in 1978.

Note: U.S. Patent # 4,025,851 to Haselwood et al. which was published on 5/24/77.

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The following discussion has been provided to further address the state of the television/radio broadcast art which existed at the time of applicant's alleged invention and, therefor, to further exemplify the context in which the applied prior art of record must be viewed. Support for the following discussion was derived from: 1) the publication "System and Apparatus for Automatic Monitoring Control of Broadcast Circuits" by *Yamane et al.*; 2) the Australian Patent document No. 74,619 to *Hetrich*; 3) the publication "The Vertical Interval: A General-Purpose Transmission Path" by *Anderson*; 4) the British patent document No. 959,274 to *Germany*; and "APPENDIX IV" of this Office action.

A) Contrary to the arguments presented by applicant in related applications (e.g. S.N. 113,329)<sup>117</sup>, it is maintained that the body of art pertaining to the broadcast of television programming the body of art pertaining to the broadcast of radio programming were, and still are, analogous arts. To suggest otherwise is to

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<sup>117</sup> The examiner notes that application S.N. 113,329 has already been cited in the record and therefor its citation by the examiner herein is not prohibited.

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portray an unrealistically low level of skill in the art <sup>118</sup>. The following facts have been cited to show/exemplify the analogous nature of these two arts:

1. First, it is noted that radio programming and television programming were communicated through radio and television distribution networks in the same basic way/format. More specifically, both radio/television distribution networks operated to produce, sequence and distribute radio/television programming to a plurality of household radio/television receivers based on predetermined radio/television broadcast schedules. In fact, the definition of the word *program*, as it pertains to the broadcast environment, was/is: "a scheduled radio or television show".

2. By the fact that the actual configurations of the radio and television networks themselves mirrored each other element for element. For example, both systems comprised national/network stations and affiliated local/regional stations wherein the local/regional stations operated to

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<sup>118</sup> The examiner notes that the existing national *radio* networks/companies naturally evolved into the national *television* networks/companies because the existing radio infrastructure which functioned to create and distribute radio programming could be extended and applied quite naturally to the creation and distribution of television programming. Thus, when applicant argues that one skilled in the art would not have understood that TV and Radio distribution systems are analogous arts, applicant is doing nothing less than ignoring "HISTORY"; i.e. once again applicant's arguments are so wide of the mark that they seem nothing less than silly/absurd. [note: the last 5 lines of the first paragraph of the Article "Versatile Transmission Video Facilities at NBC New York" by Mausler (page 811 of SMPTE Journal, Volume 85, October 1976 )



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selectively rebroadcast network programming, or to broadcasted locally produced programming in place of the network programming, to said household receivers. Almost the only difference between the configurations of the radio and television networks was that the circuitry needed to implement the television network was of a greater bandwidth than that of the radio network (e.g. the television network used VTRs in places where the radio network used ATRs);

3. By the fact that the prior art of record shows that, at the time of applicant's alleged invention, those of ordinary skill in the art themselves understood radio/television distribution networks to be "analogous arts". For example, this fact is clearly reflected in the teaching of Hetrich that his disclosed control signal distribution circuitry, while described in detail with respect to radio broadcast networks, could likewise have been used within television broadcast networks [SEE: the first 4 lines on page 2 of the Hetrich document].

B) Television and radio broadcast networks, which comprised a plurality of local/regional broadcast stations affiliated with a respective central/national broadcast station, were notoriously well known in the art at the time of applicant's

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alleged invention. In fact, at the national level, the radio and television networks/stations were one and the same (e.g. NBC, CBS, ABC, etc...); e.g. wherein the national radio networks evolved into the national television networks.

The central/national broadcast station of these broadcast networks operated to create national television/radio programming and to broadcast said created programming to ones of its affiliate broadcast stations. Said ones of the affiliate stations received the broadcasted network television/radio programming and then either rebroadcasted said received network programming or broadcasted locally produced commercials/programs in place of said received network programming. The programming that was broadcast from the ones of the affiliate stations were received by a plurality of television receivers located at households within the local region served by the affiliates, and/or were received and processed by additional ones of said affiliate stations.

C) In order to 1) reduce the operating costs of said television and radio broadcast networks, 2) eliminate man made errors in said television and radio networks, and 3) increase the efficiency in flow of programming in said television and radio networks (i.e. the "motion functions"), it became a desirable trend in the television/radio broadcast industries to have "automated" as much of the broadcast network process as was economically beneficial; e.g. where the term

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“automated” referred to the unmanned operation of network processes by machines instead of station personnel [note: lines 7-22 on page 5 of the Yamane et al. translation]. Early on, the processes that were targeted for automation involved: the monitoring of broadcasted programming for the purpose of determining faults/failures in the network; the monitoring of broadcasted programming for the purpose of determining subsequent program switching opportunities; the control of program flow and switching according to “confirmed program schedules”; etc, ... [note lines 9-18 on page 6 of the Yamane et al. translation].

D) As was already addressed in “**APPENDIX IV**” of this Office action, one of the way in which many processes performed within television/radio networks were automated was through the use of “instruction/identification/control/cuing signals” which were embedded within the broadcasted network programming. These embedded signals were not only used to monitor and identify the network programming being broadcast but were used to provide control over many of the program switching/routing/ recording operations which were performed at said affiliate stations and at the household receiver stations too [note: “**APPENDIX IV**” of this Office action; lines 1-6 on page 2 of the Yamane et al. translation; lines 11-27 on page 13 and lines 1-21 on page 14 of the Yamane et al. translation; lines

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16-23 on page 15 of the Yamane et al. translation; the last six lines on page 18 of the Yamane et al. translation; figure 1 of Hetrich; lines 1-10 on page 2 of Hetrich; the last 9 lines on page 10 of Hetrich; the abstract on page 77 of Anderson; and the first full paragraph under the heading "Introduction" on page 77 of Anderson].

For the record, it is noted that the publication by Anderson explicitly recognized the fact that the versatility of this type of system automation could be greatly expanded if the embedded signals were capable of being addressed to a specific ones, and/or to specific ones, of the affiliate stations [note: the first three lines under the heading "Applications" on page 80 of Anderson; and lines 1-12 under the heading "Conclusion" on page 82 of Anderson].

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**APPENDIX VIII**(the 8/81 article “Landmark forms cable  
weather news network” of *EDITOR & PUBLISHER* (i.e. as  
submitted by applicant))

# Landmark forms cable weather news network

Landmark Communications of Norfolk, Va., plans to begin transmitting 24-hour weather news and forecasts via satellite to over 20 million cable tv households beginning next spring.

Called the Weather Channel, its programming will combine live studio broadcasts of national and regional weather forecasts with teletext transmissions of local weather news.

Weather Channel will be offered as part of basic subscriber service and have its headquarters in Atlanta, Ga.

Landmark has invested \$20 million in the Weather Channel. The privately held communications company, with annual revenues in excess of \$200 million, publishes 10 daily and 22 non-daily newspapers including *Norfolk Ledger-Star* and *Virginian Pilot*. Its newspapers have a combined circulation of over \$11,000.

The company also owns Telecable Corp., the 15th largest cable operator with 250,000 subscribers in 14 states.

The teletext information will appear automatically on viewers' screens every five minutes and will be about a minute in duration.

The teletext weather forecasts will be supplied to local cable operators by means of a device called the Weather STAR, an acronym for Satellite Transponder Addressable Receiver. STAR will be controlled by the Weather Channel's computers in Atlanta.

Those computers have access to the data base of the National Weather Service in Washington D.C. Through the STAR, they can send "customized" National Weather Service forecasts instantaneously to a specified locality.

In addition to localized forecasts and bulletins, the STAR can send targeted advertising.

Weather STAR was developed for Landmark by Computer Video of Salt Lake City, Utah. Landmark has a proprietary interest in Weather STAR's technology.

The Weather Channel will be beamed to local cable systems over Satcom I. The network of cable systems receiving signals from that satellite has come to be known as Cablenet I and has an audience of 20 million households.

Landmark purchased its transponder rights on Satcom I on July 14 for \$10.5 million from Premiere, a pay movie service formed in a joint venture by Getty Oil and four film companies. Premiere is in the process of disbanding after being found in violation of antitrust laws last winter.

The purchase of the transponder rights EDITOR & PUBLISHER for August 8, 1991

was essential in its decision to underwrite the Weather Channel, Landmark said, since being on Satcom I assures access to 95% of all cable households.

Satcom I/Cablenet I is the system used for transmitting Home Box Office, Showtime, Cinemax, USA Network, Cable News Network, ESPN, ARTS, and Nickelodeon. The superstations—WTBS, Atlanta; WOR, New York; WGN, Chicago, and KTVU, Oakland—also transmit over this network.

Satcom I is scheduled to be replaced by a new satellite, Satcom III—R in October. Landmark's rights to a Satcom I transponder will be transferred to a transponder on the replacement satellite.

Frank Batten, chairman and chief executive officer of Landmark, said the Weather Channel is the first of several cable "programming opportunities" which the company is exploring.

"Our main focus will be on information," he stated, but added entertainment programming is also under study.

Batten commented the concept for the Weather Channel was being researched by Landmark for several years.

"In our cable systems we've done audience surveys. We've known the weather channels, which now are alphanumeric, are watched more than any other channel," Batten said. "They're watched for short periods, but are turned on by more viewers."

Batten remarked the concept for a nationwide weather channel became closer to reality when John Coleman, meteorologist for ABC's *Good Morning America*, approached Landmark with his idea for a 24-hour weather service combining national and local forecasts.

"We had access to a man who really knew how to do it," Batten said of Coleman.

Under his new contract with ABC, Coleman will continue as *Good Morning America*'s meteorologist while fulfilling his obligations to Landmark's Weather Channel. He will broadcast for ABC from the network's Atlanta affiliate.

The Weather Channel will be totally advertiser supported. Local operators who dedicate a basic service channel to the weather service will receive it for free. They will also be provided with a Weather STAR by Landmark.

Batten explained a maximum of ten minutes per hour will be available for commercials from national advertisers. The revenues from those ads will go to Landmark.

A maximum of two minutes per hour will be made available for local cable

operators to sell advertising. Local cable operators will also be able to sell textual advertising for a "crawl" across the bottom of the screen.

The teletext capability of the Weather Channel will enable local store names and locations to be tagged onto the national ads appearing in conventional video formats.

Rolin Stanley, new ventures analyst for Landmark, said advertising agencies are "taken with the concept" of the Weather Channel. He said the channel can "develop a huge come over time."

A staff of 21 meteorologists to deliver national and regional weather forecasts is being assembled by Coleman for the Weather Channel.

Coleman said the channel will have a daily schedule of forecasts targeted for special interest groups such as golfers, tennis players, hikers, hunters, fishers, and boaters.

He stated the Weather Channel plans to offer "a good wind forecast, aviation weather, agricultural weather," and a daily roundup of weather forecasts for the country's National Parks.

Coleman said weather warnings "addressed to specific localities" will be "automatically switched on by teletext through the STAR."

The live presentations will feature color or radar, color satellite photos, and color graphics to detail weather information.

Though Landmark's Batten and Cable News Network's Ted Turner are friends, the advent of the Weather Channel has not inspired CNN to add a teletext local news service to its 24-hour broadcasts.

"We've considered from time to time having a local news cut in," said CNN president, Reese Schoenfeld. "But there's no resource like (National Weather Service) available" which collects local news into a central data base.

"The ideal solution is two 24-hour news channels," he continued. "One for local news. One for national."

Schoenfeld said the "cable operator or newspaper" would provide the local news.

## WSJ Evening News to be on cable

Wall Street Journal Evening News will begin airing on USA Network this September.

Wall Street Journal Evening News will consist of two-minute segments which will be seen at 7:28 P.M. and 7:58 P.M. EDT, and in a late night floating spot.

The segments will emphasize business news as it affects consumers.

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**APPENDIX IX** (page 5 of the appendix that was attached to a  
1981 "PETITION FOR RULEMAKING" submitted to the FCC in  
which *typical* teletext data was described)

Teletext utilizes a number of the lines in the vertical blanking interval for the transmission of text and pictorial information in digital form for display on the television screen. The number of vertical blanking interval lines which may be used for teletext ranges from a minimum of one to a maximum of 12, with two lines proposed for use initially in the United States. The amount of digital teletext information which can be transmitted in a given amount of time increases in direct proportion to an increase in the number of lines used for teletext.

The first step in teletext service is the translation by a teletext editor of text, pictorial information and display attributes (such as color, flashing characters and so on) into ~~addresses or instructions~~ to be transmitted to the teletext decoder. The instructions for each page in the teletext "library" are then broadcast continuously on a revolving basis by multiplexing the data into the vertical blanking interval. The user accesses a desired page of teletext information by entering the page number, e.g., by pressing the appropriate buttons on a control unit. The teletext decoder then selects the page from the revolving transmissions, stores the coded information in memory, ~~and~~ ~~transmits the information~~ to the extent necessary for a display, and produces the page on the television screen. Where captioning is transmitted, the decoder will superimpose the captioning over the normal television picture.

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Before the  
FEDERAL COMMUNICATIONS COMMISSION  
Washington, D.C. 20554

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In the Matter of:

Amendment of Part 73, Subpart E  
of the Federal Communications  
Commission Rules Governing Tele-  
vision Broadcast Stations to  
Authorize the Transmission of  
Teletext

)  
)  
) RM No.  
)  
)  
)  
)

PETITION FOR RULEMAKING

The United Kingdom Teletext Industry Group, Bernard J. Rogers, Chairman, <sup>1/</sup> pursuant to Section 1.401 of the Commission's Rules, files herewith, this request, that the Commission initiate a proceeding proposing the adoption of rules to allow television broadcast licensees to transmit teletext using the defined format British teletext system. <sup>2/</sup>

We submit that teletext is ripe for rapid development in the United States and we urge the Commission to proceed as quickly as is reasonably possible to allow the use of this important technology in the United States. For this reason

1/ This group is comprised of representatives of the following bodies who are interested in the British teletext system and have endorsed the present submission: British Broadcasting Corporation; Independent Television Companies Association; Independent Broadcasting Authority; British Telecoms; Department of Industry; Logica, Ltd; Jasmin, Ltd; Mullard, Ltd; V.G. Electronics, Ltd; Texas Instruments (UK), Ltd; General Instrument Microelectronics (UK), Ltd; Aston, Ltd; GEC (UK) Ltd.

2/ The specific rules which we proposed for adoption are set forth at Attachment B to our Appendix. <sup>2/</sup>

KC012283

toward the commencement of teletext service in the United States as soon as is reasonably possible.

Respectfully submitted,

UNITED KINGDOM TELETEXT  
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Bernard J. Rogers, Chairman

By /s/ Bernard J. Rogers  
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March 26, 1981

Its Attorneys

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